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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058315
Party	Plaintiff State of Michigan
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State of Michigan)	
)	
Petitioner,)	Reg. Nos.: 3992159
)	3348635
)	
v.)	
)	
M22, LLC)	Proceeding: 92058315
)	
Respondent.)	
)	
_____)	


**PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE TO
RESPONDENT'S CROSS-MOTION**

Pursuant to the October 2, 2015 Order of the Trademark Trial and Appeal Board (TTAB), Petitioner, State of Michigan (State), in reply to Respondent's Response to the State's Motion for Partial Summary Judgment, and in response to Respondent's Cross-Motion for Partial Summary Judgment, states as follows:

INTRODUCTION

The parties each move for summary judgment on the State's claim that Respondent's use of the State's road sign was not lawful use in commerce so as to qualify for trademark registration under the Lanham Act. The State's motion is premised on TMEP § 1205, which precludes registration of marks for which trademark protection is prohibited under "various federal statutes and regulations." The State established the development of the Manual on Uniform Traffic Control Devices (MUTCD or Manual), and further demonstrated that MUTCD Standards (i) constitute mandatory or prohibited conduct, (ii) are applicable to private and public parties, and (iii) are incorporated into the Code of Federal Regulations, thereby having the force and effect of law. The State also

established that to qualify for federal funding, states must adopt the MUTCD, which applies to all roads involving federal funds, and may supplement the Manual with approval by the Federal Highway Administration (FHWA).

In 2003, after notice-and-comment rulemaking, the FHWA promulgated a MUTCD Standard prohibiting trademark protection for road signs included in the Manual. The State adopted the 2003 MUTCD, and included the State's trunkline highway route marker, e.g., , via a FHWA-approved supplement, as has been done since 1973. Because the State's sign is included in the MUTCD, and federal regulations prohibit trademark protection for such signs, Respondent's use of the State's sign affixed to goods and services sold, i.e.,  and  (Marks), was not lawful use in commerce so as to be eligible for trademark registration. Moreover, as it is the *State's* sign design, Respondent cannot satisfy the Lanham Act's ownership requirement for trademark registration.

Respondent failed to dispute the history of the MUTCD or that MUTCD Standards constitute mandatory requirements and prohibited practices applicable to both public and private parties. Even the case law cited by Respondent confirms that MUTCD Standards, as opposed to support, guidelines, and options, have the force and effect of law. Nor did Respondent dispute that (i) the State's sign has been included in the MUTCD by FHWA-approved supplement since 1973, (ii) the 2003 MUTCD, as adopted and supplemented by the State, includes the State's sign as well as the Standard prohibiting trademark protection for road signs incorporated therein, and (iii) all trunkline highways in Michigan involve federal aid and, therefore, federal regulations apply to them.

Nevertheless, Respondent misconstrued the crux of the State's lawful use in


commerce claim and applicable case law, as well as authority on MUTCD enforcement.¹ Contrary to Respondent's assertion, the issue at hand is not whether Respondent violated federal statutes or regulations pertaining to labeling and shipping products, such as food, cosmetics, and wine. Rather, the issue is that Respondent's use of the State's sign, affixed to apparel and other novelty items, cannot satisfy the "lawful use in commerce" requirement for trademark registration under the Lanham Act because, like other federal statutes and regulations prohibiting trademark protection, which are implemented by the USPTO in deciding registration, MUTCD Standards prohibit trademark protection for the State's sign and, having the force and effect of law, must also be effectuated. Otherwise, the risk of harm to the State is substantial.

Finally, in an attempt to circumvent federal law, Respondent asserted that the State's claims are barred by laches and acquiescence, also known as the Morehouse defense. However, as explained below, the TTAB has held that the Morehouse defense cannot be invoked where, as here, the claim at issue is whether the party's use is not lawful because it is prohibited by law. Nor can laches defeat a governmental entity acting in the public interest and to protect a public right. Accordingly, summary judgment in favor of the State on its lawful use in commerce claim is warranted.

UNDISPUTED FACTS

Respondent did not dispute that the State developed the diamond sign design for trunkline highways and has used the sign throughout the State of Michigan, dating back nearly 100 years. Further, Respondent failed to dispute the State's continuous use of the

¹ Remarkably, Respondent even suggested that the State should have declined federal funding for its roads to allow trademark rights in the State's sign, obviously under the misconception that a party other than the State, which owns the sign, could register the mark as its own.

current sign design since 1973, e.g., . Nor did Respondent refute that the M-22 route marked by the State's sign is a Scenic Heritage Route, and one of several notable Michigan trunkline highways marked by the same sign design, albeit with a different route number, in the Great Lakes Circle Tour and the Lake Michigan Tour.

Regarding the Manual, Respondent did not dispute that MUTCD Standards constitute federal regulations establishing mandatory and prohibitive conduct to be adhered to by private parties and all states receiving federal funds. Respondent also failed to dispute that, after notice-and-comment rulemaking, a Standard prohibiting trademark protection for all signs in the Manual was included in the federal MUTCD in 2003, and adopted by Michigan. Nor did Respondent establish a material factual dispute that, since 1973, the State has adopted the federal MUTCD with a FHWA-approved State supplement incorporating the State's sign in the Manual, and there is a risk of substantial harm to the State if the registrations are not canceled.

As for the facts alleged by Respondent, the State does not dispute that northwest Michigan and the M-22 route have been a popular tourist destination for several decades before Respondent put the State's sign on a t-shirt, and that Respondent has a successful business and was recognized for its success. The State also agrees that, in 2012, the Michigan Attorney General issued an Opinion stating that the State's sign is not protectable as a trademark. Prior to and after the Attorney General Opinion was issued, the parties spent nearly two years trying to resolve this matter amicably, but were unsuccessful. However, as explained more fully below, Respondent's contentions that the Marks are "creatively dissimilar from" the State's sign, that northwest Michigan and the M-22 route are popular because of Respondent's business success, that Respondent's use and registration of the Marks as trademarks is permissible, and that the State's claim is barred by acquiescence or laches, are meritless and lack any basis in fact or law.




ARGUMENT

I. Respondent failed to meet Lanham Act requirements for registration of the Marks, which are nearly identical to the State's sign.

To be registrable as trademarks under the Lanham Act, the Marks must be, *inter alia*, trademarks used in commerce, and Respondent must own the Marks. (Motion, pp. 20-22.) As explained below, there is no material factual dispute, and by its own actions Respondent has conceded, that the Marks are virtually identical to the State's sign, which Respondent clearly does not own. Respondent also failed to establish any material facts in dispute as to whether federal regulations prohibit trademark protection for the State's sign included in the Manual by FHWA-approved supplement. Because the State's sign is not eligible for trademark protection, it cannot be a "trademark" or in "lawful use in commerce" as required under the Lanham Act; nor is Respondent the owner of the State's sign, which is incorporated into the Marks. Thus, the registrations at issue must be canceled.

Strangely, Respondent placed the blame for its inability to register the State's sign as a trademark on the State's "selfishness" in securing federal funding for its roads, claiming the State acted "through its own volition and in order to obtain federal road funding" by adopting the MUTCD and including in the Manual the State's sign design, with approval by FHWA, for more than forty (40) years. (Response, pp. 13-14.) While Respondent contends that the State could have rejected federal funds and the Manual to allow trademark protection for the State's signs, such a ridiculous suggestion does not weigh in its favor because, under any scenario, Respondent does not own the State's sign.

A. The Marks are not readily distinguishable from the State's road sign, and they need not be identical to be simulations.

Without question, the Marks, i.e.,  and  , are virtually identical to the State's sign, e.g.,  . In fact, Respondent failed to dispute the Examiner's finding that the

Marks are used in “exactly” the way the State uses the road signs for its highway. (Motion, pp. 19-20.) On its Facebook page, Respondent admits that the “M22 road sign” is protected as a trademark. (Ex. 30.)

Now Respondent purports to have made “creative” modifications to the State’s sign. By its own admission, Respondent’s “creativity” is limited to a white border, imperceptibly thicker letters within and rounder corners on the diamond, and the addition of “M22ONLINE.COM” below the State’s sign. However, the allegedly “creative” white border around the sign in the Marks is the same as the border that appears on signs erected along Michigan’s roads. See Ex. 28, p. 2 and Ex. 31. Moreover, a white border added to the sign to set it apart from the dark color of a t-shirt is not even remotely creative. Clearly, Respondent’s creativity is as indiscernible as the thickness changes and rounded corners that it self-servingly claims make the Marks readily distinguishable from the State’s sign design. In fact, Respondent has admitted that its feigned “creative” differences are of no moment by threatening to sue those who duplicate the State’s sign on grounds that such signs, including the M-22 sign, i.e., without thickness changes and rounded corners, are identical to and infringe the unlawfully registered Marks. (Exs. 32-35.) For example, Respondent threatened to sue users of the State’s sign with M-25, M-26, M-28, M-37, and M-119 in the diamond, on the basis that each applicant’s mark was “identical” to the Marks at issue here. (Ex. 29, Exs. 36-41.) Respondent cannot have it both ways. Its admission that third party uses of the State’s sign infringe and are confusingly similar to the Marks constitutes an admission by Respondent that the Marks are not creatively different from the sign.

Moreover, Respondent has admitted that identicalness of its Marks to the State’s sign is not required, especially where the “substantial and distinctive portion” of the State’s sign are copied. (Exs. 36 and 37.) Any notion that the Marks must be identical to the

State's highway route marker, or that identicalness must be determined by a careful analysis and side-by-side comparison to determine whether they are readily distinguishable, is misguided because purchasers retain only an *overall* recollection of design marks:

The determination of whether applicant's mark is a simulation of an insignia of the United States is made "without a careful analysis and side-by-side comparison" with the government insignia because "purchasers normally retain but a general or overall rather than a specific recollection of the various elements or characteristics of design marks."

In re Peter S. Herrick, P.A., 91 U.S.P.Q.2d 1505; 2009 WL 1741898 (TTAB 2009) (citations omitted) (finding that, in comparing the applicant's mark to the government seal at issue, with the exception of the words "U.S. Customs Service" in place of "The Department of the Treasury," the challenged mark was identical to the seal, and "the average person upon seeing applicant's mark would associate it with the Department of Treasury seal" and, therefore, because the applicant's mark was not readily distinguishable from the Department of Treasury seal, it "consists of or comprises a simulation of an insignia of the United States thereby prohibiting registration."). Here, evidence of purchasers' recollection that the Marks are not readily distinguishable from the State's sign is clear from the dramatic uptick in road sign thefts after Respondent adopted the sign as its brand. (Motion, p. 19.)

Without question, Respondent has admitted that the Marks are not readily distinguishable from the State's sign. Because federal regulations prohibit trademark protection for the sign, and the Marks are virtually identical to the sign, it is axiomatic that trademark protection for the Marks is prohibited by law, and the trademark registrations at issue must be canceled.

B. For decades before Respondent copied the State's sign onto a t-shirt, northwest Michigan was, and still is, recognized as a popular tourist destination identified by the State's route marker.

Respondent conceded that northwest Michigan “has long served as a coastal retreat,” “was recently named ‘Most Beautiful Place in America’ by ABC News,” and is home to several famous festivals. (Response, p. 2.) Nevertheless, Respondent claims, without any supporting evidence, that its adoption of the State’s sign as its brand has been the catalyst for the region’s popularity. (Response, p. 3.) To the contrary, the popularity of the region, identified by reference to the state trunkline road, existed long before Respondent put the State’s sign on a t-shirt to “express a *common passion* for northern Michigan.” (Response, Ex. A, p. 4, Story (emphasis added)).

In 2011, Respondent admitted that the road marked by the State’s sign, and the northwest Michigan region represented by the road and sign for decades before Respondent put the State’s road sign on a t-shirt, has always been special to residents and tourists alike – “It is easy for people to relate to the road because of its cool location and most people already have an attachment to it. M-22 is a special place for people, good memories.” (Ex. 43.) Respondent’s founders admit that “[t]he highway is the nicest, most beautiful stretch of road along any fresh water in the world.” (Ex. 43.) Indeed, in September 2015, USA Today readers voted the route known as M-22 as the top scenic drive in the country – although there was no mention of Respondent’s store in the article or that it was in any way a contributing factor to the region’s popularity. (Ex. 44.) More than a decade earlier, the M-22 route was declared a Scenic Heritage Route by the Michigan Legislature, and part of the Lake Michigan Circle Tour and the Great Lakes Circle Tour in northwest Michigan. (Response, p. 3, Ex. A, p. 4.) Clearly, Respondent’s adoption of the State’s sign is not the reason for the popularity of the region. Rather Respondent adopted the State’s sign to

trade on the goodwill and well-established popularity of the tourist region associated with the State's route marker over the past century.

C. MUTCD Standards must be implemented under TMEP 1205.01, and warrant cancellation of the registrations at issue.

Despite clear and unambiguous language in the Manual and in federal regulations, Respondent contends that the entirety of the MUTCD comprises suggestions and guidelines that the states may choose to ignore. (Response, p. 15.) To the contrary, the express language of the MUTCD and 23 C.F.R. § 655.603 confirm that MUTCD Standards, rather than support, guidelines and options, have the force and effect of law. See Motion, pp. 10-16. Indeed, the cases cited by Respondent confirm that MUTCD Standards are mandatory or prohibitory and must be given preclusive effect, including the provision preventing trademark protection for the State's sign.

Referring to 36 C.F.R. § 261.22, Respondent admitted that "it is clear that where . . . a regulatory agency through the Code of Federal Regulations, has intended to exclude certain subject matter from trademark registration, it has explicitly stated its intent to do so." (Response, p. 13.) The FHWA has done so in adopting a federal regulation expressly prohibiting trademark protection for signs in the Manual. Nevertheless, Respondent asserts that whether it satisfies the requirements of the Lanham Act for purposes of trademark registration should not be determined based on the language of this MUTCD Standard. Section 1205.01 of the TMEP belies Respondent's claim, as it requires consideration of statutes and regulations precluding trademark registration, including those listed in Appendix C. That the MUTCD is not *currently* listed in Appendix C is irrelevant, as the list is "nonexhaustive" and "other sections also exist . . . which are not indexed under these terms." T.M.E.P. § 1205, Appendix C.

Respondent also contends that its "violation" of the Manual cannot be a basis for

canceling registration of the Marks. As explained in the TMEP, the MUTCD does not provide the basis for refusing or canceling registration; rather, the Board must consult the relevant statute or regulation “to determine the function of the designation and its appropriate use.” TMEP § 1205.01. TMEP § 1205 requires the USPTO to give effect to regulations that prohibit trademark protection, such as the MUTCD. Where, as here, the MUTCD provides that no one has the right to trademark protection for road signs in the Manual, the Marks must be canceled “on ground that the mark is not in lawful use in commerce, citing §§1 and 45 of the Trademark Act, 15 U.S.C. 1051 and 1127, in addition to the relevant [regulation].” T.M.E.P. § 1205.01.

In addition, Respondent failed to refute the risk of substantial harm to the State if the registrations are not canceled, as explained in the State’s Motion. See Motion, pp. 22-25. However, Respondent’s purported lack of “intent” to enforce the Marks against the State has no bearing on the requirement to adhere to federal regulations, and is not a valid defense to its inability to satisfy the “lawful use in commerce” requirements necessary for trademark registration. Not surprisingly, Respondent failed to cite any authority for its claim.

1. Contrary to Respondent’s misunderstanding, the Supreme Court and other courts have confirmed that MUTCD Standards are mandatory and adherence is required.

Respondent misconstrued the Supreme Court’s holding in *CXS Transp. Inc. v. Easterwood*, 507 U.S. 658 (1993). Contrary to Respondent’s assertion that the MUTCD cannot be enforced, the Supreme Court stated unequivocally that *standards* set out in the MUTCD are mandatory on all projects, and must be adhered to: “For all projects, [States] must employ devices that conform to *standards* set out in FHWA’s Manual on Uniform Traffic Control Devices for Streets and Highways (MUTCD or Manual).” *CXS Transp. Inc.*, 507 U.S.

at 666 (emphasis added) (citing 23 C.F.R. § 655.603 (1992)).

Similarly, in *Oliver v. Ralphs Grocery Co.*, 654 F.3d 903 (9th Cir. 2011), another case misconstrued by Respondent, the Ninth Circuit confirmed that “[i]n order to remain eligible for federal highway and highway safety program funds, a state must . . . adopt the federal MUTCD in conjunction with a state supplement.” *Id.* at 910. Although the facts in *Oliver* do not resemble those in the case at bar, the opinion is instructive here, but not for the reasons stated by Respondent.

In *Oliver*, contrary to the plaintiff’s assertions, the court found that (i) the federal MUTCD was issued pursuant to 23 U.S.C. § 109(d) and § 402(a), not the Rehabilitation Act; and (ii) the department of transportation did not revise the federal MUTCD to bring it into conformance with the Rehabilitation Act, but rather promulgated regulations to implement the Act’s prohibition on discrimination. *Id.* at 910. Thus, a design feature inconsistent with the Manual was not a per se violation of the ADA. *Id.* at 911. *Oliver* is instructive in the instant case where the Lanham Act prohibits trademark registration for marks that are not in lawful use in commerce. Like dozens of other statutes and regulations prohibiting trademark protection for various marks, in promulgating regulations prohibiting trademark protection for road sign designs in the Manual, the FHWA implemented the Lanham Act’s prohibition on registration by preventing the use of such signs in commerce from being the “lawful use” required for registration.

2. Respondent’s cited cases confirm that MUTCD “guidelines” are optional, while “Standards” are mandatory or prohibitive.

Other cases cited by Respondent discuss MUTCD *guidelines*, which are not standards and, therefore, are not mandatory or prohibitive. For example, in *Peruta v. City of Hartford*, 2012 WL 3656366 (D. Conn. Aug. 24, 2012), the plaintiff sought to enjoin the city from operating and enforcing a Pay and Display Parking Meter System on grounds that

the system, *inter alia*, failed to meet national uniform standards for traffic control devices, *as supplemented by state standards*, for giving notice of traffic laws and regulations. *Id.* at 1-2. Specifically, the plaintiff alleged that the parking meter system in place at the location where he received a ticket, and in other areas throughout the city, did not meet the standards set forth in the MUTCD and the municipal code. The court held that the guidance portion of the MUTCD relied on by the plaintiff was, as explained in the MUTCD, only general guidance and, “therefore clear based on the express terms, structure, and context of the MUDCT [sic] that it poses nothing more than a form of guidance for states and local municipalities to follow in the design and placement of regulatory, including parking, signs.” *Id.* at 14. Further, the court held that “there is no private right of action for an alleged violation of MUTCD as incorporated into 23 C.F.R. §§ 600 et seq.” *Id.* at 15. Clearly, the facts in *Peruta* have no resemblance to this case where Standards, rather than guidelines, are at issue.

Similarly, the facts and issues in *Wasserman v. City of New York*, 802 F. Supp. 849, 855 (E.D.N.Y. 1992) confirm that “guidelines” in the MUTCD are not mandatory. In *Wasserman*, the sign at issue was posted farther away than the “suggested advance posting distances” set forth in the MUTCD. The court also distinguished the facts from *Peckham v. State*, 387 N.Y.S.2d 491, 492 (App. Div. 4th Dept 1976), where the state was found negligent because it did not post a sign in accordance with MUTCD *requirements*. *Wasserman*, 802 F. Supp. at 855.

In *Albertson v. Fremont County, Idaho*, 834 F. Supp. 1117 (D. Idaho 2011), another case that Respondent cites, the court confirmed that “the Idaho Supreme Court has held that a violation of a *mandatory* provision of the MUTCD may act as the basis for a claim of negligence per se.” *Albertson* at 1137. However, MUTCD “guidelines” are not mandatory.

Id. at 1136. The plaintiff's negligence per se claim failed because application of the MUTCD on snowmobile trails, which are not "highways," is not mandatory. *Id.* at 1138.

Respondent's summary of another case, *Texas Department of Transportation v. Andrews*, 155 S.W.3d 351, 359-360 (Tx. App. 2004), as one in which the court found that MUTCD standards are discretionary rather than mandatory, is also wrong. In *Andrews*, the State of Texas adopted a Texas Manual with more stringent standards than the federal MUTCD, but the state statute authorizing implementation of the Texas Manual indicated that these higher standards were discretionary rather than mandatory. *Id.* at 359. The court confirmed that standards in the federal MUTCD are mandatory, while guidelines are discretionary. *Id.* at 359-360 (finding that "appellees presented no evidence showing that the roadway and extension do not conform to the standards set forth in the federal manual," and the provisions relied on by appellees were guidelines and, therefore, not mandatory).

Respondent also misconstrued another case, *Donaldson v. Department of Transportation*, 511 S.E.2d 210, 214 (Ga. App. 1999). In *Donaldson*, the court confirmed that "[t]hrough the Code of Federal Regulations, the MUTCD can be [sic] established applicable standard of care under proper facts." *Id.* at 213. However, the roadway at issue in the case was not a "Federal-aid highway so that the MUTCD would be applicable and have the force of law in this case." *Id.* In the instant case, all Michigan state trunkline highways are federal-aid highways to which the MUTCD applies and has the force and effect of law.

3. The USPTO regularly consults regulations prohibiting certain conduct in determining whether a mark was in "lawful use in commerce" so as to qualify for trademark protection.

Respondent misunderstood the matter at issue here as whether its products complied with shipping and labeling requirements in areas of commerce regulated by Congress, such as cosmetics, food, wine, and pharmaceuticals, i.e., whether various

products are labeled and shipped in compliance with federal statutes, so as to constitute lawful use in commerce. Response, pp. 7-11, 18-20. However, the State’s “lawful use in commerce” claim is not about whether Respondent’s goods, apparel and souvenirs with the State’s sign met the standards required by labeling or shipping statutes. The issue is whether MUTCD Standards prohibiting trademark protection for the State’s sign prevent Respondent’s use of the sign from satisfying the “lawful use in commerce” requirement for registration under the Lanham Act. The answer is a resounding “yes” and, therefore, the Marks must be canceled.

The cases Respondent cites are relevant here only insofar as they demonstrate that the USPTO consults statutes and regulations prohibiting particular conduct, including trademark protection, when determining whether use of a mark satisfies the “lawful use in commerce” standard. Otherwise, the cited cases are irrelevant to the instant case.

For example, in *In re Stellar International, Inc.*, 159 U.S.P.Q. 48; 1968 WL 8159 (T.T.A.B. 1968), the applicant’s shipment of cosmetics was misbranded with a label that included the applicant’s mark but not an accurate statement of the contents as required by The Federal Food, Drug and Cosmetic Act.² *Id.* at *1. The misbranded labels were used to establish use in commerce by the applicant. *Id.* at *2. The Board held that the question of whether or not the statement of contents *should* be required on the applicant’s label was to be determined by the Secretary of Health, Education, and Welfare, rather than the USPTO. *Id.* The issue before the Board was whether the applicant’s failure to include the contents on the label rendered the shipment of goods “unlawful shipments” in interstate commerce

² Although Respondent contends that the Board is not experienced or knowledgeable in statutes unrelated to trademark law, the holding in *In re Stellar International, Inc.*, 159 U.S.P.Q. 48 (TTAB 1968) confirms that the Board is aptly suited to review whether an applicant’s alleged use of a mark complies with applicable laws and regulations so as to constitute lawful use in commerce.

from which no trademark rights can be derived and, therefore, barred registration of the application. The Board denied registration because it could not accept “as a basis for registration a shipment in commerce which is unlawful under a statute specifically controlling the flow of such goods in commerce,” and trademark rights did not accrue to properly form a basis for “use of a mark in commerce.” *Id.* at *3. According to the Board, “a party may not enter commerce and seek registration unless and until he has fully complied with the particular Act of Congress which directly controls the commerce in such goods.” *Id.* at *5. If a shipment of goods in commerce is proscribed by statute because it does not meet specific labeling requirements, the shipments under such nonconforming labels are “‘unlawful shipments’ in commerce from which no trademark rights can accrue much less form the basis or foundation for a federally issued trademark registration.” *Id.*

Furthermore, the Board in *Stellar* confirmed that it cannot turn a blind eye to regulatory requirements that may have an effect on registration. Pursuant to Section 41 of the Act of 1946, the Commissioner promulgated Rule 2.69, “which permits the examiner, when the sale or transportation of any product for which registration is sought is regulated under an Act of Congress, to make appropriate inquiry as to compliance with such act ‘for the sole purpose of determining lawfulness of the commerce recited in the application.’” *Id.* at 3. If the Patent Office determines that an applicant has not complied with the regulatory act, registration may be refused until compliance is made. *Id.* While the Patent Office is not required to police all regulatory statutes to ensure compliance therewith, if an inquiry can be made and information is forthcoming that renders the subject application void ab initio, it would be “illogical and incongruous” to expect the Patent Office to “conveniently forget about it and let the information ‘slumber in the archives of the Patent Office.’” *Id.* If the Patent Office cannot take such action, then Rule 2.69 would be ineffective:

It seems evident that the term “commerce” whenever and wherever used in the trademark statute must necessarily refer to “lawful commerce”; and that the statute was not intended to recognize under its registration provisions shipments in commerce in contravention of other regulatory acts promulgated under the “commerce clause” of the Constitution. To hold otherwise would be to place the Patent Office in the anomalous position of accepting as a basis for registration a shipment in commerce which is unlawful under a statute specifically controlling the flow of such goods in commerce. (*Id.* at *3.)

Here, the MUTCD regulates traffic control devices used throughout the country on roadways where federal funds are used, and MUTCD Standards must be followed by the states and private parties, while the guidelines, support, and options are not obligatory. With the Standard prohibiting trademark protection now before the Board, the USPTO must ensure compliance. Because the MUTCD Standard constitutes a federal regulation that prohibits trademark protection for road signs that are incorporated therein, compliance with the regulation is not voluntary and renders registrations of the Marks void *ab initio*.

Whether Respondent’s sale or transportation of t-shirts and other souvenirs is regulated by an Act of Congress, and whether Respondent has complied with any such Act vis-à-vis labeling its products, has no bearing on the parties’ motions. Similarly, cases relating to unclean hands and unlawful commerce, as cited by Respondent, are irrelevant to the motions before the Board, as the issue is not about whether Respondent’s shipment of goods bearing the State’s sign violated a labeling statute. Cases about whether an applicant misrepresented ingredients or whether an applicant’s business was unlawful, as cited by Respondent, are also inapposite here. (Response, pp. 7-11.) (*Kellogg Co. v. New Generation Foods, Inc.*, 6 U.S.P.Q.2d 2045 (TTAB 1988) involves labeling issues and whether Kellogg complied with applicable statutes, rules and regulations pertaining to labeling; *Satinine Societa in Nome Collettivo v. P.A.B. Produits*, 209 U.S.P.Q. 958 (TTAB 1981) involves whether a non-compliant label used in shipping goods could acquire

trademark rights; in *Churchill Cellars, Inc. v. Graham*, 2012 WL 5493578 (TTAB Oct. 19, 2012), the Board held that the statutory requirement for label approval by the Department of Treasury Alcohol and Tobacco Tax and Trade Bureau was not met and, therefore, shipments of wine with the unapproved label did not constitute lawful shipments to constitute use for a trademark registration; *General Mills v. Health Valley Foods*, 24 U.S.P.Q.2d 1270 (1992), relates to unlawful shipments wherein the Board stated that “[t]he decision herein will require the Board to make a case by case determination of the importance or materiality of the labeling requirement which a party may have violated”; in *In re Taylor*, 133 U.S.P.Q. 490 (TTAB 1962), specimens failed to show lawful use where the label failed to include information required under the Federal Food, Drug and Cosmetic Act.) Similar cases relied on by Respondent are also irrelevant for the same reasons. See Response, pp. 18-19.

Without question, Respondent’s assertions, and cases cited in support, misconstrue the matter at issue. Because Respondent is not the owner of the State’s sign design and cannot, under federal regulation, use the sign design in commerce so as to qualify for trademark protection, Respondent cannot satisfy the conditions set forth in the Lanham Act for trademark registration and the Marks must be canceled.

4. The State is not required to prove its claim by clear and convincing evidence.

Consistent with its misapprehension of the issue, Respondent misstated the law applicable to the State’s lawful use in commerce claim.³ The “clear and convincing” burden

³ Respondent also misstated the issue of lawful use as one of illegality to which TMEP § 907 applies. The State’s Motion does not allege illegal conduct by Respondent. Nor does the State allege that Respondent cannot use the State’s sign on apparel, drinkware or other souvenir and novelty items. Despite the parties’ dispute, the State wishes Respondent continued success, but cannot condone, encourage, or turn a blind eye to Respondent’s efforts to exercise trademark rights over the State’s sign design, which Respondent does not

of proof proposed by Respondent is not required here. Rather, the clear and convincing standard applies where a party asserts that an applicant failed to comply with an FDA labeling statute. In other words, the State is not required to prove its lawful use in commerce claim by clear and convincing evidence because – and Respondent left out crucially important language here – the State does not seek to show that use by Respondent “was unlawful by virtue of noncompliance with a labeling statutory provision.” *Churchill Cellars, supra* at *7. The language of the FDA labeling statute at issue in the cases that Respondent relies on sets labeling requirements. In *Churchill Cellars*, the court held that, in the absence of an FDA ruling as to whether the label complies with the statute, one must show by clear and convincing evidence that the applicant failed to comply with the labeling statutory requirements. *Id.* The issue before this Board is simple and does not require an analysis of whether Respondent complied with such statutory requirements. Instead, the Board must enforce the Lanham Act, and ensure compliance with federal regulations prohibiting trademark protection for the State’s road sign, by canceling registration of the Marks that Respondent does not own and that were not in law use in commerce. The “clear and convincing” standard proposed by Respondent does not apply here because this case is not about whether Respondent’s sale of goods, vis-à-vis a label affixed to the goods, complies with a labeling statute, or the like.

To the extent the cases cited by Respondent are even remotely relevant here, it is limited to the Board’s requirement of an agency determination as to whether compliance with a statute has been met. In this case, the FHWA approved Michigan’s use of its sign design dating back to 1973 when it first issued the MUTCD. Thus, there is no dispute about whether the State’s sign satisfies MUTCD requirements; the FHWA has already

own and which is not subject to trademark protection.

determined that it does and that it is not subject to trademark protection. Giving effect to federal regulations and the FHWA's determination that the State's sign complies with the MUTCD, and is incorporated therein by supplement, compels cancellation of the trademark registrations on the Marks.

5. FHWA's approval of the State's supplement is not subject to notice-and-comment rulemaking.

Respondent contends, without any factual or legal bases, that the FHWA's approval of the State's supplements to the MUTCD adopted by Michigan is subject to notice-and-comment rulemaking. However, as explained by the FHWA, the State's adoption of the MUTCD with a State supplement is permitted so long as the supplement is in substantial conformance with the MUTCD. For example, states cannot omit or change a MUTCD "shall" to a "should" or a "may." (Ex. 43, p. 6.) The FHWA's approval of the State's supplement confirms that it is in substantial conformance with the MUTCD, i.e., "[it] conforms as a minimum to the standard statements included in the National MUTCD." (Ex. 43, p. 6, FHWA FAQs; 23 C.F.R. § 603(b).) Therefore, because a State supplement conforms to, but does not substantively change, the MUTCD, common sense dictates that there is no requirement for notice and comment.

Respondent further speculates that it is "improbable" that the State's inclusion in the MUTCD of its road sign via a supplement approved by FHWA is enforceable. (Response, p. 20.) However, according to the FHWA, for purposes of enforcement, "when traffic control devices are installed on a federal aid project," the Code of Federal Regulations applies and requires such devices to comply with the MUTCD. See Ex. 43, p. 6. Here, all State trunkline highways involve federal aid and are marked by the diamond design sign. Therefore, the MUTCD, as supplemented by the State, applies.

II. Respondent's affirmative defenses of laches and acquiescence fail because such equitable defenses do not apply to a "lawful use in commerce" case or to governmental entities acting in their sovereign capacity to protect the public welfare or enforce a public right.

Respondent asserts, again without any factual basis, that the State waited too long to complain that Respondent's use of the State's signs failed to satisfy the lawful use in commerce element required for trademark registration. However, pursuant to long-standing precedent of the TTAB, as well as that of federal and state courts, Respondent's defenses fail here where the State is a governmental entity acting in its sovereign capacity to protect the public welfare and enforce a public right, and because laches and acquiescence do not apply to the State's "lawful use in commerce" claim.

A. The equitable defenses of laches and acquiescence do not apply to a "lawful use in commerce claim."

The TTAB has made clear that equitable defenses "in the nature of laches, estoppel or acquiescence," which have come to be known as the "Morehouse defense," are not applicable in all cases, including when the ground asserted for cancellation is that the party's use is unlawful because it is prohibited by law. See *U.S. Olympic Committee v. O-M Bread Inc.*, 29 U.S.P.Q.2d 1555; 1993 WL 574463 (1993). The facts here are on par with those in *Olympic Committee*, where the TTAB found that the applicant's use of the mark OLYMPIC KIDS violated Section 110(c) of the Amateur Sports Act, 36 U.S.C. 380(c) and, therefore, the use was not lawful use in commerce. *Id.* at *2. The applicant invoked the Morehouse defense and claimed that its incontestable registrations for OLYMPIC and OLYMPIC MEAL for bread and bakery products meant that the opposer could not suffer additional damages if a registration for OLYMPIC KIDS issued. The TTAB rejected the applicant's argument, finding that the equitable defenses of laches and acquiescence do not apply where the ground asserted is that the applicant's use is unlawful because it is prohibited by law. *Id.* at 3. See also, *Schnur & Cohan, Inc. v. Academy of Motion Picture*

Arts & Sciences, 223 F.2d 478; 106 U.S.P.Q. 181 (T.T.A.B. 1955) (laches does not apply where the mark is void).

The facts in the instant case mandate the same result. The Board has held that the State has standing to assert claims as set forth in the Second Amended Petition, including its lawful use in commerce claim based on federal regulations that prohibit trademark protection for signs in the Manual. Equitable defenses of laches and acquiescence cannot be invoked to defeat the State's claim that Respondent's use of its sign was not lawful use in commerce so as to be eligible for trademark registration under the Lanham Act. *Olympic Committee* at *3. Accordingly, the State's Motion should be granted, and Respondent's Motion should be denied.

B. Respondent's equitable defense of laches is inapplicable against the State acting in the public interest and to protect public rights in the State's sign.

Under the *Summerlin* rule, the Supreme Court has held that laches is "no defense to a suit by [a governmental entity] to enforce a public right or protect the public interest." *U.S. v. Philip Morris Inc.*, 300 F.Supp.2d 61, 72 (D.C. Cir. 2004) (citing *U.S. v. Summerlin*, 310 U.S. 414, 416 (1940)). According to the Supreme Court, "the 'continuing vitality' of this rule rests on 'the great public policy of preserving the public rights, revenues, and property from injury and loss, by the negligence of public officers.'" *Philip Morris* at 72-73 (citing *Guaranty Trust Co. of New York v. U.S.*, 304 U.S. 126, 132 (1938)). As explained *supra*, Respondent has improperly exercised trademark rights over the State's sign by claiming to use it as a trademark, registering trademarks on the sign, and threatening to sue numerous entities for using the State's route markers to promote the scenic Michigan region in which their businesses are located. Respondent cannot be permitted to act contrary to federal regulations and to harm the public. There can be no dispute that the State is acting in the public interest by seeking adherence to federal regulations intended to prevent exclusive

use of the State's sign, and protecting public rights to use the State's sign which, pursuant to federal regulations, is in the public domain and not subject to trademark protection.

Therefore, Respondent's laches defense does not apply.

C. To the extent the Board determines that the equitable defenses may be asserted, Respondent has failed to meet its burden to show prejudicial reliance.


To the extent the Board finds that laches and acquiescence may be considered, the facts in this case confirm they do not apply. The equitable defense of acquiescence "is available when a plaintiff has responded to a defendant's actions with implicit or explicit assurances upon which the defendant relied," and focuses on a party's response to the offending action; any response that might constitute acquiescence must come *after* the responding party is aware of the action. *Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 213 F.Supp.2d 247, 276 (S.D.N.Y. 2002) (finding that interviews were not a "response" to allegedly infringing conduct and cannot constitute acquiescence). To prove its laches defense, Respondent has the burden to "demonstrate: (1) a delay in asserting a right or a claim; (2) that the delay was not excusable; and (3) that there was undue prejudice to the party against whom the claim was asserted." *Cross Country Home Services, Inc. v. Home Service USA Corp.*, 2010 WL 331752, *10 (S.D. Fla. 2010).

Here again, Respondent misstates the facts. The State learned of Respondent's trademark claims in 2011 and contacted Respondent to discuss the matter. Michigan businesses in the business of marketing and advancing Michigan businesses, including Michigan Economic Development Corporation (MEDC), through its Pure Michigan campaign, and MiQuest, via a Michigan Celebrates Small Businesses program, recognized Respondent as a successful business. (Exs. 51 and 52.) Respondent accepted the recognition while in discussion with the State about wrongful registration of the State's sign and after the Attorney General's Opinion was issued in 2012. When the parties


reached a stalemate in October 2013, nearly two years after discussions began, Respondent understood that the State would pursue legal or administrative remedies. Ex. 53.

Respondent cannot argue in good faith that it understood the recognition of Respondent's business success in 2013 constituted implicit or explicit assurance that the State did not intend to challenge the validity of the Marks, months after the Attorney General's Opinion was issued and *while* the parties were continuing their efforts to reach an amicable resolution of their dispute over Respondent's trademark claims. Furthermore, Respondent failed to show that the State gave any explicit assurances that it would not seek to protect the public's interest in and rights to use the State's sign based on the language of the MUTCD. In fact, Respondent was fully well aware that the State had every intention to do so. Therefore, Respondent's acquiescence defense fails.

Respondent's laches defense also fails because it cannot demonstrate prejudice, as cancellation of the Marks does not change its ability to conduct business and continue selling products bearing the State's sign. Cancellation simply means that Respondent cannot enforce the Marks against others, which it knew that it did not have the right to do from the start because the State's sign was included in the MUTCD by supplement and the MUTCD prohibits trademark protection for signs in the Manual.⁴ Respondent even revealed that it "has substantially expanded its business in reliance on *Petitioner's inaction*," rather than on a reasonable and good faith basis for seeking trademark protection based on lawful use in commerce. (Response, p. 24.) In other words, Respondent knew that the State's sign was not protectable as a trademark, but applied for registration

⁴ Notably, Respondent claimed that it "has been clearly prejudiced" because the State could have taken action" to cancel the Marks in 2007, although only the Apparel Mark, i.e.,  (Reg. No. 3348635), was registered in December 2007. (Response, p. 23.) Respondent also claimed that, in 2007, it relied on its "ownership of trademark rights" in *both* Marks to grow its business. (Response, pp. 23-24.)

anyway to see if it could get away with it. Prejudice cannot result from Respondent's unreasonable reliance on hijacking trademark rights that it knew or should have known were prohibited by federal regulation. See *Schnur & Cohan*, 223 F.2d at 481-483. Thus, its laches defense fails.

As to delay, Respondent's Retail Mark, i.e.,  (Reg. No. 3992159), was registered on July 12, 2011, less than five (5) years before the State filed this proceeding in 2013. Thus, the State's petition to cancel the registration is not barred by laches. See *Valmor Products Co. v. Standard Products Corp.*, 464 F.2d 200; 174 U.S.P.Q. 353 (1st Cir. 1972).

As for the Apparel Mark, contrary to Respondent's assertion, the State was not notified in May 2010 that the Good Hart Store received a cease and desist letter. Notably, Respondent did not produce a cease and desist letter allegedly sent to Good Hart in or before May 2010. Rather, as shown in Exhibit N to Respondent's brief, in May 2010, the Good Hart Store submitted an inquiry to the State about ownership and rights to use the State's sign. Neither a cease and desist letter nor trademark registration were raised. Rather, the timeline submitted by the Good Hart store confirmed that Respondent first contacted Good Hart in April 2011. (Ex. 45, MDOT000007.) Moreover, because the State's sign was not protectable as a trademark under federal regulation, and has been widely recognized, known and used by the public to refer to northwest Michigan for nearly a century, the State had no reason to suspect that anyone could secure trademark rights so as to require it to track trademark publications, until notified by the Good Hart Store in November 2011. Thus, any delay by the State was excusable. See *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 126 U.S.P.Q. 261 (TTAB 1960) (if the party had no knowledge that its rights were being invaded and was not chargeable with such knowledge, laches does not apply).

Upon receiving notification that Respondent had made trademark infringement

threats, the State promptly undertook an investigation of the matter and reached out to Respondent in an effort to resolve the matter amicably. The parties' representatives discussed the issues and met in person several times over the course of nearly two years. (Exs. 46-49.) In 2012, the Attorney General issued an opinion confirming that the State's sign may not be protected as a trademark. (Ex. 50.) In late 2013, when it became clear the parties could not resolve the matter, the State filed the Petition to Cancel. Any delay as a result of the settlement discussions is not a basis for laches. *Cross Country Home Services, supra*.

Clearly, Respondent failed to establish prejudice or delay, and lacked any good faith basis for claiming that it conducted business in reliance on valid registrations or that the State had abandoned its rights. Indeed, the Supreme Court has confirmed that the State cannot abandon its right to act in the public interest and for the rights of the public. While cancellation of the registrations does not prevent Respondent from continuing to sell its wares with the State's sign, allowing the State's sign to be trademarked harms the State and the public's interest in the sign.

REQUEST FOR RELIEF

Based on the foregoing, together with the facts and argument set forth in the State's Motion, the State respectfully requests that this Board grant summary judgment in favor of the State and cancel the trademark registrations at issue.

Respectfully submitted,

By: /s/Toni L. Harris

Date: October 22, 2015

Toni L. Harris, Assistant Attorney General
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Lansing, MI 48913
Tel: 517-373-1470
Fax: 517-335-6586

EXHIBITS 30 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



Wall

Info

Photos (37)

3,722

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M22

Company · Traverse City, MI

Basic Information

Founded 2003
Location 121 East Front Street
Traverse City, MI, 49684

Company Overview M-22 is not just a road; it is a way of life.

Founded by kiteboarders in search of epic wind and waves, M-22 was created to express a common passion for Northern Michigan. However, M-22 shares this passion beyond Michigan's borders. It is marked by the simplicity and appreciation for natural wonders such as bays, beaches and bonfires, dunes and vineyards, cottages, friends and family everywhere.

M-22 is the feeling you get when you realize there is no other place you would rather be.

Description

The M22 road sign symbol is a protected REGISTERED Trademark with the United States Patent and Trademark Office, an agency of the United States Department of Commerce. For more info visit: <http://m22online.com/products-page/trademark/>

Email sales@m22online.com
Phone 231.360.9090
Website <http://www.m22online.com>

Likes and Interests

Likes Crystal River Outfitters, MyNorth.com the online home of Traverse, Northern Michigan's Magazine, Sleeping Bear Dunes National Lakeshore, Glen Arbor, Grand Traverse Regional Land Conservancy, Art's Tavern Glen Arbor, Fishtown Leland, FLOW for Water, Leelanau Conservancy

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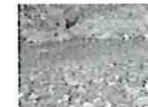


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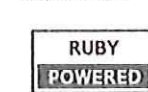
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components. Now
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EXHIBITS 31 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



EXHIBITS 32 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

M22000395

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July 30, 2013

BY FACSIMILE AND REGULAR MAIL

Enrico Schaefer, Esq.
Traverse Legal PLC
810 Cottageview Drive, G-20
Traverse City, MI 49684

Re: Murdick's Fudge Shoppe, LLC

Dear Mr. Schaefer:

I have been retained by Murdick's Fudge Shoppe, LLC ("Murdick's") to defend it against your client's allegations of misuse of the M-22 sign on merchandise in the fudge stores in Suttons Bay and Leland, Michigan. Based upon prior negotiations, correspondence, and proposed settlement agreements originating from your office, I understand that you represent Broneah, Inc. and M22, LLC ("Broneah").

Please be advised that any prior contract executed by Murdick's in an attempt to amicably settle this dispute is hereby revoked and nullified, and any execution by Broneah of that document would not create a valid contract. Further, I kindly reiterate the request of my client's former counsel, Douglas Bishop, that Broneah, and its principals, including Mr. Keegan Meyers, cease any further harassment of my client and its principals and employees, and that all communication be directed to me. I appreciate your assistance in this regard.

Your client's trademark registration of the State of Michigan's M-22 road sign was unlawful and may be cancelled at any time. While the 5 year period for challenging the 2007 filing, which includes a border around the State's design, has generally passed, the defense of a violation of Section 1052(a) of the Lanham Act is a statutory ground for cancelling the trademark that may be raised at any time. It should be noted, however, that the M-22 design being used by Murdick's is the exact replica of the State of Michigan road sign, derived from Google images of the State's sign, which was unlawfully registered by your client on July 12, 2011. This later filing is still well within the five year period for challenge and is absolutely subject to challenge on all grounds.

In either case, Murdick's would be successful in challenging the erroneous registration of Michigan's highway sign because, *inter alia*, the registration falsely suggests a connection with the State and the Michigan Department of Transportation ("MDOT"). In his opinion dated May 29,

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Enrico Schaefer, Esq.
Traverse Legal PLC
July 30, 2013
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2012, the Michigan Attorney General made it clear that the federal Manual on Uniform Traffic Control Devices "is consistent with case law establishing that materials or works in the public domain are not subject to trademark protection," and that "Michigan's highway route marker design cannot – indeed 'shall not' – be subject to trademark protection." While legal issues involving trademarks are generally a matter of federal law, the Attorney General was absolutely correct in citing Section 1052(a) of the Lanham Act, which precludes trademarks that "falsely suggest a connection with persons, living or dead, [or] institutions," including the State of Michigan. The design has been used in and by the State, and within the public domain, for decades, and the State's reputation is inextricably associated with the design of the highway it designed, built, and maintains, and for which it expended public funds, and manufactured and posted signage. The State did not approve or grant your client exclusive use of its design, and your client did not disclose the false association between this design and the State to the U.S. Patent and Trademark Office.

In his pursuit of Murdick's, apparently outside the scope of your advice and representation, Mr. Keegan Meyers is harassing and interfering with Murdick's business operation, calling the business telephone(s) multiple times each day and going into the stores to harass and intimidate my client and its employees. All of these actions have been documented, and are intended to extort a settlement from my client that unlawfully forces the business to permanently discontinue certain sales to consumers and acknowledge an ownership interest by your client in the M-22 design that does not exist as a matter of law. Our information further confirms that your client has engaged in this type of abusive, illegal activity with other area retailers.

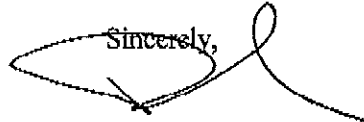
With respect to Murdick's, your client is advised that it will not be extorted into executing an illegal agreement. Murdick's will protect its business and right to lawfully sell products to its customers, including products it currently carries that bear the State's M-22 design. Thus, if your client seeks to enforce its specious trademark, or fails to immediately stop its unlawful conduct, Murdick's will seek to hold it liable for false competition in violation of the Lanham Act, unfair trade practices under the Michigan Consumer Protection Act, and unfair competition and tortious interference with prospective business advantage under the common law. Under such laws, Murdick's would be entitled to injunctive and declaratory relief, business damages and reasonable attorneys' fees. To be sure, it would seek to fully and finally resolve issues related to the termination of your client's purported trademark and the protection of Murdick's business.

Presently, Murdick's does not intend to expend the resources necessary to seek cancellation of your client's trademark. Rather, it would prefer to coexist and no longer be harassed by your client. Nevertheless, if the harassment continues, or if suit is brought by your client, Murdick's will, without further notice or demand, fully protect its legal rights by pursuing all of its remedies against your client, including, without limitation, by counterclaim, suit, and/or Petition for Cancellation before the U.S. Patent and Trade Office.

M22000397

Enrico Schaefer, Esq.
Traverse Legal PLC
July 30, 2013
Page 3

I trust this correspondence will end the conflict between our clients. Nevertheless, feel free to contact me if you have any questions or concerns.

Sincerely,

Douglas Fierberg

DEF/cdd
cc: Ms. Michelle Murdick, Murdick's Fudge Shoppe, LLC

August 27, 2013

dfierberg@bode.com
Douglas E. Fierberg, Esq.
Bode & Grenier, LLP
1150 Connecticut Avn NW, Ste. 900
Washington, DC 20036

Re: Murdick's Fudge Shoppe, LLC

Dear Mr. Fierberg:

Thank you for your letter dated July 30, 2013. Please be advised that all prior settlement offers to Murdick's Fudge Shoppe, LLC ("Murdick's") are hereby withdrawn. It appears you are intent on challenging our clients' M22 trademarks based on confusion with an institution, i.e. the State of Michigan. Our clients have spent seven years developing the M22 brand. You should be aware that in the tens of thousands of customers who have frequented that store in that time, there is no record or evidence of any single customer ever believing that the store or products were in any way affiliated, sponsored, owned or affiliated to the State of Michigan. Moreover, your client lacks standing to challenge the marks on Section 2(a) grounds. I would recommend that you review case law in this particular area, which is very favorable to our clients' position.

In *Internet, Inc. v. Corporation for Nat'l Research Initiatives*, 38 U.S.P.Q.2d 1435 (T.T.A.B. 1996), TTAB address this very issue squarely. A mark contested under Section 2(a) "must point uniquely and unmistakably to the identity or persona of the 'person' or 'institution' asserting the claim." *Id.* at 1437 (emphasis added). Stating this point even more clearly, the court in *Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc.* said, "to raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the *institution itself*." 43 U.S.P.Q.2d 1193, *3 (D.D.C. 1997) (emphasis added) (finding that because the defendant was not United States Congress or the D.C. Metropolitan Police Department, it was not entitled to raise a claim that plaintiff's mark falsely suggests a connection with those institutions); *see also Petroleos Mexicanos v. Intermix S.A.*, 97 U.S.P.2d 1403, *2 (T.T.A.B. 2010) (Petitioners seeking cancellation of a trademark have standing to raise a Section 2(a) claim based on their identity is institutions). Additionally, several other TTAB decisions, though non-precedential, offer persuasive guidance on this point. *E.g.*, *Cavern City Tours Ltd. v. Hard Rock Cafe Int'l, Inc.*, Cancellation No. 92044795, 2011 WL 5014033 (T.T.A.B. Sept. 29, 2011) (noting that to prevail on its 2(a) claim, the petition must show that the mark at issue was *the petitioner's* identity); *Bridgewater Candle Company, LLC v. Elephant Design Limited*, Cancellation No. 30,658, 2002 WL 122608 (T.T.A.B. Jan. 30, 2002) (stating that Petitioner was not entitled to assert a claim on behalf of Emma Bridgewater and its allegation that Respondent's mark falsely suggests a connection with Emma Bridgewater constituted an admission by Petitioner that the mark does not point uniquely and

unmistakably to *Petitioner*, thus its Section 2(a) claim failed). Because your client is neither the State of Michigan or any subdivision or entity thereof, such as the Department of Transportation, your client cannot possibly show that our clients' M22 marks "point uniquely and unmistakably to [Murdict's] identity or persona." *Internet, Inc.*, 38 U.S.P.Q.2d at *1-2.

Even if Murdict's *did* have standing to petition for cancellation of the M22 marks on Section 2(a) grounds, cases decided on such grounds make it clear that false association might arguably occur when the institution or government is using the mark in connection with the same services as the trademark holder. For example, if our clients attempted to open a toll road and use the M22 marks in connection therewith, consumers travelling such road might falsely believe that the road was operated by the State of Michigan. *See In re Cotter & Co.*, 228 U.S.P.Q. 202 (TTAB 1985) (WESTPOINT for firearms was rejected as falsely suggesting a connection with the U.S. Military Academy (West Point)). Conversely, where the government has no existing fame or notoriety with regard to the goods being offered by the trademark owner, there can be no false association. *See Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc.*, 43 U.S.P.Q.2d 1193 (D.D.C. 1997) (a composite mark consisting of the word HEROES on a shield design with a picture of the U.S. capitol building in the shield does not violate Section 2(a) because it does not mislead persons into assuming that the U.S. government has sponsored or approved of the charitable services symbolized by the mark); *see also U.S. Navy v. United States Manufacturing Co.*, 2 U.S.P.Q.2d 1254 (T.T.A.B. 1987) (When used on orthopedic devices, the letters USMC did not point uniquely to the United States Marine Corps).

Similarly, there is no reasonable claim to be made under Section 2(b). Section 2(b) identifies a number of items associated with government functions that are specifically precluded from registration. Specifically, Section 2(b) precludes registration of "the flag or coat of arms or other insignia of the United States, or any State of municipality, or any simulation thereof." *See also* TMEP § 1204.02(a) ("Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority.") "Other insignia" is meant to be read narrowly and "include[s] only those emblems and devices that also represent governmental authority." Road signs clearly fall outside of Section 2(b)'s prohibitions, but in case there is doubt, TTAB made clear that "department insignia which are merely used to identify a service or facility of the Government are not insignia of national authority and that they therefore do not fall within the general prohibitions of this section of the Statute." *In re United States Dep't of the Interior*, 142 U.S.P.Q. 506, 507 (T.T.A.B. 1964). Thus, they fall outside the scope of Section 2(b). There is no 'catch-all' provision that exempts other government landmarks, buildings, symbols or designs, thus making them available for trademark use and registration. In fact, the USPTO Design Search Code Manual contains a category specifically for design marks that contain traffic or road signs, Category 18. *See* http://tess2.uspto.gov/tmdb/dscm/dsc_18.htm#18 (Note, in particular, category 18.15.03.). Your client's lack of standing aside, we are having some difficulty understanding specifically what grounds Murdict's would defend a trademark infringement lawsuit, file a counterclaim or file Petition for Cancellation.

As you are also aware, neither the Michigan Attorney General or the federal Manual on Uniform Traffic Control Devices is remotely relevant to trademark registration under the Lanham Act. Your suggestion that enforcement of our trademark is somehow "extortion" is both unprofessional and unsubstantiated. We will aggressively protect our clients' marks

including by way of federal court complaint and by way of registrations and/or other necessary action before the USPTO. We will pursue all damages available under law and, given the frivolous nature of your defense, we will pursue an action for willful infringement by your client. We are confident that maximum damages will be awarded under the law well into seven figures. Not only may our clients recover Murdick's profits, damages sustained and costs of the action, *see* 15 U.S.C. § 1777(a), but in a case involving willful infringement such as this, our clients may instead elect to recover statutory damages in the amount of \$2,000,000 per counterfeit mark per type of goods/services sold, offered for sale, or distributed, *see* 15 U.S.C. § 1117(c)(2); *see also* 15 U.S.C. §§1114-1125. While we understand that you may be representing Murdick's pro bono (at least that is what your client has indicated to our client), the liability belongs to Murdick's. Any judgment or award will be paid by Murdick's.

Your letter fails to indicate whether or not Murdick's intends on continuing to sell goods including the M-22 trademarks. Please provide us with a clear statement of your client's intent.

In the meantime, do not hesitate to contact me if you have any further questions. I look forward to working with you on this important matter.

Very truly yours,

Traverse Legal, PLC

A handwritten signature in black ink, appearing to be 'ES' with a large loop and a trailing flourish.

Enrico Schaefer
Attorney at Law
enrico@traverselegal.com

CES/plb

EXHIBITS 33 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

August 17, 2010

Riverside Canoe Trips
5042 N. Scenic Hwy
Honor, MI 49640
(231) 325-5622

RE: Unlawful use of mark confusingly similar to M22

Dear Sir or Madam:

We represent the interests of M22, LLC, a corporation organized under the laws of the State of Michigan. M22, LLC is a retailer of clothing, sporting goods, and novelty items, which it sells through its M22 retail brick and mortar and online stores. Local kiteboarding icons Matt and Keegan Myers, the founders of M22, LLC, created the M22 brand to pay tribute to the northern Michigan road of the same name and the natural beauty of its surrounding areas.

M22, LLC has used the M22 mark in association with its line of products since November 2007. The M22 mark has been extensively and exclusively used and advertised as a designator of source for our client's products, and the M22 mark has been displayed nationally, such as in the photograph attached as Exhibit A, which was widely distributed across the United States on the cover of Traverse Magazine. Further, our client has displayed the M22 mark in association with the advertisement and sale of products through its website located at <http://m22online.com>. As such, our client has obtained common law trademark rights in the M22 mark.¹

It has recently come to our attention that you have adopted and are currently using a mark that is identical to our client's M22 mark. Specifically, you are currently using the M22 image mark in association with your sale of stickers and other novelty items, as evidenced by the attached Exhibit B. This letter serves as your notice that you have infringed upon our client's trademark rights. As such, you face liability for trademark infringement.

Section 45 of the Lanham Act states that a mark is used in commerce when it is "is placed in any manner on the goods or their containers or the displays associated therewith..."²

¹ See *Trade-Mark Cases*, 100 U.S. 82, 94 (U.S. 1879) (holding that common law trademark rights are created through use in commerce).

² See 15 U.S.C. 1127.

August 17, 2010
Page 2 of 3

Trademark ownership, in turn, is determined through the priority of use of a mark in commerce in association with goods or services.³ Our client has used the M22 mark in association with its goods since November 2007. As such, our client gained common law rights in the M22 mark prior to your use of the same mark. Additionally, our client is the holder of registrations for the M22 in a variety of International Classes for use in association with several different goods or services. Evidence of these registrations is attached to this letter as exhibit C.

One may be held liable for trademark infringement where one uses, without the consent of the trademark holder, a mark that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person."⁴ Where trademark infringement is established, the mark owner may recover the defendant's profits, as well as the mark owner's actual damages and costs of the action.⁵

Your adoption and use of a mark that is likely to cause confusion, to cause mistake, or to deceive as to the affiliation of M22, LLC with Riverside Canoe Trips, namely, your use of the M22 mark, has subjected you to liability for trademark infringement. As such, you may be held liable for significant monetary damages.

In light of the foregoing, we hereby request that you **comply with the following by September 6th, 2010:**

1. Cease and desist any and all use of our client's M22 mark, or any colorable imitation thereof, that is likely to cause consumer confusion;
2. Provide an accounting of all profits made from the use of M22 to sell stickers and other goods featuring the mark;
3. Destroy any and all marketing materials, catalogs, labels, or the like that use M22 to indicate the source of your goods and provide evidence and confirmation of same;
4. Provide confirmation, in writing, of compliance with the above demands.

Your failure to comply with these requests by the date mentioned above may subject you to a lawsuit for trademark infringement. Should you wish to continue selling stickers bearing our client's M22 mark after September 6, 2010, our client would be happy to sell them to you for their resale price. Understand that our client respects your longstanding support of the local community and your commitment and contribution to the spirit of northern Michigan.

³ See *Western Stove Co. v. Geo. D. Roper Corp.*, 82 F. Supp. 206, 217 (D. Cal. 1949).

⁴ See 15 U.S.C. 1125(a)(1).

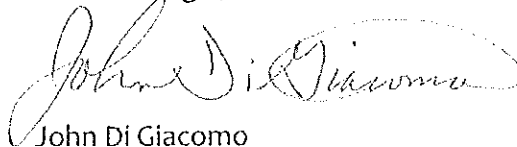
⁵ See 15 U.S.C. 1117(a).

August 17, 2010
Page 3 of 3

You must understand, however, that the M22 brand is the intellectual property of our client and, as such, must be consistently and vigorously protected. Please contact me directly, or have your attorney contact me directly, at 231-932-0411 if you have any questions.

Very truly yours,

Traverse Legal, PLC

A handwritten signature in black ink, appearing to read "John Di Giacomo", written in a cursive style.

John Di Giacomo
john@traverselegal.com

EXHIBITS 34 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

traverselegal

ATTORNEYS & ADVISORS

September 17, 2008

VIA EMAIL

Michael Boks
michael@graar.org
mjboks@hotmail.com

Re: Unauthorized Use of M22, LLC's Federally Registered M22 Trademark

Dear Mr. Boks:

This law firm represents the interests of M22, LLC. The purpose of this letter is to notify you of your unauthorized use of our client's M22® trademark (the "Mark").

Our client offers men's, women's, and children's clothing apparel and accessories. Its products have been available in stores throughout Northern Michigan, including, for example, Harbor Wear in Suttons Bay, Harbor House in Leland, Totem Shop in Glen Arbor, Bay Wear in Frankfort, and Five Corners in Beulah since 2004. Since its opening in November 2007, its products have also been available at its M22 Store located at 121 East Front St., Suite 104, Traverse City, Michigan 49684 as well as online at www.m22online.com. See Exhibit A, Picture of Storefront and Inside.

Our client has spent considerable sums of money on advertising and promotion. See Exhibit B, Various Advertisements and Promotional Materials. Moreover, our client also offers M22® wine from wineries and stores throughout Northern Michigan and beyond. As a result, consumers recognize our client as the source of the products and services associated with its marks.

As part of its business, our client exclusively uses its trademarks as the distinctive identifiers of its products. In fact, our client is the owner of the following trademarks with the United States Patent and Trademark Office:

1. M 22 M22ONLINE.COM
Registration Number: 3348635
International Class: 025. Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops.

September 17, 2008

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First Use In Commerce Date: 20040101

Filing Date: August 29, 2006

2. M22

Registration Number: 3427900

International Class: 033. Wine.

First Use In Commerce Date: 20071000

Filing Date: June 4, 2007

Through our client's registration of the M22® trademark, continuous use of M22® as part of its products since 2004, Internet presence at the m22online.com domain, and operation under the M22, LLC trade name, the M22® mark has become the distinctive identifier and well-known source of its clothing apparel, accessories, and wine. Through its continuous and extensive efforts, our client has established tremendous value and goodwill in its Mark.

In order to protect the significant goodwill associated with its Mark, our client makes reasonable efforts to prevent the unauthorized use of its marks, terms, or names by others that cause confusion as to the source of products or services as well as to the sponsorship, affiliation, or endorsement by or with its product offerings. Our client even provides notice to consumers and competitors alike of its trademark rights, as seen in its Catalog. See Exhibit C, Printout of Catalog, including M-22 Policies & Information.

That said, it has come to our attention that you used our client's Mark without authorization at <http://www.cafepress.com/m22highway>. Our client has already contacted Cafepress to stop your offering for sale of infringing goods and to limit the consumer confusion that has likely occurred already. You appear to be offering identical goods using an identical mark. Our client, without waiving any of its rights or claims, is willing to give you the benefit of the doubt that your use of the Mark was due to your lack of understanding of trademark law, which is set forth for your benefit in more detail below.

LAW:

Trademark Infringement

A trademark protects a company's source, product, and corporate reputation. Another's use of someone's trademark violates Section 43(a) of the federal Trademark Act, which "prohibits any false designation of origin or false or misleading representation of fact that is likely to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person" *One World Botanicals Ltd. v. Gulf Coast Nutritionals, Inc.*, 987 F.Supp. 317, 331

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(D.N.J.1997). A finding of liability by a court of law will revolve around a determination of whether or not a "defendant's use of a disputed mark is likely to cause confusion among consumers regarding the origin of the goods offered by the parties." *Id.* "Nevertheless, the more similar the marks in terms of appearance, sound, and meaning, the greater the likelihood of confusion." *Brookfield Communs., Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999). Of particular note in this matter when comparing the marks, significant similarity in appearance is all that is needed even if the consumer can differentiate between the two products. See *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532 (2nd Cir. 2005).

As such, you have no rights to M22®, and any subsequent use of any counterfeit mark would subject you to statutory damages of \$100,000. Furthermore, any continued use would be willful and further subject you to both legal and financial exposure, including disgorgement of any and all profits you have obtained, treble damages, and costs of any action we choose to pursue, which may include injunctive relief. Moreover, your familiarity with the Mark due to your apparent location in Grand Rapids, Michigan (upon information and belief) would only strengthen our claims of willful infringement.

REQUESTS:

Now that we have provided you with a better understanding of the law and your potential legal exposure should you continue to use M22®, or any colorable imitation of our client's mark, as a trademark, we are confident you will cease and desist all use. Should you decide to move forward with any use of M22®, or any colorable imitation of our client's marks, we demand you keep all evidence of use, all revenue attributable to the sale of the infringing items, and all associated expenses attributable to the sale of the infringing items. Failure to do so subjects you to claims of spoliation of evidence. If you have any questions, we encourage you to consult with an attorney

Ultimately, our client prefers to amicably resolve this with you directly. That said, your failure to reply to this letter will force our client to consider court intervention, which may include injunctive relief. As such, we would ask that you immediately:

1. Cease and desist any and all use of our client's M22® trademark, or any colorable imitation thereof;
2. Not produce, advertise, market, promote, sell, distribute or otherwise use our client's M22® trademark, or any colorable imitation thereof, in connection with any clothing or other products or services that would be likely to cause consumer confusion as to source or origin;
3. Not use M22® in such a way that would create a likelihood of consumer confusion, dilute the Mark, or otherwise damage the M22 Mark or M22, LLC; and

September 17, 2008

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4. Sign and return the below agreement.

Do not hesitate to contact us directly at 231-932-0411 or enrico@traverselegal.com. We hope to be able to avoid the consumer confusion that would undoubtedly occur should you proceed with any use of our client's Mark.

Sincerely,

TRAVERSE LEGAL, PLC




Enrico Schaefer
enrico@traverselegal.com

ES/bah
Enclosure

I, Michael Boks, hereby acknowledge and agree that I will adhere to the demands set forth in the attached letter, namely: (1) I will cease and desist any existing and planned and any and all other use of the M22 Mark, or any colorable imitation thereof; (2) I will not produce, advertise, market, promote, sell, distribute, or otherwise use the M22 Mark, or any colorable imitation thereof, in connection with any clothing or other products or services that would be likely to cause consumer confusion as to its source or origin; and (3) I will not use the M22 Mark, or any colorable imitation thereof, in such a way that would create a likelihood of consumer confusion, dilute the M22 Mark, or otherwise damage the M22 Mark or M22, LLC. I further acknowledge and agree that I have read and understand this agreement.

Date: 9-17-08

By: 
Name Printed: Michael Boks



M22 Stickers

Show your Love for Michigan Highway 22

Buy Now

Choose your Sticker Size

These bumper stickers are made from extremely high quality outdoor vinyl and will last for many years on your car.



Large 4" Sticker

1 Sticker for \$2

[Buy Now](#)

5 Stickers for \$5

[Buy Now](#)



Mini 2" Sticker

1 Sticker for \$1

[Buy Now](#)

5 Stickers for \$3

[Buy Now](#)

FREE SHIPPING!

About the design

The Michigan Highway 22 Roadsign and all other Michigan Highway roadsigns are Public Domain. Please feel free to download this design and print and share as many copies as you want with friends and family.

According to Michigan Attorney General Bill Schuette:

(<http://www.ag.state.mi.us/opinion/datafiles/2010s/op10344.htm>) "No entity can lawfully claim exclusive control over use of the State's highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law."

"Because the State of Michigan, the creator of the design, placed the Michigan highway route marker design in the public domain, no entity can lawfully obtain intellectual property protection of the design under trademark

or copyright law"

"Any other individual or company is also free to use the design to promote commercial goods and services."

This domain name is for sale

Email us (<mailto:mail@m22sticker.com>) for details

EXHIBITS 35 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

TRAVERSE^{legal}.

ATTORNEYS & ADVISORS

May 3, 2010

VIA CERTIFIED MAIL and EMAIL (director@benzie.org)

Benzie County Visitors Bureau
PO Box 204
Benzonia, MI 49616

Re: Unauthorized Use of M22 (Serial No. 78963038)

Dear Sir/Madam :

This firm represents M22, LLC, which is the owner of the distinctive trademark M22 (the "Mark") under the following registration information:

Serial No.: 78963038
International Class: 025
For Apparel Specifically Hats, T-Shirts, Long Sleeve Shirts, Sweat Shirts, Pants, Shorts,
Underwear, Tank Tops, in Class 25 (U.S. Cls. 22 and 39)
First Use Date: 01-01-2004
First Use in Commerce Date: 01/01/2004

Our client's use of the M22 trademark ("Mark") dates back to at least as early as January 2004.

Ever since, our client has used its Mark to identify and distinguish the source of its merchandise, apparel, coffee, wine and other products and services to the local and tourist communities. The Mark has become well-known and famous throughout the region, and through its efforts, our client has established tremendous value and goodwill associated with the Mark. In order to protect the significant goodwill associated with the Mark, our client must take efforts to prevent the use of trademarks, service marks, terms, or names by others that cause confusion as to the source of products or services as well as to the sponsorship, affiliation, or endorsement by or with our client's mixed use community.

It has come to our attention that you have recently attempted to register a nearly identical Mark with the United States Patent and Trademark Office. While our initial thought from reviewing your website is that you did not appear to be using the Mark as a "trademark", your direct attack on my client's trademark registration cannot be ignored. While the Trademark Office has shut you down based on what should have been obvious to you in the first place, that there would be a strong likelihood of confusion between your proposed

May 3, 2010

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mark and our prior registration, we are now forced to do whatever is necessary in order to protect our client's substantial investment in this brand. We have a hard time believing that you did not specifically intend to leverage the tremendous success my client's Mark has had in the marketplace and essentially divert business otherwise created by or directed to my client.

THE LAW:

Section 43(a) of the federal Trademark Act, which "prohibits any false designation of original or false or misleading representation of fact that is likely to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person" *One World Botanicals Ltd. v. Gulf Coast Nutritionals, Inc.*, 987 F.Supp. 317, 331 (D.N.J.1997); *Opticians Ass'n. of America v. Independent Opticians of America*, 920 F.2nd 187, 192 (3rd Cir. 1990). A finding of liability by a court of law will revolve around a determination of whether or not a "defendant's use of a disputed mark is likely to cause confusion among consumers regarding the origin of the goods offered by the parties." *Id.*

Use of another's trademark constitutes infringement even when some dissimilarity in the form of the trademark exists. See *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377, 380 (8th Cir. 1965); see also *Calamari Fisheries, Inc. v. Village Catch, Inc.*, 8 USPQ.2d 1953 (D.C. Mass. 1988) (holding that THE VILLAGE CATCH for plaintiff's restaurants so resembles defendant's use of DAILY CATCH in the same city so as to not allow the use of CATCH in 2 or 3 word restaurant titles). As long as there is a likelihood of confusion, a plaintiff will prevail. See *River Hotel Co. v. La Mansion on Bay, Inc.*, 228 USPQ 622 (N.D. Fla. 1985) (holding that another's use of the identical combination of words, La MANSION, for competing services involving hotels and condominiums is likely to cause confusion); see also *Blumenfeld Dev. Corp. v. Carnival Cruise Lines, Inc.*, 4 USPQ.2d 1577 (E.D. Pa. 1987) (holding that CARNIVAL CLUB for hotel and casino is likely to cause confusion with established use of CARNIVAL for cruise line).

In addition, a mark need not be registered in order to be entitled to find one who engages in trademark infringement or unfair competition liable. See *Deyerle v. Wright Mfg. Co.*, 496 F.2d 45 (6th Cir. 1974) (holding that Section 43(a) of the Lanham Act may be violated even though the injured party did not have a federally registered trademark); see also *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194 (9th Cir. 1979) (holding that unfair competition under the Lanham Act for using trademark and trade names applies equally to registered and unregistered marks). Therefore, with regard to other uses of the mark which have not been registered, our client still maintained prior common law trademark rights.

May 3, 2010
Page 3 of 4

YOUR UNAUTHORIZED USE SUBJECTS YOU TO LIABILITY:

You were undoubtedly aware of our client's use of "M22" as its Mark when you copied their business model and Mark. You are purposefully incorporating our client's Mark in the same tourist niche market, geographical region, and consumer base targeted by our client.

The fact that you have copied the substantial and distinctive portion of our client's Mark constitutes infringement even when some dissimilarity in the form of the trademark exists.

Nevertheless, if forced to seek court intervention to prevent your use of our client's Mark, we are extremely confident that all of the facts and law set forth above will render a decision enjoining your continued use of "M22." See *Bishops Bay Founders Group, Inc. v. Bishops Bay Apts., LLC*, 74 USPQ.2d 1877 (W.D. Wis. 2003) (granting plaintiff's motion for preliminary injunction in its trademark infringement action because plaintiff showed a likelihood of success on the merits of its Lanham Act claim since the evidence demonstrated that although its mark was connected to a geographic description, the mark had achieved secondary meaning and defendant's use of its mark was likely to diminish distinctive qualities of the mark, which was associated with its luxury community, because defendant's apartment complex was not on part with plaintiff's development).

A. Statutory Damages for Trademark Infringement

Under the Lanham Act, a court may award a minimum of \$ 500.00, and a maximum of \$ 100,000.00 "per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just . . ." 15 U.S.C. § 1117(c)(1). If the court finds that the use of the counterfeit mark was wilful, the maximum limit of statutory damages is raised to \$ 1,000,000.00. 15 U.S.C. § 1117(c)(2). An infringement is wilful, and thus triggers the enhanced statutory damages limit, if the defendant "had knowledge that its actions constitute an infringement." *N.A.S. Import, Corp. v. Chenson Enters., Inc.*, 968 F.2d 250, 252 (2nd Cir. 1992). [**28] Actual knowledge is not required, and constructive knowledge will suffice to trigger the enhancement. Thus, knowledge need not be proven directly, but may be inferred from the defendant's conduct. A defendant's continued infringement after notice of his wrongdoing is probative evidence of willfulness. *Int'l Korwin Corp. v. Kowalczyk*, 855 F.2d 375, 380-81 (7th Cir. 1988) (willfulness may be demonstrated where the infringer is provided notice of its infringing conduct). Paragraphs 10, 12-31, and 47 of the Complaint, together with Paragraph 3 and Exhibits C-E of the Zumwalt Declaration, assert that Defendants have persisted in their unlawful and infringing use of Ford's trademarks, despite their receipt of actual notice that their actions were unauthorized. Plaintiff has cited authority for the proposition that a successful plaintiff in a trademark infringement case is entitled to recover enhanced statutory damages even where its actual damages are nominal or non-existent. *Peer Int'l*, 909 F.2d at 1336-37; *Superior Form Builders, Inc. v. Dan Chase*

May 3, 2010
Page 4 of 4

Taxidermy Supply Co., Inc., 74 F.3d 488, 496-98 (4th Cir. 1996). Ford has also cited cases [**29] which have recognized the deterrent effect of statutory damages as a proper objective. Fitzgerald Publ'g Co. v. Baylor Publ'g Co., 807 F.2d 1110, 1117 (2nd Cir. 1986). Ford Motor Co. v. Cross, 441 F. Supp. 2d 837, 852 (D. Mich. 2006)

DEMANDS:

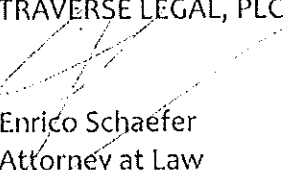
Our client is prepared to take all necessary actions to protect its valuable trademark rights in its Mark. Your use of our client's mark subjects you to treble damages, costs, attorney's fees, and a potential \$100,000 penalty for your willful and knowing infringement, as provided under the Lanham Act.

No later than May 10, 2010, we demand that you:

1. Cease and desist use of the "M22" logo as part of your advertising campaign.
2. Contact me, or have your attorney contact me, to discuss a release of liability for reasonable compensation.
3. Initiate corrective advertising; specifically stating in all materials, marketing or otherwise, that all material associated with your company is in no way connected with our client.
4. Agree in writing that you will not infringe on the trademark of our client again.

If forced to litigation, we will pursue all monetary penalties available under law. However, in an effort to amicably resolve this matter, we would prefer to avoid litigation. As such, I look forward to speaking with you.

Sincerely,
TRAVERSE LEGAL, PLC


Enrico Schaefer
Attorney at Law
enrico@traverselegal.com

Enclosure

EXHIBITS 36 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

M22000070

TRAVERSE^{legal}

ATTORNEYS & ADVISORS

810 Cottageview Dr. 231-932-0311
Suite G-20 231-932-0636 fax
Traverse City
Michigan 49684 traverselegal.com

July 13, 2010

Nicholas DeGrazia
Sandy White
MI Thumbprint
3650 Shorewood Drive
North Lakeport, MI 48059
Phone: (810) 327-6569
Email: thumb1@mithumbprint.com

RE: Unlawful use of mark confusingly similar to M22

Dear Sir or Madam:

We represent the interests of M22, LLC, a corporation organized under the laws of the State of Michigan. M22, LLC is a retailer of clothing, sporting goods, and novelty items, which it sells through its M22 retail brick and mortar and online stores. Local kiteboarding icons Matt and Keegan Myers, the founders of M22, LLC, created the M22 brand to pay tribute to the northern Michigan road of the same name and the natural beauty of its surrounding areas.

M22, LLC has used the M22 mark in association with its line of products since November 2007. The M22 mark has been extensively and exclusively used and advertised as a designator of source for our client's products, and the M22 mark has been displayed nationally, such as in the photograph attached as Exhibit A, which was widely distributed across the United States on the cover of Traverse Magazine. Further, our client has displayed the M22 mark in association with the advertisement and sale of products through its website located at <http://m22online.com>. As such, our client has obtained common law trademark rights in the M22 mark.¹

It has recently come to our attention that you have adopted and are currently using a mark that is confusingly similar to our client's M22 mark. Specifically, you are currently using M25 in association with your sale of t-shirts, as evidenced by the attached Exhibit B. This letter serves as your notice that you have infringed upon our client's trademark rights. As such, you face liability for trademark infringement.

¹ See *Trade-Mark Cases*, 100 U.S. 82, 94 (U.S. 1879) (holding that common law trademark rights are created through use in commerce).

July 13, 2010
Page 2 of 2

Section 45 of the Lanham Act states that a mark is used in commerce when it is "is placed in any manner on the goods or their containers or the displays associated therewith..."² Trademark ownership, in turn, is determined through the priority of use of a mark in commerce in association with goods or services.³ Our client has used the M22 mark in association with its furniture since November 2007. As such, our client gained common law rights in the M22 mark prior to your use of M25 in association with t-shirts. Furthermore, our client has registered the M22 mark, as evidenced by the certificate attached as Exhibit C. Such a certificate "shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate..."⁴

One may be held liable for trademark infringement where one uses, without the consent of the trademark holder, a mark that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person."⁵ Where trademark infringement is established, the mark owner may recover the defendant's profits, as well as the mark owner's actual damages and costs of the action.⁶ Further, the owner of a registered mark may recover up to \$2,000,000 in statutory damages per mark infringed.⁷

Your adoption and use of a mark that is likely to cause confusion, to cause mistake, or to deceive as to the affiliation of M22, LLC with MI Thumbprint, namely, your use of M25, has subjected you to liability for trademark infringement. As such, you may be held liable for significant monetary damages, costs, and attorneys fees.

In light of the foregoing, we hereby demand that you comply with the following by Monday, July 19, 2010:

1. Cease and desist any and all use of our client's M22 mark, or any colorable imitation thereof, that is likely to cause consumer confusion;
2. Provide an accounting of all profits made from the use of M25 to sell t-shirts;
3. Destroy any and all marketing materials, catalogs, labels, or the like that use M25 to indicate the source of your t-shirts and provide evidence and confirmation of same;
4. Provide confirmation, in writing, of compliance with the above demands.

² See 15 U.S.C. 1127.

³ See *Western Stove Co. v. Geo. D. Roper Corp.*, 82 F. Supp. 206, 217 (D. Cal. 1949).

⁴ See 15 U.S.C. 1057(b).

⁵ See 15 U.S.C. 1125(a)(1).

⁶ See 15 U.S.C. 1117(a).

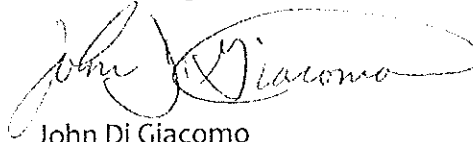
⁷ See 15 U.S.C. 1117(c)(2).

July 13, 2010
Page 3 of 3

Your failure to comply with these requests by the date mentioned above may subject you to a lawsuit for trademark infringement. Our client reserves all rights under the law, including the right to initiate a trademark infringement lawsuit at any time and without notice to you. Please contact me directly, or have your attorney contact me directly, at 231-932-0411 if you have any questions.

Very truly yours,

Traverse Legal, PLC

A handwritten signature in black ink, appearing to read "John Di Giacomo", with a large, sweeping flourish extending from the end of the name.

John Di Giacomo
john@traverselegal.com

EXHIBIT A

NORTHERN MICHIGAN'S MAGAZINE

Traverse

WARM WATER BIG SUMMER

Out & up WITH THE
► Kiteboarding
Broneah brothers

**Paddle the Beaver
Islands' Bizarre
and Mystic Past**

**LIGHT THE
BONFIRE!**

*The North's great dogs,
mustards and brews*

plus

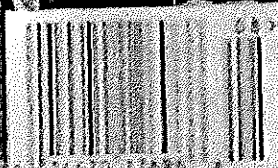
**THE GREAT LAKES'
DISAPPEARING
SHRIMP p.50**

**RECIPE FOR DRUNK
MUSKMELON p.123**

**ANTIQUING
WEEKENDS p.37**

**HOW TO
SNORKEL
A RIVER**

PAGE 66

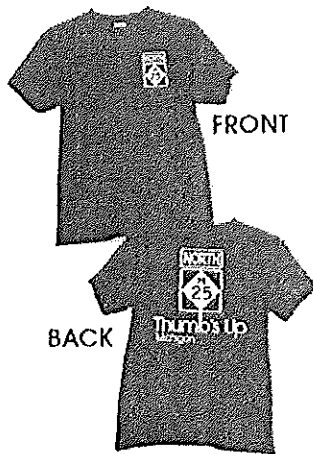


AUGUST 2006

\$3.95

EXHIBIT B

[HOME](#) [SHOP ONLINE](#) [RETAIL LOCATIONS](#) [WHOLESALE](#) [GET A FREE SHIRT!](#) [GALLERY](#) [ABOUT US](#) [CONTACT US](#) [LINKS](#)



[View Full-Size Image](#)

M-25 T-Shirt

Price: \$22.00

[Ask a question about this product](#)

Okay, well, right now all we have is this really cool T-shirt, but we'll be happy to send you THUMB, or even just one. A shirt is \$22 plus 6 percent MI tax. Shipping is free. 'Cuz why not?

MI Thumbprint shirts are printed in the USA with eco-friendly water-based ink, both soft to the touch and durable in the wash.

Proceeds of the sale of this shirt are being donated to the SC4 Foundation, earmarked for scholarships at St. Clair County Community College in Port Huron.

Are these T-shirts not the perfect gift for anyone who lives, works or vacations along M-25 - in or near Michigan burghs like Port Huron, Lakeport, Lexington, Port Sanilac, Applegate, Forester, Richmondville, Forestville, White Rock, Harbor Beach, Port Hope, Grindstone City, Port Austin, Pointe aux Barques, Caseville, Bay Port, Sebewaling, Unionville, Wisner, Quanicasssee - and all the way into Bay City?

Bumper decals coming soon!

A small discreet statement of Thumb pride for your bumper, boogie board or book bag.

Please email if you want to be notified when they're available.

Availability

Usually ships in:

24 h
Express Shipping

Size: <input type="text" value="Small"/>
Quantity: <input type="text" value="1"/> <input type="button" value="Add to Cart"/>

USER MENUS

Username:

Password:

Remember Me: ☐

[Forgot your password?](#)

[Forgot your username?](#)

[Create an account](#)

[Show Cart](#)

Your Cart is currently empty.

EXHIBIT C



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Jul 13 03:56:20 EDT 2010

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DCT](#) [SEARCH LOG](#) [BOTTOM](#) [HELP](#) [PREV LIST](#) [CURR LIST](#)
[NEXT LIST](#) [FIRST DOC](#) [PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: OR [Jump](#) to record: **Record 3 out of 4**

[TARR Status](#) [ASSIGN Status](#) [TOR](#) [TTAB Status](#) (Use the "Back" button of the Internet
Browser to return to TESS)



Word Mark	M 22 M22ONLINE.COM
Goods and Services	IC 025. US 022 039. G & S: Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops. FIRST USE: 20040101. FIRST USE IN COMMERCE: 20040101
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.07.01 - Diamonds with plain multiple line border; Diamonds with plain single line border 26.09.20 - Squares inside one another 26.09.21 - Squares that are completely or partially shaded
Trademark Search Facility Classification Code	ART-07.13 Billboards, Signs LETS-1 M A single letter, multiples of a single letter or in combination with a design NUM-26-UP 22 Other Numerals - 26 and Up SHAPES-DIAMONDS Diamond shaped designs including shaded or more than one diamond SHAPES-GEOMETRIC Geometric figures and solids including squares, rectangles, quadrilaterals and polygons
Serial Number	78963038
Filing Date	August 29, 2006
Current Filing Basis	1A

Original Filing Basis 1A
Published for Opposition September 18, 2007
Registration Number 3348635
Registration Date December 4, 2007
Owner (REGISTRANT) Broneah, Inc. CORPORATION MICHIGAN 121 E. Front St. Suite 103 Traverse City MICHIGAN 49684
Attorney of Record Enrico Schaefer
Description of Mark Color is not claimed as a feature of the mark. The mark consists of an unmounted square street sign with a centered diamond containing M 22 and with M22online.com in the bottom border of the square.
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DCT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

EXHIBITS 37 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



January 26, 2012

Via Email and Fax

CafePress.com
Attn: Lindsay Moore
Intellectual Property Rights Agent
1850 Gateway Drive
Suite 300
San Mateo, CA 94404

RE: Copyright Claim Concerning User UP_North_Michigan

Dear Sir or Madam:

We represent the interests of Broneah, Inc., which is a corporation organized under the laws of the State of Michigan with its principal place of business in Traverse City, MI ("Broneah"). Broneah is the owner of all copyright rights in and to the work of creative authorship embodied in the M22 logo, which may be viewed at <http://www.m22online.com>. Additionally, Broneah is the owner of the M22 family of marks, which include THE M-22 CHALLENGE (Serial No. 85089688), M22 (Serial No. 85041051), M22 (Serial No. 85040494), M22ONLINE.COM (Serial No. 78963038), and M22 (Serial No. 77197208) marks ("M22 Family of Marks").

It has recently come to our attention that a party using your service has infringed upon our client's exclusive copyright rights, which are guaranteed by 17 U.S.C. § 106. Specifically, the user UP_North_Michigan is currently offering for sale goods that are substantially similar to our client's copyrighted works and are offered in direct competition with our clients t-shirt goods. Additionally, this user's use of M26 as a mark is likely to cause confusion with our client's registered M22 Family of Marks, which constitutes trademark infringement in violation of 15 U.S.C. § 1117 and 1125. These actions have been taken without our client's authorization, license, or acquiescence. The goods in question may be accessed at the following link http://www.cafepress.com/sk/up_north_michigan.

This letter serves as your notice that we have a good faith belief that your user has infringed upon our client's copyright and trademark rights misappropriating its creative work and by reproducing, distributing, and publicly displaying that work through your website. Consequently, we hereby demand that you expeditiously remove the identified work

January 26, 2012

Page 2

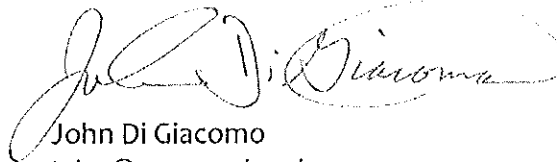
pursuant to your statutory safe harbor duties under 17 U.S.C. § 512 or face liability for direct and contributory copyright infringement, as well as contributory and vicarious trademark infringement. We further demand that you, now and in the future, refrain from distributing or displaying the copyrighted and trademarked works of our client through your services.

We hereby affirm, under penalty of perjury, that the information contained in this notice is accurate and that we are authorized to act on behalf of our client, the copyright holder. Understand that we will not hesitate to take further action for your failure to remove this copyrighted work from your servers. Our client reserves all of its rights under the law, including the right to initiate a copyright and trademark infringement lawsuit at any time and without notice.

Should you have any questions, do not hesitate to contact me directly at 231-932-0411.

Very truly yours,

TRAVERSE LEGAL, PLC

A handwritten signature in black ink, appearing to read "John Di Giacomo", written over a horizontal line.

John Di Giacomo

john@traverselegal.com

EXHIBITS 38 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

Cathy Dittrich

From: Enrico Schaefer [enrico@traverselegal.com]
Sent: Friday, May 04, 2012 8:08 AM
To: btanis1@hotmail.com
Cc: Matt Myers; Cathy Dittrich; Broneah Dudes
Subject: Re: M22

Brian:

My name is Enrico Schaefer and I am the trademark attorney for M22. As you likely know, M22 spent years and substantial sums of money building M22 into a brand recognizable throughout the United States and beyond. It has severally federally registered trademarks which provide for the exclusive use of M22 marks throughout the United States, and to prevent any marks which might cause confusion to consumers.

We believe your use of M28 violates the M22 marks. We have already had confused customers mistake what you are doing with the M22 brand. Copying the success of M22 is a violation of federal law and can subject you to substantial damages, including up to \$150,000 is statutory damages for willful violations, and payment of attorney fees. It appears your business model is designed to directly mimic and infringe on the success of M22. I understand that you are doing more than just the Facebook page, and may even be selling merchandise and stickers which are almost identical to M22 federal trademarks. This is a serious issue which needs to be addressed.

I understand that you may have registered something to do with M28 in Michigan. Please understand that such a filing has no impact on this issue. Assuming you registered for a state trademark, you also affirmed as part of that filing that you were not violating any trademark rights. In any event, federal law controls. The first to use a mark in commerce has the exclusive right to use that mark, and preclude the use of confusingly similar marks. In this case, that is clearly M22. Federal registration provides enhance remedies against people who infringe.

I would be happy to speak with you, or your attorney, directly about this important matter. Often times, we can work out an accommodation which allows both parties to move forward. It is our goal to resolve, rather than escalate, this issue. However, M22 must protect its marks and substantial investment. Please let me know when we might speak.

Enrico Schaefer
www.TraverseLegal.com
enrico.schaefer@traverselegal.com
866.936.7447
231-715-3298 (Direct Dial)

ps. I understand you sent an email to my client accusing them of 'hacking' your web site. M22 is a professionally run company with M22 stores in multiple locations, and global merchandise distribution. Neither M22 nor its owners or employees engages in activities such as hacking. We operate to resolve legal issues which arise in a professional manner, always seeking to educate people about our rights so everyone can make solid business decisions.

On May 3, 2012, at 11:58 AM, Broneah Kiteboarding wrote:

> Brian.
>
> Nice talking today. Here is the link with the radio interview I
> mentioned. <http://m22online.com/products-page/trademark/>
>
> Traverse Legal, <http://www.traverselegal.com/> will be in touch with
> you soon to discuss your concerns.
>
> Thanks Keegan!
>
> --
> Best Regards,
>
> M-22
> "Join" on Facebook - <http://www.facebook.com/M22online>
> 125 East Front Street
> Traverse City, MI 49684
> www.M22online.com
> 231-360-9090
>
> BRONEAH
> "Join" on Facebook - <http://www.facebook.com/Broneah>
> 125 East Front Street
> Traverse City, MI 49684
> www.broneah.com
> 231-392-2212

Cathy Dittrich

From: Brian Tanis [btanis1@hotmail.com]
Sent: Friday, May 11, 2012 6:04 PM
To: enrico@traverselegal.com
Cc: matt@broneah.com; cathy.dittrich@traverselegal.com; m 22
Subject: RE: M22

I have taken down all photos of m28 on the facebook page. How do you suggest we work out so "both parties move forward".

> Subject: Re: M22
> From: enrico@traverselegal.com
> Date: Fri, 4 May 2012 08:08:02 -0400
> CC: matt@broneah.com; cathy.dittrich@traverselegal.com; broneah@broneah.com
> To: btanis1@hotmail.com
>
> Brian:
>
> My name is Enrico Schaefer and I am the trademark attorney for M22. As you likely know, M22 spent years and substantial sums of money building M22 into a brand recognizable throughout the United States and beyond. It has severally federally registered trademarks which provide for the exclusive use of M22 marks throughout the United States, and to prevent any marks which might cause confusion to consumers.
>
> We believe your use of M28 violates the M22 marks. We have already had confused customers mistake what you are doing with the M22 brand. Copying the success of M22 is a violation of federal law and can subject you to substantial damages, including up to \$150,000 is statutory damages for willful violations, and payment of attorney fees. It appears your business model is designed to directly mimic and infringe on the success of M22. I understand that you are doing more than just the Facebook page, and may even be selling merchandise and stickers which are almost identical to M22 federal trademarks. This is a serious issue which needs to be addressed.
>
> I understand that you may have registered something to do with M28 in Michigan. Please understand that such a filing has no impact on this issue. Assuming you registered for a state trademark, you also affirmed as part of that filing that you were not violating any trademark rights. In any event, federal law controls. The first to use a mark in commerce has the exclusive right to use that mark, and preclude the use of confusingly similar marks. In this case, that is clearly M22. Federal registration provides enhance remedies against people who infringe.
>
> I would be happy to speak with you, or your attorney, directly about this important matter. Often times, we can work out an accommodation which allows both parties to move forward. It is our goal to resolve, rather than escalate, this issue. However, M22 must protect its marks and substantial investment. Please let me know when we might speak.
>
> Enrico Schaefer
> www.TraverseLegal.com
> enrico.schaefer@traverselegal.com
> 866.936.7447
> 231-715-3298 (Direct Dial)
>
>
> ps. I understand you sent an email to my client accusing them of 'hacking' your web site. M22 is a professionally run company with M22 stores in multiple locations, and global merchandise distribution. Neither M22 nor its owners or employees engages in activities such as hacking. We operate to resolve legal issues which arise in a professional manner, always seeking to educate people about our rights so everyone can make solid business decisions.
>
> On May 3, 2012, at 11:58 AM, Broneah Kiteboarding wrote:
>
> > Brian.
> >

M22000028

> > Nice talking today. Here is the link with the radio interview I
> > mentioned. <http://m22online.com/products-page/trademark/>
> >
> > Traverse Legal, <http://www.traverselegal.com/> will be in touch with
> > you soon to discuss your concerns.
> >
> > Thanks Keegan!
> >
> > --
> > Best Regards,
> >
> > M-22
> > "Join" on Facebook - <http://www.facebook.com/M22online>
> > 125 East Front Street
> > Traverse City, MI 49684
> > www.M22online.com
> > 231-360-9090
> >
> > BRONEAH
> > "Join" on Facebook - <http://www.facebook.com/Broneah>
> > 125 East Front Street
> > Traverse City, MI 49684
> > www.broneah.com
> > 231-392-2212
>

EXHIBITS 39 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

TRAVERSElegal.

ATTORNEYS & ADVISORS

March 24, 2010

VIA CERTIFIED MAIL AND EMAIL
mary@traversebaypaddler.com
susan@traversebaypaddler.com
PaddleAway, LLC
15763 Smokey Hollow Road
Traverse City, MI 49686

RE: Traversebaypaddler.com

Dear Mary and Susan:

As you know, this law firm represents M22, LLC, with regard to their various M22 trademarks, including M22 (Serial No. 77,197,208), M22online.com (Serial No. 78,963,038), and M185 (Serial No. 77,378,131). Please recall that we met last summer to discuss your use of "M37" on t-shirts and your website. During that meeting, we discussed my clients' various trademarks and your virtual identical copying of my clients' t-shirt designs and marketing model. During that meeting, you agreed to cease and desist using M37 on apparel and on your website. It is now apparent from the information on www.traversebaypaddler.com that you have actually violated that prior agreement and now are expanding your infringing activities. Before taking this matter further and potentially filing a complaint in Federal Court in Grand Rapids, we wanted to provide you one last opportunity to explain your actions. As you know, each instance of infringement can result in up to \$100,000 in statutory damages, plus attorneys' fees. Given your prior notice and, in fact, prior agreement to cease and desist, there is no question that your continued activities are intentional.

We would demand that you contact this office within the next three (3) business days and confirm that you will immediately disable the website and cease and desist the sale of any further M37 merchandise.

Sincerely,

Traverse Legal, PLC



Enrico Schaefer
enrico@traverselegal.com

ES/cad
Enclosures

PaddleAway

OUR M 37 CONNECTION

M 37 is a state highway that runs north-south in the lower peninsula of Michigan, along rural pathways, passing lush green state forests, through bustling and sleepy towns, and over and under a number of scenic rivers. It bisects the 18 miles of Old Mission Peninsula (our home) in Traverse City, encompassing East and West Grand Traverse Bay views and ends at the Old Mission Lighthouse on the 45th Parallel.

But to us, M 37 is more than a road. It is from where we, daily, take in scenic vistas, preserved farmlands (through Peninsula Township's historic citizen-financed Purchase of Development Rights Program) and our beloved Lake Michigan bay waters.

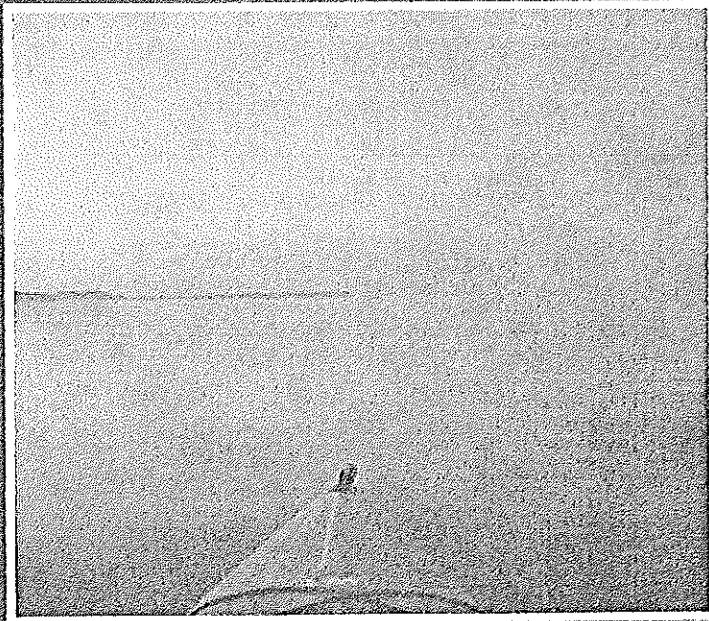
We have been known to call it our "road to enlightenment." So we fondly and proudly present a product line that honors M 37: Lots of colors are available (red, sapphire, heather cardinal, heather green, black, gold, camel, metro blue, lime, prairie dust, tangerine and cedar red) but limited quantities and sizes. Order yours now, or email us if your size or color is not available.



**M 37 Limited Edition Short Sleeve Cotton
T-Shirt**
Price: \$15.00

[PADDLEAWAY](#)[OUR VISION](#)[ABOUT US](#)[STORE](#)[M 37](#)[PADDLE TOURS](#)[EDUCATION](#)[PADDLEBLOG](#)

PaddleAway

**ADDRESS:**

PaddleAway, LLC
15763 Smokey Hollow Road
Traverse City, MI 49686

WEBSITE:

Traversebaypaddler.com

HOW TO CONTACT US:

Mary@traversebaypaddler.com

Susan@traversebaypaddler.com

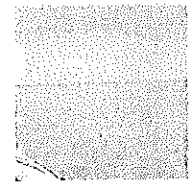
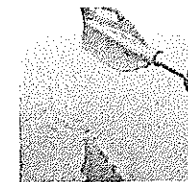
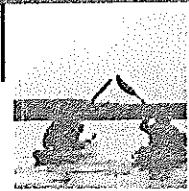
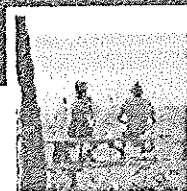
231/715-1454

ABOUT US

TraverseBayPaddler.com and PaddleAway, LLC was formed by two women with different backgrounds but

the same passion for the outdoors. Mary and Susan have been paddling together for over 10 years and have a wealth of experience in the Traverse Bay area. They have a deep understanding of the local waterways and the best places to paddle. They want to share this knowledge with others and provide a safe and enjoyable paddling experience for everyone.

Traverse Bay Paddler LLC is a 501(c)(3) non-profit organization.



M22000380

PaddleAway LLC

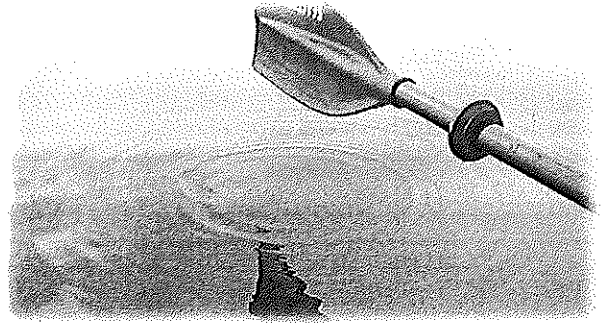
15763 Smokey Hollow Rd.

Traverse City MI 49686

231-715-1454

Mary Manner

Susan Tarczon



April 26, 2010

Enrico Schaefer
810 Cottageview Dr.
Suite G-20
Traverse City MI 49684

REF: Traversebaypaddler.com

Dear Enrico,

In response to your April 20, 2010 letter, we agree to remove the ability to purchase the M37 t-shirts from our website.

We appreciate your clients' investment in marketing their products. However, we continue to believe consumers are not misled by road signs any more than Michigan drivers are misled by those same road signs.

It is our hope that both our organizations can now focus our energies on growing our respective companies and promoting northern Michigan as a great place to live and do business.

Best regards,

Mary

Susan

Mary U. Manner
CEO

Susan G. Tarczon
CFO

www.traversebaypaddler.com

TRAVERSElegal

ATTORNEYS & ADVISORS

April 20, 2010

VIA EMAIL ONLY

Mary U. Manner mary@traversebaypaddler.com
Susan Tarczon susan@traversebaypaddler.com
PaddleAway, LLC
15763 Smokey Hollow Road
Traverse City, MI 49686

RE: Traversebaypaddler.com

Dear Ladies:

In response to your letter dated March 26, 2010, we believed that you should have been well done publicly selling any merchandise that you had. Also, it did appear that your website had been updated in order to do more marketing. People, are, in fact, confused believing that your products are being provided through M22.

We appreciate your response and indication that you have not expanded your inventory. Given the amount of time that has passed, however, **we must request that you cease and desist any further marketing of the M37 merchandise.** We cannot continue to allow further marketing activity. We would request that you cease marketing the t-shirts on traversebaypaddler.com. We would allow you to continue to sell your merchandise to customers who come to your tours. This way you could continue to sell any remaining merchandise that you have. The key is that we cannot allow any public marketing of the merchandise any further.

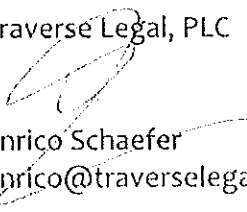
Please appreciate our position. My clients have well over six figures invested in creating this brand, not to mention innumerable hours of time. **Your t-shirts look virtually identical to ours. There is no doubt that people are confused about the relationship between your company and ours and the source of the M37 merchandise.** A jury would have no problem concluding that there would be a likelihood of confusion between the brands. More importantly, your sale of M37 simply encourages others to infringe.

April 20, 2010
Page 2 of 2

Please let me know if the above approach will work for you. Again, you would remove all M37 merchandise marketing from your website. You would agree not to publicly market M37 gear. We would allow you to continue to sell your merchandise to actual customers of your paddle tours.

Sincerely,

Traverse Legal, PLC



Enrico Schaefer
enrico@traverselegal.com

ES/cad
Enclosures

EXHIBITS 40 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

M22000218

TRAVERSE^{legal}

ATTORNEYS & ADVISORS

810 Cottageview Dr. 231-932-0411 TEL
Suite G-20 231-932-0636 FAX
Traverse City
Michigan 49684 traverselegal.com

August 9, 2010

North Coast Image Wear
C/O Tracy Piehl
610 West Sheridan, Suite 2
Petoskey, MI 49770
Phone: (231) 347-3016
Fax: (231) 348-2015
tracy@ncimagewear.com

RE: Infringement of M22 Trademark

Dear Ms. Piehl:

It has recently come to our attention that you are printing several products for The M119 Project, which distributes products containing a mark that infringes upon our client's registered M22 family of marks. This letter serves as your notice that any continued printing of products containing the M119 mark will subject you to significant liability for contributory trademark infringement and vicarious liability under federal law.

Our client is the holder of registered trademarks for M22 in a variety of International Classes and for use in association with several different goods or services. Specifically, our client holds a registered trademark for M22 for use in association with wine (Registration No. 3427900) and M22 for use in association with apparel, specifically, hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, and tank tops (Registration No. 3348635). Our client also has two applications currently pending registration in front of the US Patent and Trademark Office for M22 for use in association with retail shops featuring clothing, sporting goods, and novelty items (Serial Nos. 85040494 and 85041051), as well as an application for M22 Challenge for use in association with entertainment in the nature of competitions in the field of athletics (Serial No. 85089688). Evidence of these trademarks are attached to this letter as Exhibit A. Our client also holds common law rights in the M22 family of marks by virtue of its longstanding use of those marks in commerce.

August 9, 2010

Page 2 of 2

Consequently, our client's M22 mark has become well and favorably known across the world as an indicator of quality goods and services.

Understand that the test for trademark infringement applied by a court asks whether the opposing party's mark is "likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114. In examining whether a mark is likely to cause confusion, courts apply eight non-exclusive factors: (1) the strength of the plaintiff's mark; (2) the relatedness of the goods; (3) the similarities of the marks; (4) evidence of actual confusion; (5) the marketing channels used; (6) the likely degree of purchaser care; (7) the defendant's intent in selecting the mark; and (8) the likelihood of expansion of the product lines. See *Frisch's Restaurants, Inc. v. Elby's Big Boy, Inc.* 670 F.2d 642, 648 (6th Cir. 1982). When the likelihood of confusion test "is closely balanced, the question should be resolved in favor of the senior user." See 3 McCarthy § 23:64; see also *Dallas Cowboys Football Club, Ltd. v. Am.'s Team Props.*, 616 F. Supp. 2d 622, 637 (N.D. Tex. 2009).

We have no doubt that a court would find that the M119 Project's use of the M119 mark is confusingly similar to our client's M22 mark. Specifically, the M119 Project is currently using an identical logo, save for a change in the number displayed on the logo from 22 to 119, to sell goods in direct competition with our client's goods. This has subjected them to up to \$2,000,000 in statutory damages under the Lanham Act. 15 U.S.C. § 1117(c)(2). Further, the M119 Project can also be held liable for our client's actual costs, damages, and attorneys fees under 15 U.S.C. § 1117(a).

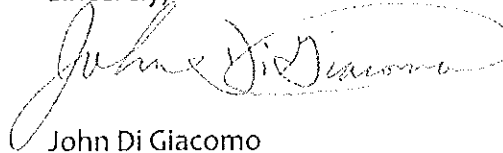
Also note that your printing of products for the M119 Project has subjected you to liability for the same amount, up to \$2,000,000 in statutory damages, for your contributory and vicarious infringement. Contributory infringement occurs where a third party either (a) induces a third party to infringe on a mark or (b) supplies a product to a third party with actual or constructive knowledge that the product is being used to infringe upon a mark. See *Inwood Lab, Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 853-54 (1982). Similarly, vicarious liability for trademark infringement occurs where a party (1) has the ability to stop or limit the direct infringement of a mark; (2) directly profits from the direct infringement of another's mark; and (3) declines to exercise the right to stop or limit the infringement. See *Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615, 621 (6th Cir. 2004). It is clear that, should you decide to continue printing these products, you will be subjected to liability for both contributory and vicarious trademark infringement.

I hope that the explanation of the law contained within this letter resolves any questions that you may have as to our client's trademark rights and that you will cease printing the M119 products without the need for further legal action. With that said, our client must reserve all rights, including the right to bring a trademark infringement lawsuit for

August 9, 2010
Page 3 of 3

contributory infringement should you continue printing these items. If you have any questions, please do not hesitate to contact me directly at 231-932-0411.

Sincerely,

A handwritten signature in cursive script, reading "John Di Giacomo". The signature is written in dark ink and is positioned above the printed name and email address.

John Di Giacomo
john@traverselegal.com

M22000180

TRAVERSElegal

ATTORNEYS & ADVISORS

810 Cottageview Dr. 231 932 0401 TEL
Suite G-20 231 932 0636 FAX
Traverse City
Michigan 49684 traverselegal.com

August 4, 2011

Douglas S. Bishop, Esq.
Bishop & Heintz P.C.
440 West Front Street
P.O. Box 707
Traverse City, MI 49685
Email: doug1@bishopheintz.com

Re: Broneah, Inc. / M22 trademark

Dear Doug,

You indicated in your letter that federal regulations and enabling legislation permit anyone whose business is located on a state highway to use an exact duplicate of the sign for that highway. It is true that a business is permitted to use a highway sign in this manner. Such use of a trademark, however, is geographically descriptive, and is not protected under the Lanham Act. See *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 594 (6th Cir. 1989). I appreciate your concession that the M-119 sign can and should be used in a geographically descriptive manner.

While I agree with you that the M-119 mark should only be used in a geographically descriptive way, your client has not limited its use to mere geographic description, and has instead used the M-119 mark to indicate the source of its apparel, wine, and other products.

It is clear that your client has copied my client's business model, in a blatant attempt to trade off of the popularity and good will of the M-22 brand. You are already well aware that there are numerous accounts of actual confusion in the marketplace by loyal M-22 customers, who mistakenly believe that M-119 is affiliated with or shares the same origin as M-22 goods. As evidenced by your client's obvious copying and reckless disregard for deceiving consumers about the true source of M-119 goods, it is clear that your client is engaged in unfair competition and trademark infringement.

In our last meeting, you presented an administrative traffic manual as your authority for trademark law. The authority that governs here, and which will govern in any court, is the federal trademark statute, the Lanham Act, which was enacted by Congress and signed by the President of the United States. If you can provide any federal statutory authority or case law that indicates that a highway sign cannot be afforded trademark protection, I would like to see it.

Sincerely,


John Di Giacomo
john@traverselegal.com

M22000181

TRAVERSE^{legal}

ATTORNEYS & ADVISORS

810 Cottageview Dr. 231 932 0411
Suite G-20 231 932 0636 fax
Traverse City
Michigan 49684 traverselegal.com

August 6, 2010

Lee Lutes
360 McKinley Rd.
Traverse City, MI 49686
llutes@blackstarfarms.com

RE: Infringement of M22 Trademark

Dear Mr. Lutes:

It has recently come to our attention that you are printing wine labels for The M119 Project, which distributes products containing a mark that infringes upon our client's registered M22 family of marks. This letter serves as your notice that any continued printing of labels containing this mark will subject you to significant liability for contributory trademark infringement and vicarious liability under federal law.

Our client is the holder of registered trademarks for M22 in a variety of International Classes and for use in association with several different goods or services. Specifically, our client holds a registered trademark for M22 for use in association with wine (Registration No. 3427900) and M22 for use in association with apparel, specifically, hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, and tank tops (Registration No. 3348635). Our client also has two applications currently pending registration in front of the US Patent and Trademark Office for M22 for use in association with retail shops featuring clothing, sporting goods, and novelty items (Serial Nos. 85040494 and 85041051), as well as an application for M22 Challenge for use in association with entertainment in the nature of competitions in the field of athletics (Serial No. 85089688). Evidence of these trademarks are attached to this letter as Exhibit A. Our client also holds common law rights in the M22 family of marks by virtue of its longstanding use of those marks in commerce. Consequently, our client's M22 mark has become well and favorably known across the world as an indicator of quality goods and services.

Understand that the test for trademark infringement applied by a court asks whether the opposing party's mark is "likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114. In examining whether a mark is likely to cause confusion, courts apply eight non-exclusive factors: (1) the strength of the plaintiff's mark; (2) the relatedness of the goods; (3) the similarities of the marks; (4) evidence of actual confusion; (5) the marketing channels used; (6) the likely degree of purchaser care; (7) the defendant's intent in selecting

August 6, 2010
Page 2 of 3

the mark; and (8) the likelihood of expansion of the product lines. See *Frisch's Restaurants, Inc. v. Elby's Big Boy, Inc.* 670 F.2d 642, 648 (6th Cir. 1982). When the likelihood of confusion test "is closely balanced, the question should be resolved in favor of the senior user." See 3 McCarthy § 23:64; see also *Dallas Cowboys Football Club, Ltd. v. Am.'s Team Props.*, 616 F. Supp. 2d 622, 637 (N.D. Tex. 2009).

We have no doubt that a court would find that the M119 Project's use of the M119 mark is confusingly similar to our client's M22 mark. Specifically, the M119 Project is currently using an identical logo, save for a change in the number displayed on the logo from 22 to 119, to sell goods in direct competition with our client's goods. This has subjected them to up to \$2,000,000 in statutory damages under the Lanham Act. 15 U.S.C. § 1117(c)(2). Further, the M119 Project can also be held liable for our client's actual costs, damages, and attorneys fees under 15 U.S.C. § 1117(a).

Also note that your printing of labels for the M119 Project has subjected you to liability for the same amount, up to \$2,000,000 in statutory damages, for your contributory and vicarious infringement. Contributory infringement occurs where a third party either (a) induces a third party to infringe on a mark or (b) supplies a product to a third party with actual or constructive knowledge that the product is being used to infringe upon a mark. See *Inwood Lab, Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 853-54 (1982). Similarly, vicarious liability for trademark infringement occurs where a party (1) has the ability to stop or limit the direct infringement of a mark; (2) directly profits from the direct infringement of another's mark; and (3) declines to exercise the right to stop or limit the infringement. See *Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615, 621 (6th Cir. 2004). It is clear that, should you decide to continue printing these labels, you will be subjected to liability for both contributory and vicarious trademark infringement.

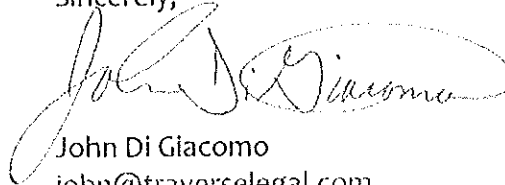
Our client indicated that you were concerned that its mark has been involved in a dispute with another entity in Mackinac City. Rest assured that this issue was settled and that our client continues to have full rights in and to its M22 family of marks. While I am hesitant to provide you with confidential information concerning our client, I have attached the settlement agreement in that matter to this letter as Exhibit B in an attempt to alleviate your concerns. Understand that this document is provided to you for the limited purpose of making you aware of our client's rights and cannot be redistributed without legal consequences.

I hope that the explanation of the law contained within this letter resolves your concerns and that you will cease printing the M119 labels without further actions. Our client is very happy with your services and looks forward to a long and beneficial relationship with your company. With that said, our client must reserve all rights, including the right to bring a trademark infringement lawsuit for contributory infringement should you continue printing

August 6, 2010
Page 3 of 3

these bottles. If you have any questions, please do not hesitate to contact me directly at 231-932-0411.

Sincerely,



John Di Giacomo
john@traverselegal.com





DOUGLAS S. BISHOP*
PATRICK E. HEINTZ
DAVID A. CVENGROS
STEVEN R. FOX
*registered patent attorney

MEAGAN RAFTERY BELDEN +
MATTHEW L. CLASSENS

JEROME COLLIGAN - of counsel
+ also admitted in Illinois

August 17, 2011

John Di Giacomo, Esq.
Traverse Legal
810 Cottageview Drive, Suite G-20
Traverse City, MI 49684

Also sent via email to john@traverselegal.com

Re: Broneah, Inc./M22 Trademark
Your Letter with reference to Broneah, Inc. dated August 4, 2011

Dear John:

I believe you are missing a number of issues. First and foremost, since our client has been using replicas of the state highway sign for M-119 on goods sold from her retail location for a substantial number of years, before your client even existed, your suggestion that somehow your client's "business model" has been copied or infringed is pretty far off the mark.

Further, irrespective of whether your client is properly using the M-22 road sign as a trademark (I submit that it is not, but it's not a dispositive issue), any person may utilize an exact duplicate of a public road sign in any manner that they wish.

Finally, all other argument aside, I cannot agree with the suggestion that M-119 is confusingly similar, in any way, to M-22, as that test is applied.

This letter is without prejudice to our client's rights, all of which are expressly reserved. As with my prior correspondence, it further constitutes a settlement communication and may not be used for any other purpose without the prior written consent of Bishop & Heintz, P.C. and our client.

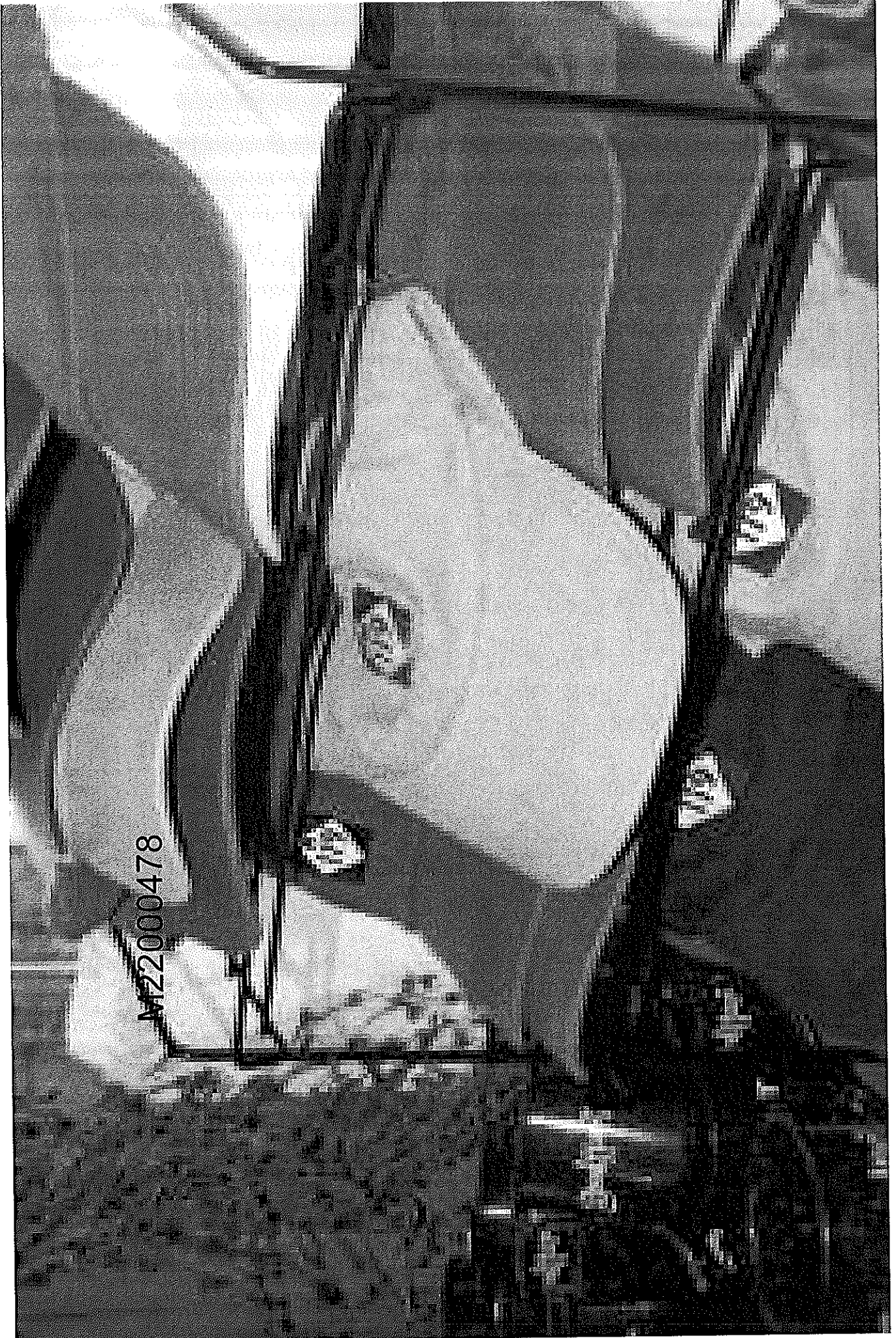
Sincerely,

Douglas S. Bishop

DSB/tms

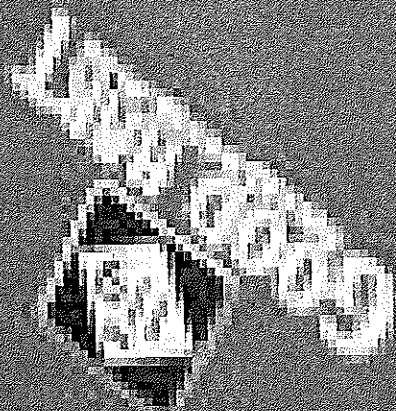
cc: Ms. Carolyn Sutherland

M22000478





M22000479



The Tunnel of Trees

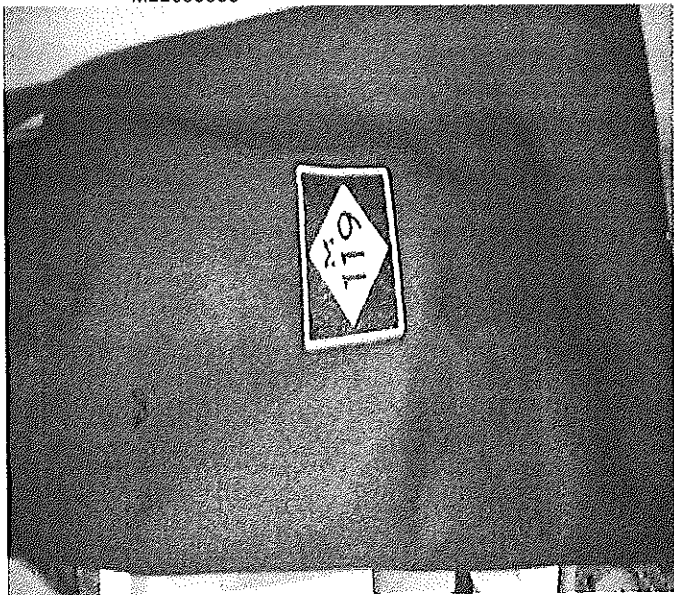
M22000563



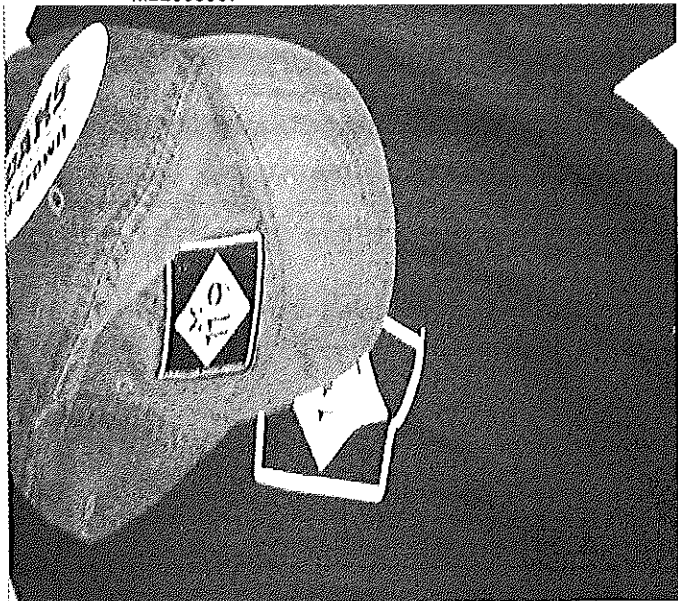
GOOD HART GENERAL STORE
GOOD HART, MICHIGAN
GOODHARTSTORE.COM

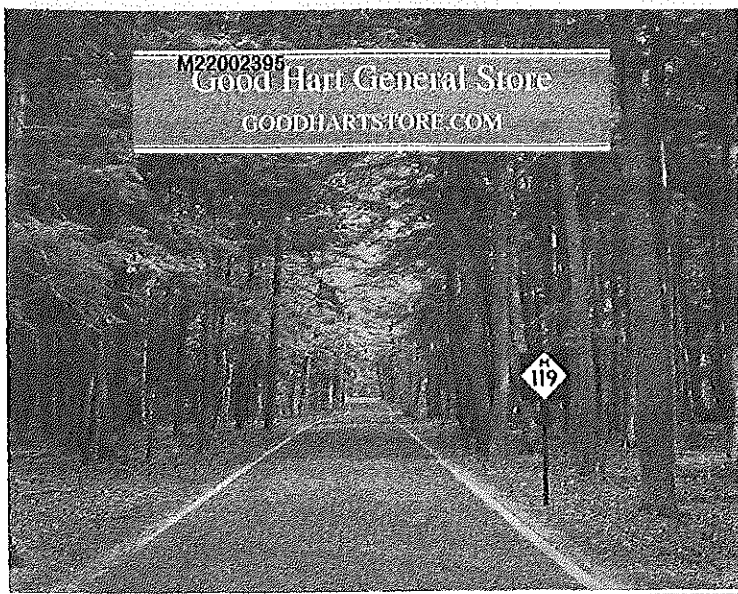
RED HOUSE RED

M22000566



M22000567

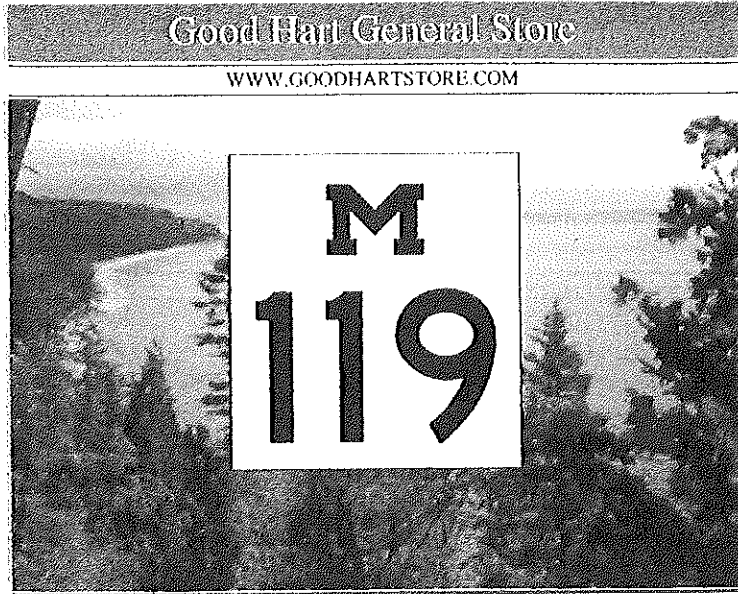




M22002395
Good Hart General Store
GOODHARTSTORE.COM

THE TUNNEL OF TREES
Good Hart, Michigan

PINOT NOIR



Good Hart General Store

WWW.GOODHARTSTORE.COM

THE TUNNEL OF TREES
Good Hart, Michigan

PINOT NOIR

Good Hart General Store

WWW.GOODHARTSTORE.COM

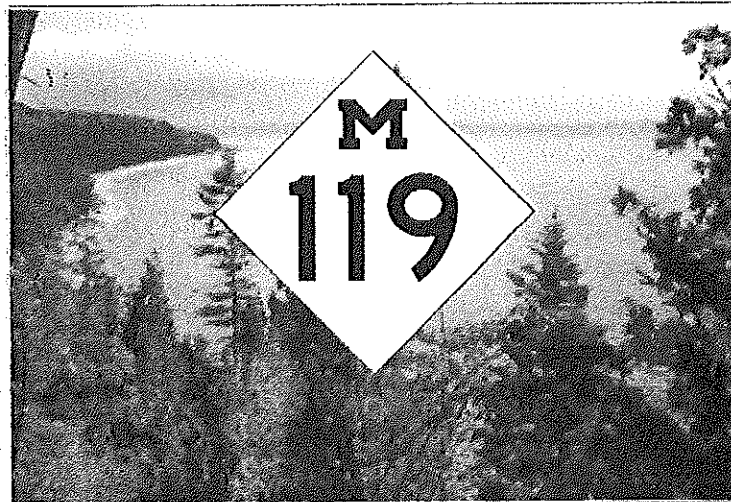


THE TUNNEL OF TREES
Good Hart, Michigan

PINOT NOIR

Good Hart General Store

WWW.GOODHARTSTORE.COM



THE TUNNEL OF TREES
Good Hart, Michigan

PINOT NOIR



EXHIBITS 41 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

TRAVERSE^{legal}

ATTORNEYS & ADVISORS

September 11, 2008

VIA CERTIFIED MAIL/RETURN RECEIPT

Route Scouts
Attn: Mary Roberts, Heidi Marshall
and Rebecca Glotfelty
P.O. Box 533
Petoskey, MI 49770

Re: Notice Letter of Trademark Issues

To Whom It May Concern:

This is a follow-up to two emails I sent you through your website of www.routescouts.com. As you know, I represent M-22, LLC concerning their various registered trademarks for M-22 and other brands in international classes relating to apparel, wine and other products. This letter will again put you on notice of our client's trademark rights and our belief that your "route scouts" use of M-119 infringes on my client's previously registered trademarks. It is clear that you have essentially copied my client's business model. While we appreciate the goal of generating funds to benefit the cultural preservation along M-119 corridor, we have already received feedback potential customers who believe that my client owns, operates, endorses or sponsors the apparel which you are selling at:

Cycling Salamander Art Gallery (7 miles south of Charlevoix),
McLean and Eakin Booksellers (downtown Petoskey),
Indian Hills Gallery (on M119),
Harborwear in downtown Harbor Springs,
Primitive Images (Good Hart), and
Legs Inn.

As noted in my previous emails, I am asking again that you contact our office directly so that we can discuss this matter. Our next step would be to send to notice letters to the retail establishments noted on your website indicating the trademark issues noted above and asking them to cease distribution in order to avoid their potential liability in the matter.

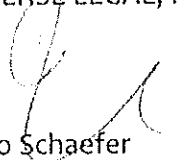
September 11, 2008

Page 2 of 2

I look forward to hearing from you no later than September 19, 2008.

Sincerely,

TRAVERSE LEGAL, PLC

A handwritten signature in black ink, appearing to read "Enrico Schaefer", is positioned above the printed name and email address.

Enrico Schaefer

Enrico.Schaefer@traverselegal.com

ES/cam

cc: M-22, LLC

TRAVERSElegal

ATTORNEYS & ADVISORS

September 17, 2008

VIA MAIL / FACSIMILE / EMAIL

Wallace H. Glendening
1550 Buhl Building
Detroit, Michigan 48226

Fax: 313-221-9488
Email: whg@comcast.net

Re: M119 Trademark Infringement

Mr. Glendening:

Thank you for your September 12, 2008 letter on behalf of route Scouts LLC. Let me first clarify my typo and answer your question by noting that our client, M22, LLC does not have a registered trademark for M119.

That said, we reiterate our position that your client's continued use of the M119 logo on t-shirts infringes upon our client's registered M22 trademarks, which include the following registrations with the United States Patent and Trademark Office:

1. M 22 M22ONLINE.COM
Registration Number: 3348635
International Class: 025. Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops.
First Use In Commerce Date: 20040101
Filing Date: August 29, 2006
2. M22
Registration Number: 3427900
International Class: 033. Wine.
First Use In Commerce Date: 20071000
Filing Date: June 4, 2007

It is clear that your client has not only copied our client's business model, but they have also copied our client's trade dress by using the same colors and a confusingly similar mark with the same logo design. See Exhibit A, Printout of website listing M119

September 17, 2008

Page 2 of 2

shirts for sale and directing consumers to distributors. These factors show purposeful copying in an effort to divert business from our client, which further benefits our client's position. See *Leelanau Wine Cellars v. Black & Red*, 502 F.3d 504, 520 (6th Cir. 2007). Most importantly, the fact remains that your client's use of the mark has resulted in actual confusion. As you know, "[e]vidence of actual confusion is undoubtedly the best evidence of likelihood of confusion." See *AutoZone, Inc. v. Tandy Corp.*, 373 F.3d 786, 795-96 (6th Cir. 2004).

As a result, we request that your client immediately:

1. Cease and desist any and all use of any mark, including M119, in such a way that would create a likelihood of consumer confusion, dilute M22, LLC's M22® or other marks, or otherwise damage the M22® mark or M22, LLC;
2. Not produce, advertise, market, promote, sell, distribute or otherwise use our the M119 mark, or any colorable imitation thereof, in connection with any clothing or other products or services that would be likely to cause consumer confusion as to source or origin; and
3. Keep all evidence of use, all revenue attributable to the sale of the infringing items, and all associated expenses attributable to the sale of the infringing items. Failure to do so subjects you to claims of spoliation of evidence.

We would ask that your client confirm, in writing, its willingness to abide by our requests no later than September 25, 2008. In the meantime, we welcome the opportunity to discuss this matter with you further if need be. Our goal is to avoid the consumer confusion that has undoubtedly occurred without court intervention, if possible.

Sincerely,

TRAVERSE LEGAL, PLC



Enrico Schaefer

Enrico.Schaefer@traverselegal.com

ES/bah

cc: M-22, LLC

M22002454

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[Create Blog](#) | [Sign In](#)

ROUTE SCOUTS

AUDIO TOURS OF MICHIGAN'S HERITAGE HIGHWAYS

P.O. Box 533, Petoskey, MI 49770

Route Scouts is dedicated to the preservation and celebration of tradition, activities, heritage, stories, flora, and arts and culture of northern Michigan. We create self-guided audio tours of the scenic routes and trails and sights of Northern Michigan.

THE ROUTE SCOUTS

[Home](#)[The Scouts](#)

WEDNESDAY

M-119 Apparel

CONTACT US:

Your
message

Name:

Your
location

Email
Address:

How did
you
learn
about
Route
Scouts?

☐ online search
☐ word of mouth
☐ audio tour
☐ M119 t-shirts
☐ newspaper
☐ store

Route Scouts is proud to introduce M119 T-shirts.
Celebrate what many call Michigan's most beautiful scenic highway
by sporting M119 apparel.

Shirts can be purchased at:
Cycling Salamander Art Gallery (7 miles south of Charlevoix)
McLean and Eakin Booksellers (downtown Petoskey),
Indian Hills Gallery (on M119),
Harborwear in downtown Harbor Springs
Primitive Images (Good Hart),
Legs Inn (Cross Village).

Twenty percent of sales will directly benefit the cultural preservation
along the M-119 corridor.

POSTED BY REBECCA AT 11:31 PM

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M22002455

M-119 APPAREL



FEATURED ROUTE SCOUT
RECIPE

Cock-a-leekie Soup

SUBSCRIBE TO ROUTE SCOUT



BLOG ARCHIVE

▼ 2007 (5)

▼ May (3)

M-119 Audio Tour

Mackinac Island Audio Tour

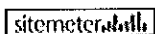
Cock-a-leekie Soup

► April (1)

► February (1)

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the Time

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M22002456

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ROUTE SCOUTS

AUDIO TOURS OF MICHIGAN'S HERITAGE HIGHWAYS

P.O. Box 533, Petoskey, MI 49770

Route Scouts is dedicated to the preservation and celebration of tradition, activities, heritage, stories, flora, and arts and culture of northern Michigan. We create self-guided audio tours of the scenic routes and trails and sights of Northern Michigan.

THE ROUTE SCOUTS

Home

The Scouts

SATURDAY

M-119 Audio Tour

CONTACT US:

Your
message

Name:

Your
locationEmail
Address:

How did you learn about Route Scouts?

☐ online search

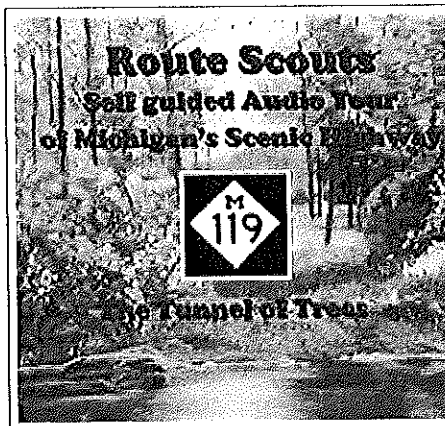
☐ word of mouth

☐ audio tour

☐ M119 t-shirts

☐ newspaper

☐ store

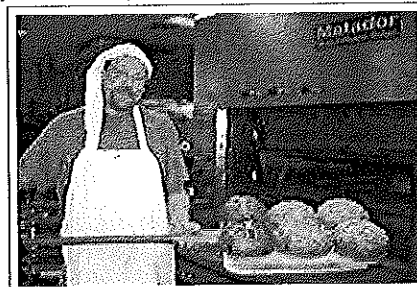


Coming Soon!

Route Scouts is your guide for the 27.5 mile journey along this Michigan Heritage Highway. M-119 is a mix of villages, lakes, pastoral vistas and winding road. You'll learn about Chief Petoskey, the formation of Little Traverse Bay, wonderful places to shop

and dine, ancient Odawa stories and much more. Various guides such as John Riggs of Thorne Swift Nature Preserve and Ray Kiogima, Odawa Elder, assist you on this journey. Join us in the Land of the Crooked Tree.

(Sean of Crooked Tree Bread Works delivers fresh bread daily)

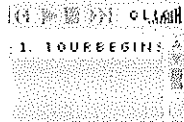


Listen to the introduction of
the M-119 audio tour

create form

M22002457

M-119 APPAREL

FEATURED ROUTE SCOUT
RECIPE

Cock-a-leekie Soup

SUBSCRIBE TO ROUTE SCOUT

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BLOG ARCHIVE

▼ 2007 (5)

▼ May (3)

M-119 Audio Tour

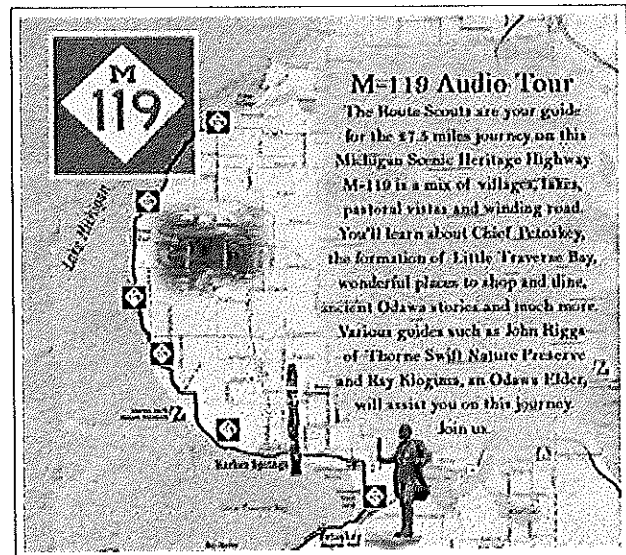
Mackinac Island Audio Tour

Cock-a-leekie Soup

► April (1)

► February (1)

POSTED BY REBECCA AT 3:29 PM

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EXHIBITS 42 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

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Friday April 22nd

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THE M-22 LOOK

The Myers brothers capture the mood of Northern Michigan



Matt and Keegan Myers on Neah-tawanta point on Old Mission Peninsula where they grew up. Photo by Jason Hamelin.

By: Kristy Kurjan

Fresh water, beaches, bonfires, and comfortable clothing. That is exactly what kiteboarding co-founders Matt and Keegan Myers had in mind for their M-22 clothing company based out of Traverse City. For the brothers, M-22 is a way to express appreciation for the region through comfortable fashion.

M-22 is not just a road; it is a way of life. The Myers brothers' line of cotton apparel is a reflection of the simplicity and natural beauty that Northern Michigan gives its visitors.

"Loving the beaches and Northern Michigan summers, that is the feeling our clothing represents," says Keegan. "It is easy for people to relate to the road because of its cool location and most people already have an attachment to it. M-22 is a special place for people, good memories."

The company has a diverse customer base consisting of locals as well as out-of-towners. The brand also appeals to a wide age spectrum from 10-year-old boys to 80-year-old grandmas. And, with over 5,000 fans on facebook.com, the brand is growing in both size and popularity.

COMFORTABLE CLOTHING

M-22's philosophy is to keep their styles simple and comfortable. "When you get out of the water after a day at the beach you want to put on a comfortable sweatshirt," explains Keegan. "We have done a lot of research on comfy hoodies."

The line is best known for its classic logo t-shirt but offers much more, including baseball hats, visors, coats and backpacks. Their store on West Front in downtown Traverse City even carries a line of M-22 coffee beans. Clothing is offered in men's, women's, youth and toddler sizes. Pricing range from \$25 for a t-shirt to \$49 for a sweatshirt.

Keegan says the M-22 brand will always have the classic standard M-22 t-shirts to represent the area, but the brothers are looking towards other ways to expand their brand.

"Right now we are working on technically-enhanced garments such as spring/fall mid layer jackets," Keegan says. "When it first started it was all logo wear. Now that the brand is growing we are becoming more refined and water focused."

THE ROAD TO SUCCESS

How did this athletic duo decide to mix fashion, kiteboarding and a road? "We came up with the M-22 idea while kiteboarding," explains Keegan. "All of the best kiteboarding spots are off of M-22. We first made t-shirts for our buddies and it took off from there."

The brothers grew up in Traverse City and attended Michigan State University. Keegan earning his degree in marketing and Matt in landscape architecture. Matt is the designer



while Keegan takes care of marketing, organizing and the running of the business.

The two also own a kiteboarding company named Broneah, "bro" stands for "brothers" and "Neah" is short for "Ne Ah Ta Wanta Road" located on Old Mission Peninsula. During their college years they traveled the world, pursuing waves in places like Bora Bora and Tahiti. In recent years, they established a winter kiteboarding camp in Puerto Rico and have pursued their passion for big waves on the coast of Argentina.

Closer to home, you're likely to find them on the Lake Michigan coast in the summer, where a blossoming kiteboarding scene can be found off locales such as Point Betsie or Otter Creek in Benzie County.

In 2003, the brothers began making t-shirts and stickers with the M-22 road sign for their kiteboarding friends. After being featured on the cover of Traverse the Magazine in 2006, they took their products to boutiques in Leelanau County and began producing t-shirts, hoodies and stickers en masse. After receiving encouraging feedback from both customers and retailers, they decided to open a storefront. They now have an official M-22 brand store on Front Street in Traverse City and are opening a second store this May in Glen Arbor. In addition, their online website ships orders throughout the country.

PROTECTING WATERS

The Myers brothers have a theory on the M-22 highway: "The highway is the nicest, most beautiful stretch of road along any fresh water in the world." With this idea in mind, they in-

Moe Murillo, a manager at the M-22 store in downtown TC, doesn't have to look far for the product line's label. Downes photo.

corporated eco-friendly ideas into their business model. A percentage of all sales are donated to The Leelanau Conservancy, helping to protect the landscape. They try to keep their production local by using Northern Michigan companies for their printing and screening needs.

"Eco-friendly is huge for us; it is the basis of everything we believe," says Keegan who is always thinking of ways to save fresh water. "The big driving force for us as a brand is to protect fresh water. Our hope is to set a good example for other companies to start similar programs helping protect our waters."

Another way the M-22 team is reaching out to the community is through The M-22 Challenge. The multisport event, held in Glen Arbor, benefits The Leelanau Conservancy. June 11 marks the third year of the Challenge. Competitors will participate in a 17 mile bike ride, a 2 mile run/dune climb, and finish with a 2 mile open water paddle. Registration is closed, as the 550 spots were filled up in just over 6 hours.

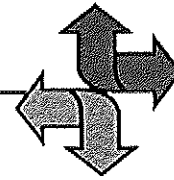
For more information on the M-22 clothing brand check out www.M-22online.com or visit their store fronts in Traverse City and Glen Arbor (opening in May, 2011).

strictly BUSINESS

EXHIBITS 43 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



Manual on Uniform Traffic Control Devices (MUTCD)



Knowledge

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Frequently Asked Questions - General Questions on the MUTCD

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General

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General Questions on the MUTCD

General

1. **Q: What is the Manual on Uniform Traffic Control Devices?**

A: The Federal Highway Administration (FHWA) publishes the MUTCD, which contains all national design, application, and placement, standards, guidance, options, and support provisions for traffic control devices. The purpose of the MUTCD is to provide uniformity of these devices, which include signs, signals, and pavement markings, to promote highway safety and efficiency on the Nation's streets and highways.

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2. Q: What is the legal status of the MUTCD?

A: The MUTCD is adopted by reference in accordance with Title 23, United States Code, Section 109(d) and Title 23, Code of Federal Regulations, Part 655.603, and is approved as the national standard for designing, applying, and planning traffic control devices.

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3. Q: Does the MUTCD apply to all roads and streets in the United States?

A: Yes. In Title 23 of the Code of Federal Regulations, Part 655.603 states that the MUTCD is the national standard for all traffic control devices installed on any street, highway, or bicycle trail open to public travel.

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4. Q: What does "open to public travel" mean?

A: Title 23 of the Code of Federal Regulations, Part 655.603 states that "for the purpose of MUTCD applicability, the phrase 'open to public travel' includes toll roads and roads within shopping centers, parking lots, airports, sports arenas, and other similar business and recreation facilities that are privately owned but where the public is allowed to travel without access restrictions. Except for gated toll roads, roads within private gated properties where access is restricted at all times are not included in this definition. Parking areas, driving aisles within parking areas, and private highway-rail grade crossings are also not included in this definition."

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5. Q: Are State and local agencies required to use metric units?

A: No, States and local agencies are not required to use metric units. The 2009 MUTCD uses only English units, but metric equivalents for all English unit values in the MUTCD are provided in Appendix A2 of the MUTCD so that those who choose to use metric measurements will have them available.

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6. Q: The FHWA publishes the MUTCD, but who decides which traffic control devices are selected and installed?

A: The individual State and local highway agencies (not the FHWA) select, install, operate, and maintain all traffic control devices on all public roadways (including the Interstate and the U.S. numbered systems) nationwide. On private roads open to public travel, the owner is responsible, although in some jurisdictions the State or local governments may exercise some approval requirements over private road traffic control devices, especially in the development approval process and in building and occupancy permits.

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7. Q: How often do MUTCD standards change, and how are the changes made?

A: The MUTCD is a dynamic document because standards change to address travel patterns and road conditions, and to incorporate technology and materials advancements. FHWA has stated its intention to issue a new edition of the MUTCD approximately every 5 years, and to keep revisions to an absolute minimum between new editions. The FHWA previously relied on periodic updates, usually every 2 to 3 years, to revise existing manuals. The 1988 edition was updated with many revised pages seven separate times over a period of 12 years, until a new edition was produced in 2000. The practice of keeping field personnel abreast of amendments to the MUTCD by mailing updates proved unsatisfactory because traffic planners and engineers had difficulty identifying whether or not they were applying the most recent "updated" version. This is one reason why the official version of the

manual is now published by FHWA on the Internet only. All MUTCD revisions and new editions must be adopted via the Federal Register rulemaking process, which involves publishing a Notice of Proposed Amendments (NPA) soliciting comments, analyzing comments, and publishing a Final Rule.

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8. **Q: Are the figures, tables, and illustrations in the MUTCD standards, guidance, options, or do they have no particular status?**

A: There is no single answer to this. As stated in paragraph 11 of the Introduction of the MUTCD: "Figures and tables, including the notes contained therein, supplement the text and might constitute a Standard, Guidance, Option, or Support. The user needs to refer to the appropriate text to classify the nature of the figure, table, or note contained therein." For example, the text may state that a sign shall be located as shown in Figure X-XX. The portion of that figure that is referred to in the text as being a "shall" condition would thus be a Standard, even though other portions of the figure may illustrate other things that are not Standards.

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9. **Q: I am a manufacturer of traffic control devices that are fully compliant with the MUTCD. Can I advertise my products as "FHWA Approved" or "MUTCD Approved"?**

A: The FHWA does not approve or endorse individual devices or products as being MUTCD compliant. It is not appropriate to include the terms "FHWA Approved" or "MUTCD Approved" in product literature or advertisements. State and local highway agencies are responsible for assuring that devices they use on public roads under their jurisdiction are compliant with the MUTCD. Note that highway agencies, before using a product, usually have other determinations they must make, such as whether the product meets the agency's qualification criteria, has been tested for quality, durability, etc., and meets the agency's detailed product specifications. The FHWA is not involved in these determinations. For some products, State and local highway agencies need to determine whether the product has been found to be crashworthy in accordance with NCHRP Report 350. The FHWA Office of Safety is responsible for reviewing and accepting crashworthiness tests of devices and appurtenances (such as supports) that are placed within the right of way. That is a completely separate issue from MUTCD compliance. For information on NCHRP 350 certification, please refer to the Office of Safety's Web site at http://safety.fhwa.dot.gov/roadway_dept/policy_guide/road_hardware/index.cfm.

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Private Roads Applicability

1. **Q: Are ring roads, circulation roads, access roads, driveways, and fire lanes on private properties such as shopping malls included in the definition of "private roads open to public travel"?**

A: Definition 159 in Section 1A.13 defines "Private Road Open to Public Travel" as including "roads within shopping centers" without specifying certain types of such roads. The terms "ring road," "circulation road," "access road," "driveway," and "fire lane" are in common use and have general understanding in the commercial development industry but have not been precisely defined for regulatory purposes such as the MUTCD. Individual commercial developments and the private roads within them exhibit a very wide variety of physical conditions and layout designs. Thus, it is not possible at this time to provide any precise definitions or clarifications beyond the language already included in the Code of Federal Regulations and the MUTCD.

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2. **Q: Who will enforce the provisions of the MUTCD on private roads?**

A: Private roads open to public travel are now subject to the same traffic control standards as public streets and highways. However, the FHWA does not believe it is necessary for State and/or local highway agencies to have specific authority or enforcement responsibility for traffic control devices on private roads to ensure compliance with the MUTCD. Owners or parties responsible for such private roads are encouraged to bring the traffic control devices into compliance with the MUTCD and other applicable State Manuals, and those who do not may find themselves exposed to increased tort liability. State and local jurisdictions can encourage MUTCD compliance on private roads by incorporating pertinent language into zoning requirements, building and occupancy permits, and similar controls that they exercise over private properties.

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3. Q: Does the MUTCD apply to private parking lots, such as at shopping malls?

A: No. The Introduction of the 2009 MUTCD and the changes to the Code of Federal Regulations (23 CFR 655.603(a)) that were adopted on December 16, 2009, make it clear that the MUTCD does not apply to parking areas and driving aisles within parking areas, either privately or publicly owned. While MUTCD general principles and standard traffic control device designs should be used in parking areas, there are some MUTCD provisions that do not easily translate to conditions typically found in parking lots and parking garages. Consideration of making the MUTCD apply to parking areas may occur in the future after development of appropriate and feasible standards and guidance for the application of traffic control devices in parking areas.

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4. Q: My shopping center has 90-degree or angled parking spaces directly adjacent to the store entrances. A main driving lane runs next to those spaces, parallel to the building frontage, and carries significant traffic leading to and from the shopping center entrance/exit. On the other side of this main driving lane is the large shopping center parking lot. Would this main driving lane be considered a roadway or a "driving aisle"?

A: It depends on whether the driving lane is separated from the adjacent parking lot. Definition 133 in Section 1A.13 clearly states that parking spaces must be separated from the roadway in order to be considered a "parking area." Thus, if the driving lane described in the question is separated from the adjacent parking lot, it would typically be considered a roadway and not a driving aisle within the parking area. Conversely, if there is no separation of the driving lane from the adjacent parking lot, it would typically be considered a driving aisle of the parking lot. It is important to understand that, because of the wide variety of site layouts on private property, it is not possible to make generalizations. Each specific case needs to be analyzed individually by the property owner and/or its engineering consultants to make a judgment of where the MUTCD would apply or not apply. Such judgments and the reasoning used should be documented by the owner for use in the event that future claims arise over the issue of MUTCD applicability.

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State MUTCDs and State Supplements to the National MUTCD

1. Q: My State has its own State MUTCD. Is that allowed, and if so how does a State MUTCD relate to the Federal MUTCD?

A: Yes, State MUTCDs are allowed. Title 23 of the Code of Federal Regulations requires all States to do one of three things within two years after a new national MUTCD edition is issued or any national MUTCD amendments are made: 1) adopt the new or revised national MUTCD as the standard for traffic control devices in the State; 2) adopt the national MUTCD with a State Supplement that is in substantial conformance with the new or revised national MUTCD; or 3) adopt a State MUTCD that is in substantial conformance with the new or revised national MUTCD.

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2. Q: What does substantial conformance mean in regard to State Supplements and State MUTCDs?

A: In 2006 a specific definition of substantial conformance was added to the Code of Federal Regulations. 23 CFR 655.603(b) states that "substantial conformance means that the State MUTCD or supplement shall conform as a minimum to the standard statements included in the National MUTCD" and that "the guidance statements contained in the National MUTCD shall also be in the State Manual or supplement unless the reason for not including it is satisfactorily explained based on engineering judgment, specific conflicting State law, or a documented engineering study." This section of the CFR also allows FHWA to grant exceptions in cases where a State MUTCD or supplement cannot conform to standard statements in the National MUTCD because of the requirements of a specific State law that was in effect prior to the January 16, 2007 effective date of this provision, if FHWA determines the non-conformance does not create a safety concern. Also, legal precedents have determined that State Supplements and State MUTCDs can be more prescriptive than the national MUTCD. This means that a State can make a national MUTCD "should" condition a "shall" condition in that State, can allow in that State only one of several national MUTCD optional designs for a particular device, or can prohibit the use in that State of a particular optional device. However, State Supplements and State MUTCDs cannot omit or change a national MUTCD "shall" to a "should" or change a "should" to a "may". The FHWA reviews each State Supplement and State MUTCD and makes determinations as to substantial conformance.

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3. Q: From the perspective of a local agency, how do the State Supplements or State MUTCDs apply to the local roads? Are the local agencies bound to the State standards, which in turn are bound to the Federal standards?

A: The State law will govern in most circumstances. Each State enacts its own laws regarding compliance with standards for traffic control devices in that State. If the State law has adopted a State Supplement or a State MUTCD that FHWA has found to be in substantial conformance with the national MUTCD, then those State requirements are what the local road agencies (as well as the State DOT) must abide by. The exception is when traffic control devices are installed on a federal aid project, in which case the Code of Federal Regulations (23 CFR 655.603(d)(2)) specifically requires those devices to comply with the national MUTCD before the road can be opened or reopened to the public for unrestricted use.

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Compliance Dates

1. Q: What Federal Register contains all the compliance dates for new standards?

A: The Federal Register dated December 16, 2009, contains the final rule that adopted the new 2009 MUTCD standards. This Federal Register notice is located on the MUTCD web site. The compliance dates for updating existing devices in the field to comply with the changes effective with the 2009 edition are given in that Federal Register final rule in the discussions of individual changes. A list of all currently relevant compliance dates (including those established by prior final rules) is contained within the 2009 MUTCD itself, in Table I-2 in the Introduction on pages I-4 to I-6.

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2. Q: If there is no compliance date for one of the new requirements, when do devices in the field have to be upgraded to meet the requirement?

A: Each State, in cooperation with its political subdivisions, is required by Federal law (23 U.S.C. 402(a)) to have a program for the systematic upgrading of substandard traffic control devices and for the installation of needed devices to achieve conformity with the MUTCD. The program should include dedicated time to properly assess traffic control operations and needs, budgeting of funds required for implementing MUTCD changes and, to the extent possible, and accomplishing the changes either when the devices are no longer serviceable because they reach the end of their service life or otherwise need to be replaced, or when other events such as highway improvement or reconstruction projects occur. Specific compliance dates have been established for only a few new requirements in the MUTCD that are of critical safety importance justifying upgrading existing devices before they may be at the end of their service life, or in cases where the new MUTCD requirement is for an action, such as a study, that is not related to service life.

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3. **Q: If there is a compliance date, does that mean our new installations don't have to comply with the new provision of the MUTCD until that date?**

A: No, all new or reconstructed devices installed anytime after a new MUTCD is adopted must be in compliance with the new MUTCD provisions, regardless of whether or not there is a compliance date established for a given provision in the Manual. Compliance dates apply to existing devices in the field that don't meet the new MUTCD provisions. Those existing non-compliant devices must be replaced with compliant devices by the stated compliance date.

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4. **Q: What is the penalty for not meeting a compliance date?**

A: Failure to replace non-compliant devices for which a compliance date is established could result in withdrawal of Federal-aid funds. Now that most States no longer have sovereign immunity, tort liability in lawsuits is another possible penalty for non-compliance, especially in situations where a crash has occurred that might be attributed to inadequate, inappropriate, or noncompliant traffic control devices.

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Printing, Copying or Obtaining Copies of the MUTCD

1. **Q: How can I get a copy of the MUTCD?**

A: You can print your own copy directly from this web site. Downloading and printing instructions are included on the MUTCD web site. Please read the instructions provided and if you are still experiencing difficulties after making the suggested adjustments, please submit your problem to Operations Feedback and you will receive a reply. Alternatively, you can purchase a bound copy, a 3-ring notebook loose-leaf version, or a CD-ROM version through any of the four national associations listed below:

[American Association of State Highway Transportation Officials \(AASHTO\)](#)

[Institute of Transportation Engineers \(ITE\)](#)

[American Traffic Safety Services Association \(ATSSA\)](#)

[International Municipal Signal Association \(IMSA\)](#)

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2. **Q: The larger MUTCD parts or chapters won't print, or print badly. What's wrong?**

A: Certain parts and chapters of the MUTCD have very large file sizes due to the large page count, number of illustrations, or both (for example, Part 6 has 184 pages with 60 illustrations). These large files can present problems when printing, depending on the printer used. This is often due to the amount of memory within the printer itself, which is often minimal. If the printer will not print the file, or prints it with errors, sending the file to the printer in smaller sections (10 to 20 pages at a time) often solves the problem.

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3. **Q: How can I get high-quality copies of images of signs and figures in the MUTCD? Using the "copy and paste" functions in the MUTCD Web site's PDF documents doesn't produce images that are high enough resolution for my needs.**

A: Before attempting to copy an image from a page of the MUTCD PDF, try this: Using the zoom tool of Adobe Acrobat, increase the magnification to at least 200% or 300%, then use the snapshot tool to select the portion of the page you want to copy and paste. Often that will produce an image that is of very good quality. If that is not sufficient for your needs, a private web site (www.trafficsign.us) maintained by Mr. Richard Moeur of the Arizona Department of Transportation is a convenient source of high quality images of MUTCD signs. Also, FHWA's MUTCD Team can provide, on request, copies of any MUTCD figure in high-resolution PDF or EPS format.

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4. **Q: Is the text of the MUTCD available in Microsoft Word format?**

A: Yes, this is available on request from the MUTCD Team.

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5. **Q: Is the MUTCD copyrighted? Do I need permission from FHWA to copy material from the MUTCD and include it in a book or other type of document?**

A: The MUTCD is in the public domain and as such it is not copyrighted. Individuals can use material from the online version of the MUTCD, such as tables, figures, and text quotations, without seeking permission from the FHWA. When using or referencing material from the MUTCD, please be sure to reference the source as the MUTCD, 2009 Edition, published by FHWA at http://mutcd.fhwa.dot.gov/pdfs/2009/pdf_index.htm. It is also helpful to include the section and paragraph number of the material quoted, so that readers can easily find the material in context within the full MUTCD.

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Other Topics

1. **Q: What is the National Committee on Uniform Traffic Control Devices (NCUTCD), and what is its role?**

A: The NCUTCD is a private organization that has no official association with the Federal government. Its current membership is more than 250 traffic control device experts, representing a wide variety of organizations, who have a major interest in and experience with traffic control device issues. The majority of the NCUTCD members are employees of State and local agencies and are involved in the daily operation of highways or streets. NCUTCD members are volunteers receiving no compensation for their contributions. Committee members meet twice a year to discuss the Manual and develop consensus recommendations, which are then submitted to the FHWA for consideration. The NCUTCD is also one of many organizations and individuals that reviews FHWA's proposals for MUTCD changes and submits comments to the rulemaking docket. For more information on the NCUTCD, including its history dating from 1932, see their web site at www.ncutcd.org.

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2. Q: Are there PowerPoint slides showing the changes from the 2003 to the 2009 MUTCD?

A: Yes, the FHWA's MUTCD Team has prepared PowerPoint slides that provide details and examples for the significant changes from the 2003 edition to the 2009 edition. These slideshows are posted on the MUTCD Web site under "Training", near the bottom of the navigation bar along the left side of the page.

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3. Q: Why doesn't the MUTCD contain standards for the design and spacing of speed humps and bumps?

A: Speed bumps and humps are considered "physical features" of a roadway rather than traffic control devices (TCDs), so the MUTCD does not address the height, width, length, or spacing of the actual humps and bumps. The Institute of Transportation Engineers (www.ite.org) publishes technical guidance on criteria, dimensions, spacing, etc. of speed humps that many cities and counties use in developing their own policies for these features. The pavement markings and signs used to warn road users of the physical features of the road, such as signs and markings for speed humps, are TCDs and are therefore covered by the MUTCD.

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4. Q: Where can I obtain more information about the historical development of traffic control devices and the MUTCD, and why certain colors, shapes, designs, dimensions, etc. were chosen?

A: One of the best references on questions about the history of traffic control devices is a 1971 publication entitled "Traffic Devices---Historical Aspects Thereof." This book is available from the Institute of Transportation Engineers (www.ite.org). Also, Dr. H. Gene Hawkins of Texas A&M University has compiled a great deal of historical information on the MUTCD and traffic control devices and he provides this information online at <https://ceprofs.civil.tamu.edu/ghawkins/MUTCD-History.htm>.

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EXHIBITS 44 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

CATEGORY

10BEST: Trusted Travel & Lifestyle Advice



Best Scenic Autumn Drive

As chosen by readers of USA TODAY and 10Best

[SAVE TO MY LISTS](#)

Fall Color Tou

[grayling-mi.com/fall-color-t](http://grayling-mi.com/fall-color-tour)

Explore Grayling's beautiful fall foliage and stay in a charming town of NM.

#1 - M-22

Michigan

The M-22 route along Lake Michigan is one of America's most beautiful tours, and it gets even better in the fall. This 116-mile road brings visitors through the peaceful countryside and along the shore, past small businesses, wineries, galleries and, of course, countless colorful trees. Visitors can stop and visit points of interest along the way and meet some locals, making this fall leaves trip a little bit wildlife and a little bit small town, all in one.

[Photo courtesy of Lindspetrol / Flickr](#)

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Michigan's M-22 Wins Best Scenic Autumn Drive!

Upper Delaware Scenic Byway; Kancamagus Scenic Byway; Hocking Hills Scenic Byway and Olympic Peninsula Loop Drive also winners

The kids are back in school, temperatures are starting to drop and Mother Nature's gearing up for her annual spectacle of fall color. 'Tis the season for leaf-peeping, and USA TODAY 10Best readers have been busy voting for their favorite scenic autumn drives across the USA. After four weeks of voting, we have a winner!



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According to our readers, the best stretch of road for fall leaf-peeping is Michigan's M-22, a 116-mile route along Lake Michigan that is absolutely breathtaking come autumn.

The top 10 winners in the category Best Scenic Autumn Drive are as follows:

1. M-22 - Michigan
2. Upper Delaware Scenic Byway - New York
3. Kancamagus Scenic Byway - New Hampshire
4. Hocking Hills Scenic Byway - Ohio
5. Olympic Peninsula Loop Drive - Washington
6. **Blue Ridge Parkway** - North Carolina & Virginia
7. West Elk Loop - Colorado
8. Skyline Drive - Virginia
9. Peter Norbeck Scenic Byway - South Dakota
10. Scenic Route 100 Byway - Vermont

Additional nominees for the category Best Scenic Autumn Drive were the Dutch Country Roads in Pennsylvania, Going-to-the-Sun Road in Montana, Historic Columbia River Highway in Oregon, Historic Route 1 in Maine, Jacob's Ladder Scenic Byway in Massachusetts, Middlebury Gap Road in Vermont, Mohawk Trail in Massachusetts, Pig Trail Scenic Byway in Arkansas, Roaring Fork Motor Nature Trail in North Carolina and Tennessee and Scenic 7 Byway in Arkansas.

10Best and USA TODAY extend their congratulations to all the winners.

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The Experts

Anna Hider



Anna is a writer and social media manager for [Roadtrippers](#), the coolest trip-planning site and app on the planet, where she's spent two years digging up the coolest off-the-beaten-path things for travelers to see and do. She loves hiking, exploring, and sometimes even getting lost in a good state park, and is definitely a sucker for any place with a waterfall, a ghost town or a beach.

Larry Bleiberg



Larry Bleiberg, a veteran journalist with magazine, newspaper and web experience, has spent much of his career living in, and writing about, the South. The Virginia native is former travel editor of the Dallas Morning News and Coastal Living magazine and founder of [CivilRightsTravel.com](#). He served on a Pulitzer Prize team, is a seven-time Lowell Thomas Travel Journalism Award winner, and was honored for producing the best newspaper travel section in North America. Learn more at [LarryBleiberg.com](#) or [facebook.com/larry.bleiberg](#).

Lydia Schrandt



Lydia, photo editor and Readers' Choice Production Manager for USA TODAY 10Best, has traveled to more than 30 countries in Europe, Asia and North and South America, and has lived in Albuquerque, Galveston, Austin, Thailand, Korea, China, Ecuador, Colombia, Argentina, Brazil and now Spain. When she's not at her computer in a cafe, she's out photographing the city, writing fiction or cheering on Barça.

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EXHIBITS 45 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



November 7, 2011

Attorney General Bill Schuette
G. Mennen Williams Building, 7th Floor
525 W. Ottawa Street
P.O. Box 30212
Lansing, Michigan 48909

Via email: mlag@michigan.gov, schuetteb@michigan.gov

Dear Mr. Schuette:

I hope that you will remember me from the July fundraising event at the home of John Demmer in Harbor Springs. I assisted Sarah Prues in securing the location for the event.

Afterwards, I spoke with you briefly about the M-119 road sign trademark issue, which is currently posing a threat to my parents' business, the Good Hart General Store.

You provided me your contact information and said that it would be okay to submit the information regarding this case for your review. Included in this PDF is a timeline of events, a cast of characters, and of course all corresponding documentation with an index.

In summary, we are looking for confirmation from the AG's office that use of the designated M road signs are public domain and available for public use. It is my belief that the federal government has inadvertently issued trademarks on signage that was already deemed public domain and property of the State of Michigan. Our attorney, Doug Bishop, concurs that ruling by the AG office will finally put his matter to rest.

You will find that while most parties involved in this situation are consistently seeking an exclusive use of particular signage, we remain at the other end of the equation, believing that the more entities which are promoting the signs, the greater exposure for the areas and thus an increase in travel and tourism. Our store happens to be located on (quite literally, due to early zoning laws) M-119, the Tunnel of Trees.

Please review the enclosed documentation and let me know what questions I can answer. My mother Carolyn Sutherland, the store owner, is also available to you and better versed on the topic. She can be reached at 231.526.6001 or via email at mail@goodhartstore.com.

Yours Sincerely,

A handwritten signature in black ink, appearing to read "Ami Woods".

Ami Woods
Good Hart General Store
amiwoods@mac.com or 231.881.2200

1075 North Lake Shore Drive, | Good Hart, Michigan 49737 | www.goodhartstore.com | P 231.526.7661

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MDOT000005

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Introduction Letter

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Timeline

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Cast of Characters

PAGE 10

June 10, 2008

June 10, 2008 M-119 Tunnel of Trees Heritage Route Committee Meeting Minutes showing new business where the Route Scouts are requesting use of the M-119 logo on an upcoming audio tour, t-shirts, and other merchandise. Dave Langhorst (Planner with MDOT's North Region Office in Gaylord) confirms that said signage "such as M-119 and M-22 are public domain".

PAGE 11

January 8, 2010

Trademark information for the word mark "M 119", provided to Ami Woods by Christopher Mitchell, an early attorney assisting with the situation.

PAGE 12

May 6, 2010

Email from Susan Bernquist of MDOT to Ami Woods, confirming that "MDOT considers that the image or graphic of the sign, M-119, is in the public domain."

PAGE 13

May 6, 2010

Additional email correspondence later on May 6 between Ami Woods and Susan Bernquist with MDOT, noting that "we [MDOT] don't want private companies copyrighting our sign images".

PAGE 14

July 27, 2010

Email correspondence between Laura Lawson at Black Star Farms and Ami Woods regarding an additional order of private label Good Hart General Store wine depicting the M-119 logo. Lawson eludes to a possible conflict being generated by the M-22 group.

PAGE 15-28

August 9, 2010

Letter from M-22 attorney John Di Giacomo to Tracy Pichl of North Coast Imagewear in Potoskey. North Coast was the Good Hart General Store's vendor for screenprinted merchandise during the 2009 and 2010 seasons. The letter is threatening North Coast to cease printing any apparel containing the "M-119 mark", as he claims this is infringing on his client's family of marks. The letter also includes several attachments as part of "Exhibit A".

PAGE 29

August 10, 2010

Email correspondence between Woods and Bernquist. Woods is forwarding the August 9 Di Giacomo/ Pichl letter for Bernquist's review. Email shows Bernquist forwarding the information to several people with the state including then Assistant AG in charge for MDOT, Pat Isom.

PAGE 30

August 10, 2010

Additional email from Bernquist to Woods, later August 10. Email confirms that the Assistant AG has assigned an attorney from his office to look into the situation.

PAGE 31-33

August 12

Email from Bernquist to Woods including an excerpt from the Federal Manual on Uniform Traffic Control Devices stating that, "Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by FHWA." Email further states that by law, the Michigan Manual on Uniform Traffic Control Devices must be in compliance with the federal manual. She also suggests that the trademark(s) obtained for the M-22 sign or any other Michigan M-route sign are legal.

PAGE 34-36

August 20, 2010

Email from Laura Lawson to Ami Woods stating that Black Star Farms is not able to print the Good Hart General Store private label wine due to a threat by the M-22 attorneys.

PAGE 37-39

March 8, 2011

Email correspondence between Keegan Myers and Andrew Dawley. Keegan begins the conversation on February 27, 2011 and claims that Dawley's merchandise design(s) infringe on their M-22 trademark. On March 7, Keegan emails a PDF of the Good Hart General Store wine label to Andrew Dawley asking if he[Dawley], knows who made the design. Note, the design clearly states that it is a product of the Good Hart General Store and includes the store website.

PAGE 40

April 8, 2011

First email from Keegan Myers to Ami Woods. This is also the first ever contact of any type from anyone with M-22/Broncah to anyone with the Good Hart General Store.

PAGE 41-47

April 9, 2011

Additional email correspondence between Ami Woods and Keegan Myers.

PAGE 48-49

June 14, 2011

Letter from Doug Bishop to Carolyn Sutherland after review of the documentation after the May 31 meeting.

PAGE 50-51

June 23 and 27, 2011

Emails from Sutherland to Bishop

PAGE 52

July 3, 2011

Email from Sutherland to Bishop noting that Doug Marshall had just visited the Good Hart General Store regarding the M-119 merchandise (follow-up to his wife's prior phone call).

PAGE 53

July 7, 2011

Letter from Doug Marshall to Sutherland stating that the M-119 logo is a registered trademark of Route Scouts, LLC and suggesting that the two entities settle on a "licensing arrangement".

PAGE 54

July 11, 2011

Email from Bishop to Sutherland regarding a conversation with Lee Lutes of Black Star Farms.

PAGE 55

July 12, 2011

Letter from Bishop to Brian Hall with Traverse Legal.

PAGE 56

July 15, 2011

Letter from Bishop to Sutherland regarding the response from Traverse Legal.

PAGE 57

July 18, 2011

Letter from Bishop to Sutherland regarding the suggested involvement of Mark Mueller an additional Traverse City attorney.

PAGE 58

July 19, 2011

Letter from Bishop to Di Giacomo with Traverse Legal confirming a 3pm meeting on Wednesday, July 20, 2011.

PAGE 59-86

July 20, 2011

Letter from Di Giacomo to Bishop regarding the meeting earlier that day, also including several pages of trademark information.

PAGE 87-88

July 21, 2011

Letter from Bishop to Sutherland summarizing the July 20 meeting with Di Giacomo.

PAGE 89

July 26, 2011

Letter from Bishop to Sutherland recognizing Sutherland's intent to provide all information to the state attorney general's office.

PAGE 90

July 26, 2011

Letter from Bishop to Di Giacomo regarding the trademark information provided by Di Giacomo on July 20.

PAGE 91

August 4, 2011

Response from Di Giacomo to Bishop.

PAGE 92

August 5, 2011

Letter from Bishop to Sutherland including the correspondence from August 4.

PAGE 93

August 12, 2011

Letter from Bishop to Sutherland requesting permission to respond to Di Giacomo.

PAGE 94

August 17, 2011

Letter from Di Giacomo to Bishop regarding a phone call from Doug Marshall to Traverse Legal on August 10, suggesting that Sutherland "intended to hire Marshall to print M-119 shirts".

PAGE 95

August 17, 2011

Letter from Bishop to Di Giacomo in response to his letter regarding Doug Marshall.

PAGE 96

August 17, 2011

Letter from Bishop to Sutherland regarding a phone call from Doug Marshall to Bishop & Heintz.

PAGE 97

August 17, 2011

Letter from Bishop to Di Giacomo requesting discussions end regarding Marshall.

PAGE 98

August 17, 2011

Letter from Bishop to Marshall, asking to cease and desist.

PAGE 99-102

August 29, 2011

Letter from Bishop to Sutherland including August 24 letter sent from Route Scouts attorneys Herness Dickey to Bishop regarding possible infringement, including copy of US trademark.

PAGE 103

September 8, 2011

Letter from Bishop to Sutherland with proposed response to Harness, Dickey & Pierce, P.L.C.

PAGE 104-105

September 13, 2011

Letter from Bishop to Keith Miller of Harness, Dickey & Pierce, PLC.

PAGE 106

A list of Route Scouts and M-22 web links.

PAGE 107-108

An archive of the domain, www.routescouts.com showing what the website looked like on January 23, 2009.

PAGE 109

Contact information for Route Scouts, LLC as per their website from 2009.

PAGE 110-112

View of the current domain, www.routescouts.com showing that the site is no longer promoting M-119 related products.

PAGE 113-114

Whois lookup for the domain, www.routescouts.com showing that the site is registered to a Matthew Diamond of Bellevue, Washington.

PAGE 115

August 19, 2011

Email between Ami Woods and Matthew Diamond, the current registrant of the domain, www.routescouts.com asking what happened to the M-119 information on the site. He replied stating that he has no information on the Route Scouts group that Woods is referring to.

PAGE 116-121

Photographs of 2011 Good Hart General Store merchandise.

PAGE 122-126

M-22 trademark information printed from the M-22 website, www.m22online.com.

PAGE 127-128

M-22 company history from the M-22 website, noting a business start up year of 2006.

PAGE 129-131

Wikipedia information for the M-119 roadsign.

PAGE 132

The 2010 Good Hart General Store private label used by Black Star Farms.

PAGE 133-134

The 201 Good Hart General Store private label used by Black Star Farms.

PAGE 135-136

A random photo of an "M-201" hat. Source unknown.

PAGE 137-138

A random photo of an M-119 car sticker. Car was parked at Good Hart General Store. Location where sticker was purchased is unknown.

PAGE 139

Zazzle.com page showing available of toddler M-1 apparel.

PAGE 140

Zazzle.com page showing available M-1 adult apparel.

TIMELINE

1934

Good Hart General Store opens for business.

May 22, 1971

Carolyn Sutherland purchases Good Hart General Store.

1978

Good Hart General Store begins selling merchandise promoting the greater Good Hart area. The first design includes the saying, "It's Gooder In Good Hart".

1980's

Good Hart General Store begins selling Tunnel of Trees specific merchandise, promoting M-119, the Tunnel of Trees.

Fall 2006

M-22 of Traverse City goes into business selling merchandise depicting the M-22 road sign.

2008

Route Scouts, LLC is established as a business located near Harbor Springs, selling audio tours of M-119 and M-119 related merchandise.

March 31, 2008

The domain name, www.routescouts.com is registered to Matthew Diamond in Bellevue, Washington.

June 10, 2008

Tunnel of Trees Heritage Route Committee Meeting Minutes show new business where the Route Scouts are requesting use of the M-119 image. Dave Langhorst (Planner with MDOT's North Region Office in Gaylord) confirms that said signage "such as M-119 and M-22 are public domain".

2009

As rumors and grumblings begin regarding use of road sign logos, the Good Hart General Store begins researching ownership use rights with the State of Michigan.

2009

The domain, www.routescouts.com is live and promotes an audio tour of M-119. There is no mention of available merchandise on the website.

May, 2010

Good Hart General Store emails MDOT in an attempt to get information regarding ownership and use rights of the sign. MDOT confirms that all signage is public domain.

July, 2010

Black Star Farms, producing private label M-119 wine for Good Hart General Store, first warns of a possible conflict regarding use of the signage on the label.

August, 2010

M-22 group begins threatening Good Hart General Store vendors by sending a letter to North Coast Imagewear, the store's producer of M-119 apparel.

August, 2010

Black Star Farms refuses to print more private label wine for Good Hart General Store pending a conflict derived by the M-22 group.

March, 2011

M-22 group contacts another entity, Andrew Dawley of Petoskey, regarding Dawley's production of M-119 merchandise sold on Facebook and cites trademark infringement.

April, 2011

M-22 group first contacts Good Hart General Store requesting a meeting to discuss suggested trademark infringement.

May, 2011

Good Hart General Store retains Doug Bishop with Bishop & Heintz to discuss the situation with M-22.

June, 2011

Heidi Marshall with Route Scouts, LLC phones Sutherland claiming to have a trademark on M-119 and demands that the store cease printing all M-119 merchandise, also threatens to sue.

July, 2011

Doug Marshall also with Route Scouts, LLC writes Sutherland also citing a trademark infringement, and suggesting a "licensing agreement" as a solution to the matter.

July 20, 2011

Traverse Legal (M-22) and Bishop & Heintz (Good Hart General Store) meet to discuss the trademark situation.

August 10, 2011

Doug Marshall phones both Traverse Legal and Bishop & Heintz regarding the M-119 logo situation also threatening trademark infringement.

August 17, 2011

Bishop requests that Marshall cease and desist.

August, 2011

Route Scouts, LLC attorneys, Harness Dickey Law Firm, write to Bishop regarding the M-119 trademark situation.

September, 2011

Bishop responds to the Harness Dickey letter from August.

November, 2011

All information is sent to the office of Bill Schuette, State AG.

CAST OF CHARACTERS

Carolyn Sutherland
Owner of Good Hart General Store

Ami Woods
Daughter of Carolyn Sutherland (handling marketing efforts for Good Hart General Store)

Good Hart General Store
Continually operating general store located in Good Hart, Michigan.

Doug Bishop
Attorney with Bishop & Heintz of Traverse City, attorneys to Carolyn Sutherland/Good Hart General Store as of May, 2011

Matt and Keegan Myers
Brothers, owners of M-22 Online and Broneah Kiteboarding

M-22 Online/Broneah Kiteboarding
A store front and online operation based in Traverse City, Michigan selling M-22 apparel and merchandise since 2006.

John DiGiacomo, Esq.
Attorney with Traverse Legal of Traverse City, attorney to Keegan and Matt Myers (M-22/Broneah Kiteboarding)

Route Scouts, LLC
A group believed to be local to Harbor Springs, claiming to have a trademark on the M-119 logo and supposedly producing audio tours and M-119 merchandise.

Doug Marshall
An official spokesperson for Route Scouts, LLC

Heidi Marshall
An official spokesperson for Route Scouts, LLC (wife of Doug Marshall)

H. Keith Miller
Attorney representing Route Scouts, LLC with the firm of Harness, Dickey & Pierce, PLC.

Laura Lawson
Winery Administrator at Black Star Farms in Traverse City, Michigan (producer of Good Hart General Store private label wines and M-22 private label wines)

Lee Lutes
Operations Manager at Black Star Farms,

Susan Bernquist
MDOT Planning

Andrew Dawley
Petoskey-resident who attempted to produce M-119 merchandise, sold via Facebook, and was told to cease and desist by M-22 representatives.

**M-119 Tunnel of Trees Scenic Heritage Route Committee
Meeting Minutes
Tuesday, June 10, 2008
West Traverse Township Hall**

Members Present

Joey Arbaugh, West Traverse Township
Richard Cobb, Emmet County Lakeshore Association
Rob Deane, Cross Village Township
Joe Engelhard, Readmond Township
Ron Krause, Readmond Township
Erio Rasmussen, Friendship Township
Carolyn Sandford, West Traverse Township
Henry Singer, Cross Village Township
Naomi Singer, Cross Village Township
Dell Weitzel, Emmet County Lakeshore Association

Guests Present

Dale Scott, Supervisor Friendship Township

Staff Present

Patty O'Donnell, Northwest Michigan Council of Governments

I. Welcome and Introductions

Richard Cobb called the meeting to order at 9:34 a.m. Introductions were made around the room.

II. Review Proposed Agenda

Motion made by Rob Deane, support by Joey Arbaugh to approve the agenda. Motion carried.

III. Approval of the May 13, 2008 Meeting Minutes

Please remove the name Joey before Rob Deane under III. Motion made by Dell Weitzel, support by Carolyn Sandford to approve the May 13, 2008 meeting minutes as amended. Motion carried.

IV. New Business

A. Route Scouts

A note was received from Joey Arbaugh regarding a visit by the Route Scouts to the Little Traverse Conservancy. The Route Scouts are proposing to create an audio tour compact disc which tells of the many cultural and other features of the M-119 corridor, along with t-shirts with the M-119 logo. The Route Scouts also proposed to donate a percentage of their receipts to the Conservancy and would like to feature the LTC logo on the clothing, hang tags, and CDs. Discussion followed regarding this type of business promoting the M-22 Highway with t-shirts, mugs, and stickers with percentage of revenue going to the Leelanau Conservancy. Dave Langhorst stated that the route markers such as M-119 and M-22 are public domain. The Little Traverse Conservancy would decide the usage of their logo. Henry Singer added that the Tunnel of Trees logo is copyrighted and other entities cannot use it. There was continuing discussion on the Committee's wishes to not market the route. Motion made by Henry Singer, support by Rob Deane that the committee has a policy of no commercialization or marketing of the Tunnel of Trees corridor and/or the use of the M-119 Tunnel of Trees Scenic Heritage Route logo, which has been copyrighted by the Committee. Motion carried. The Committee thanks Henry for copyrighting the logo in 2003 and copies of the document were distributed.

B. Heritage Route Committee Meeting Schedule

The Committee discussed the schedule of winter meetings for 2009, due to members being out of town during the winter. It was decided by consensus to keep the same schedule as 2008.

000014

From: "Mitchell, Christopher" <mitchellc@butzel.com>
Subject: RE: Trademark Matter
Date: January 8, 2010 12:40:48 PM EST
To: Ami Woods <ami@amiwoods.com>
> 1 Attachment, 5.6 KB

Dear Ami,

Further to our phone call today, I found the following registered US trademark:

M 119

Word Mark	M 119
Goods and Services	IC 025, US 022 039, G & S: Clothing, namely, t-shirts, shirts, sweatshirts, hats. FIRST USE: 20080522. FIRST USE IN COMMERCE: 20080703
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Trademark Search Facility	LETS-1 M A single letter, multiples of a single letter or in combination with a design
Classification Code	NUM-26-UP 119 Other Numerals - 26 and Up
Serial Number	77661443
Filing Date	September 3, 2008
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	March 3, 2009
Registration Number	3729510
Registration Date	December 22, 2009
Owner	(REGISTRANT) Route Scouts, LLC LIMITED LIABILITY COMPANY MICHIGAN P.O. Box 152 Harbor Springs MICHIGAN 49740
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

Best regards,

s/Chris
Chris Mitchell

BUTZEL LONG, a professional corporation
350 South Main Street, Suite 300 | Ann Arbor, MI 48104 | Tel: 734-213-3435 | Fax: 734-995-1777 | E-mail: mitchellc@butzel.com

000015

MDOT000015

From: Susan Berquist <BERQUISTS@michigan.gov>
Subject: M-119 Sign Image
Date: May 6, 2010 9:59:58 AM EDT
To: amlwoods@mac.com

Ami -

The Michigan Department of Transportation (MDOT) considers that the image or graphic of the sign, M-119, is in the public domain. MDOT considers that the images or graphics of all "M route" signs are in the public domain.

Please let me know if you have any questions.

Susan Berquist, MDOT-Planning
berquists@michigan.gov
517-335-2929

000016

MDOT000016

From: Susan Berquist <BERQUIST@nichigan.gov>
Subject: Re: M-119 Sign Image
Date: May 6, 2010 11:53:54 AM EDT
To: Ami Woods <amiwoods@mac.com>

Thanks, Ami -

I will forward this information along - In my opinion there is a problem here already with M-22 that someone at MDOT should address. It will probably be just a matter of priorities, since we are short-staffed in a lot of areas.

Susan B., 517-335-2929

>>> Ami Woods <amiwoods@mac.com> 5/6/2010 10:56AM,>>>

I will definitely keep you posted Susan. I imagine this is going to become more and more common. The M-22 folks in Traverse City (<http://m22online.com/>), state in one of the articles about them that part of their plan is to trademark other scenic highways throughout the country. I forwarded you a link to their site where they clearly state that their Trademark process is complete and they threaten infringement with legal action.

Regarding the Route Scout folks, they are a very passive and suspect group who I have yet to figure out. They do not have a real website, but rather a blog and the information is at least two years out of date. They have made a weak attempt at selling audio tours of M-119, however strangely, never approached our store (the oldest and most recognizable retail outlet along the road). Their blog is at <http://www.routescouts.com/>.

Thanks again.
Ami Woods

On May 6, 2010, at 10:15 AM, Susan Berquist wrote:

Ami - Good! And, if that lawyer for Route Scouts continues to threaten legal action, ask him for documentation that they have copyrighted the sign image for M-119. Those of us who have discussed this here at MDOT are not the lawyers, but we would be interested to see a copy of the lawyer's paper work. At some point, perhaps MDOT would have to make some sort of legal step, because we don't want private companies copyrighting our sign images.

Susan B., 517-335-2929

Ami Woods
231.881.2200 Cell
231.526.7244 Office
800.943.2353 Fax
amiwoods.com
ami@amiwoods.com

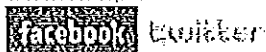
FB: [facebook.com/amiwoods](https://www.facebook.com/amiwoods)
Twitter: twitter.com/amiwoods
Blog: amiwoods.blogspot.com
LinkedIn: [linkedin.com/company/amiwoods](https://www.linkedin.com/company/amiwoods)

000017
MDOT000017

From: "Laura Lawson" <l Lawson@blackstarfarms.com>
Subject: RE: Good Hart General Store Re-Order
Date: July 27, 2010 2:01:19 PM EDT
To: "Ami Woods" <ami@amiwoods.com>
2 Attachments, 3.6 KB

Hey Ami -- so just a little heads up for you...the guy that sells the M-22 wines came in my office while we were printing off your labels. Of course you know they think they own every street sign on the planet, he threw a little fit and took a picture of the labels. Said his lawyer is going to like seeing that, blah, blah, blah. Urgh!

Laura Lawson
Winery at Black Star Farms
Winery Administrator
(231) 944-1282 phone
(231) 944-1279 fax
www.blackstarfarms.com



P please consider the environment before printing this e-mail

From: Ami Woods [mailto:ami@amiwoods.com]
Sent: Tuesday, July 27, 2010 1:05 PM
To: Laura Lawson
Subject: Good Hart General Store Re-Order

Hi There,
We would like to re-order 6 cases of red and 6 cases of white. Please let me know if there is any chance these could be ready for pick-up this Friday and if not, maybe next Tuesday. Thanks Laura. I'll wait to hear back.
Ami Woods

Ami Woods
231.881.2200 Cell
231.526.7244 Office
800.943.2353 Fax
amiwoods.com
ami@amiwoods.com

FB: [facebook.com/amiwoods](https://www.facebook.com/amiwoods)
Twitter: twitter.com/amiwoods
Blog: amiwoods.blogspot.com
LinkedIn: [linkedin.com/in/amiwoods](https://www.linkedin.com/in/amiwoods)

000018

MDOT000018

TRAVERSE CITY

August 9, 2010

North Coast Image Wear
C/O Tracy Piehl
610 West Sheridan, Suite 2
Petoskey, MI 49770
Phone: (231) 347-3016
Fax: (231) 348-2015
tracy@ncimagewear.com

RE: Infringement of M22 Trademark

Dear Ms. Piehl:

It has recently come to our attention that you are printing several products for The M119 Project, which distributes products containing a mark that infringes upon our client's registered M22 family of marks. This letter serves as your notice that any continued printing of products containing the M119 mark will subject you to significant liability for contributory trademark infringement and vicarious liability under federal law.

Our client is the holder of registered trademarks for M22 in a variety of International Classes and for use in association with several different goods or services. Specifically, our client holds a registered trademark for M22 for use in association with wine (Registration No. 3427900) and M22 for use in association with apparel, specifically, hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, and tank tops (Registration No. 3348635). Our client also has two applications currently pending registration in front of the US Patent and Trademark Office for M22 for use in association with retail shops featuring clothing, sporting goods, and novelty items (Serial Nos. 85040494 and 85041051), as well as an application for M22 Challenge for use in association with entertainment in the nature of competitions in the field of athletics (Serial No. 85089688). Evidence of these trademarks are attached to this letter as Exhibit A. Our client also holds common law rights in the M22 family of marks by virtue of its longstanding use of those marks in commerce.

000019

MDOT000019

August 9, 2010

Page 2 of 2

Consequently, our client's M22 mark has become well and favorably known across the world as an indicator of quality goods and services.

Understand that the test for trademark infringement applied by a court asks whether the opposing party's mark is "likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114. In examining whether a mark is likely to cause confusion, courts apply eight non-exclusive factors: (1) the strength of the plaintiff's mark; (2) the relatedness of the goods; (3) the similarities of the marks; (4) evidence of actual confusion; (5) the marketing channels used; (6) the likely degree of purchaser care; (7) the defendant's intent in selecting the mark; and (8) the likelihood of expansion of the product lines. See *Frisch's Restaurants, Inc. v. Elby's Big Boy, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982). When the likelihood of confusion test "is closely balanced, the question should be resolved in favor of the senior user." See 3 McCarthy § 23:64; see also *Dallas Cowboys Football Club, Ltd. v. Am.'s Team Props.*, 616 F. Supp. 2d 622, 637 (N.D. Tex. 2009).

We have no doubt that a court would find that the M119 Project's use of the M119 mark is confusingly similar to our client's M22 mark. Specifically, the M119 Project is currently using an identical logo, save for a change in the number displayed on the logo from 22 to 119, to sell goods in direct competition with our client's goods. This has subjected them to up to \$2,000,000 in statutory damages under the Lanham Act. 15 U.S.C. § 1117(c)(2). Further, the M119 Project can also be held liable for our client's actual costs, damages, and attorneys fees under 15 U.S.C. § 1117(a).

Also note that your printing of products for the M119 Project has subjected you to liability for the same amount, up to \$2,000,000 in statutory damages, for your contributory and vicarious infringement. Contributory infringement occurs where a third party either (a) induces a third party to infringe on a mark or (b) supplies a product to a third party with actual or constructive knowledge that the product is being used to infringe upon a mark. See *Inwood Lab, Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 853-54 (1982). Similarly, vicarious liability for trademark infringement occurs where a party (1) has the ability to stop or limit the direct infringement of a mark; (2) directly profits from the direct infringement of another's mark; and (3) declines to exercise the right to stop or limit the infringement. See *Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615, 621 (6th Cir. 2004). It is clear that, should you decide to continue printing these products, you will be subjected to liability for both contributory and vicarious trademark infringement.

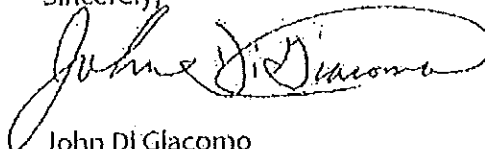
I hope that the explanation of the law contained within this letter resolves any questions that you may have as to our client's trademark rights and that you will cease printing the M119 products without the need for further legal action. With that said, our client must reserve all rights, including the right to bring a trademark infringement lawsuit for

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August 9, 2010
Page 3 of 3

contributory infringement should you continue printing these items. If you have any questions, please do not hesitate to contact me directly at 231-932-0411.

Sincerely,

A handwritten signature in black ink, appearing to read "John Di Giacomo", with a large, stylized loop at the end.

John Di Giacomo
john@traverselegal.com

000021

Exhibit A

000022

MDOT000022



United States Patent and Trademark Office

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M22

Word Mark	M22
Goods and Services	IC 033, US 047, 049, G & S: Wine, FIRST USE: 20071000, FIRST USE IN COMMERCE: 20071000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code	LETS-1 M A single letter, multiples of a single letter or in combination with a design NUM-22 The number 22 or the word Twenty-two
Serial Number	77197208
Filing Date	June 4, 2007
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	November 27, 2007
Registration	

<http://tess2.uspto.gov/bin/showfield?f=doc&state=4010:h/qhdp.2.3>

Page 1 of 2

000023

MDOT000023

Registration Number 3427900
Registration Date May 13, 2008
Owner (REGISTRANT) Broneah, Inc. CORPORATION MICHIGAN 121 E. Front St. Suite 103 Traverse City MICHIGAN 49684
Attorney of Record Enrico Schaefer
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE



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000024

MDOT000024



United States Patent and Trademark Office

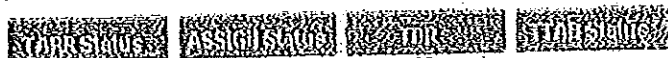
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Record 1 out of 1



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Word Mark	M 22 M22ONLINE.COM
Goods and Services	IC 025, US 022 039, G & S: Apparel specifically hats, t-shirts, long sleeve shirts, sweat shirts, pants, shorts, underwear, tank tops; FIRST USE: 20040101, FIRST USE IN COMMERCE: 20040101
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.07.01 - Diamonds with plain multiple line border; Diamonds with plain single line border 26.09.20 - Squares inside one another 26.09.21 - Squares that are completely or partially shaded
Trademark Search Facility Classification Code	ART-07.13 Billboards, Signs LETS-1 M A single letter, multiples of a single letter or in combination with a design NUM-26-UP-22 Other Numerals - 26 and Up SHAPES-DIAMONDS Diamond shaped designs including shaded or more than one diamond SHAPES-GEOMETRIC Geometric figures and solids including squares, rectangles, quadrilaterals and polygons
Serial Number	78963038
Filing Date	August 29, 2006
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	September 18, 2007
Registration Number	3348635

<http://tess2.uspto.gov/bin/showfiles?f=1&doc&state=4010:hjhqg:4:1>

Page 1 of 2

000029025

Registration Date December 4, 2007
Owner (REGISTRANT) Broneah, Inc. CORPORATION MICHIGAN 121 E. Front St. Suite 103 Traverse City MICHIGAN 49684
Attorney of Record Enrico Schaefer
Description of Mark Color is not claimed as a feature of the mark; The mark consists of an unmounted square street sign with a centered diamond containing M 22 and with M22online.com in the bottom border of the square.
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE



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[illegible]

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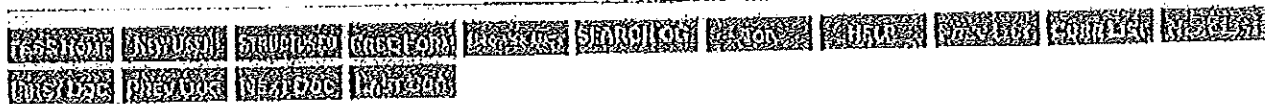
M22

Word Mark	M22
Goods and Services	IC 035, US 100 101 102, G & S: Retail shops featuring clothing, sporting goods, and novelty items.
Standard Characters Claimed	FIRST USE: 20071121, FIRST USE IN COMMERCE: 20071121
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85040494
Filing Date	May 17, 2010
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Broneali, Inc. CORPORATION MICHIGAN 121 E. Front St. Suite 103 Traverse City MICHIGAN 49684
Attorney of Record	Brian A. Hall
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Use/Good	

0000275

MDOT000027

LIVE/DEAD
Indicator LIVE



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000028

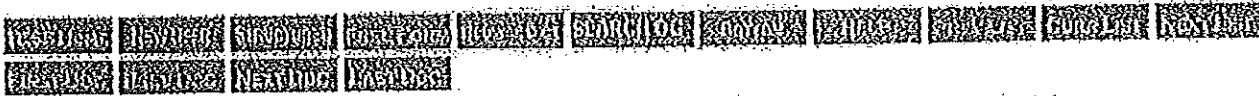


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 List At: OR to record: Record 1 out of 4

 (Use the "Back" button of the Internet Browser to return to TESS)


Word Mark M22

 Goods and Services IC 035. US 100 101 102. G. & S: Retail store services featuring clothing, sporting goods, and novelty items.
 FIRST USE: 20071121. FIRST USE IN COMMERCE: 20071121

 Mark
 Drawing (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
 Code

 Design 26.07.01 - Diamonds with plain multiple line border; Diamonds with plain single line border
 Search 26.11.21 - Rectangles that are completely or partially shaded
 Code

Serial Number 85041051

Filing Date May 18, 2010

Current Filing Basis 1A

Original Filing Basis 1A

Owner (APPLICANT) Broneah, Inc. CORPORATION MICHIGAN 121 E. Front St. Suite 103 Traverse City MICHIGAN 49684

Attorney of

000029

Attorney or
Record Brian A. Hall

Description The color(s) black and white is/are claimed as a feature of the mark. The mark consists of a small, black,
of Mark stylized letter M above a large, black number 22, within a white square, on a black background.

Type of
Mark SERVICE MARK

Register PRINCIPAL

Live/Dead
Indicator LIVE



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000030

MDOT000030

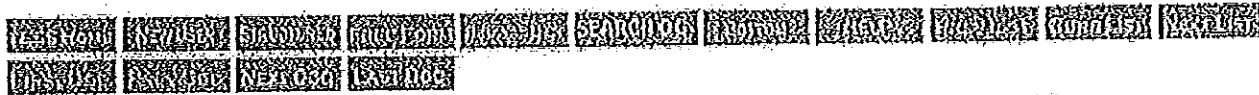


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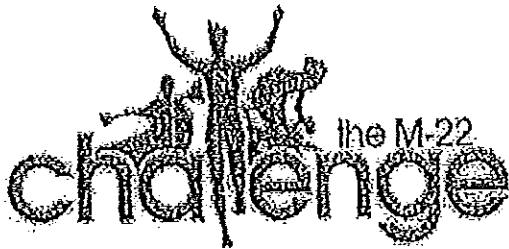
Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Aug 6 04:08:46 EDT 2010


 Please logout when you are done to release system resources allocated for you.

 List At: OR to record: Record 1 out of 10

(Use the "Back" button of the Internet Browser to return to TESS)



Word Mark THE M-22 CHALLENGE

Goods and Services IC-041, US 100 101 107. G & S: Entertainment in the nature of competitions in the field of athletics. FIRST USE: 20090201. FIRST USE IN COMMERCE: 20090201

Mark

Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design 02.01.02 - Men depicted as shadows or silhouettes of men; Silhouettes of men

Search 02.07.01 - Groups, males

Code 02.09.05 - Humans, including men, women and children, depicted running; Running, humans
02.09.19 - Diving, humans; Humans, including men, women and children, depicted playing games or engaged in other sports; Playing games or sports, humans

18.03.01 - Bicycles; Tricycles; Unicycles

18.07.01 - Boats, inflatable; Canoes; Kayaks; Row boats

18.11.07 - Boat paddles; Canoe paddles; Oars; Paddles, canoe

Serial Number 85089688

Filing Date July 21, 2010

Current

Filing 1A

Basic

Original

<http://tess2.uspto.gov/bin/showfile.df?doc&state=4008:r3hho0.3.1>

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000031

MDOT000031

Filing Basis 1A

Owner (APPLICANT) Broneah, Inc. CORPORATION MICHIGAN Suite 103 121 E. Front St. Traverse City MICHIGAN 49684

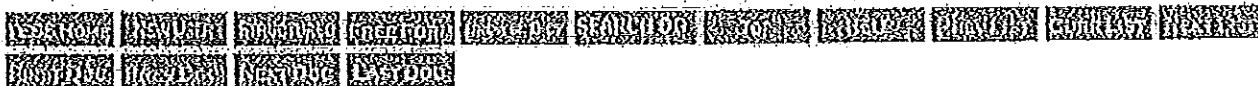
Attorney of Record Brian A. Hall

Description of Mark Color is not claimed as a feature of the mark. The mark consists of silhouettes of three individuals along with the words "the M-22 challenge". One individual is biking, one is canoeing, one is running. The running individual's legs make up the two l's in the word "challenge", and the same individual bears a stylized M22 mark on the chest; a white diamond containing "M22" on a black background.

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE



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000032

MDOT000032

From: "Susan Berquist" <BERQUISTS@michigan.gov>
Subject: Re: Fwd: M22 Trademark
Date: August 10, 2010 11:01:46 AM EDT
To: "Bates, Courtney" <BatesC@michigan.gov>, "Bott, Mark" <BottM@michigan.gov>, "Hicks, Barbara" <HicksB3@michigan.gov>, "Isom, Patrick" <IsomP@michigan.gov>, "Woods, Ami" <ami@amiwoods.com>
Cc: "Sutherland, Carolyn" <goodhart@grahamro.com>
P 2 Attachments, 1.6 MB

Ami -

Thanks for sending me the attached letter threatening legal action from the "holders" of copyright on M22 and M119 marks or images. It certainly does not seem right, but I'm no lawyer. I have copied this information to Pat Isom, Assistant Attorney General in Charge for MDOT - his office acts as MDOT's lawyer, so to speak.

Pat - Is it legal for a commercial entity to acquire copyright of MDOT M - route sign marks or images and related images? And then to legally threaten other entities if they use those images on their own publications or merchandise? I understand from Mark that the MDOT route sign images are in the public domain.

Thanks!

Susan Berquist, MDOT-Handling
berquists@michigan.gov
517-335-2929

>>> Ami Woods <ami@amiwoods.com> 8/10/2010 10:41AM >>>

Hi Susan,

Ami Woods here in Good Hart, Michigan. If you remember, I contacted you back in the spring regarding the use of the M-119 signage.

Please see the attachment. This was sent to our screen printer and I thought you would want to be in the loop. I hope to hear back with any insight you might have. I hope all is well in Lansing.

Ami Woods

Good Hart General Store

----- Original Message -----

John@TraverseLegal.com
To: tracy@ncimagerwear.com
Sent: Monday, August 09, 2010 12:08 PM
Subject: M22 Trademark

Dear Ms. Piehl:

Please see the attached letter regarding infringement of M22 Trademark. Please contact me with questions or to discuss.

Sincerely,

John A. Di Giacomo, Esq.

Traverse Legal, PLC

Email: John@TraverseLegal.com

810 Cottageview Dr, Unit G-20

Traverse City, MI 49684

231-932-0411 (office)

231-932-0636 (fax)

<http://www.traverselegal.com/>

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000033
MDOT000033

From: "Susan Berquist" <BERQUISTS@michigan.gov>
Subject: Re: Fwd: M22 Trademark
Date: August 10, 2010 11:19:33 AM EDT
To: "Woods, Ami" <ami@amiwoods.com>
Cc: "Sultherland, Carolyn" <goodhart@grahamre.com>
1 Attachment, 0.8 KB

Ami -

The Assistant Attorney General In Charge for MDOT has assigned an attorney from his office (that is, part of the overall office of the Michigan Attorney General) to look into this. I know those attorneys are very busy, so I don't know how long it will take for there to be a response, but I'll also keep YOU in the loop.

Susan B., 517-225-2929

>>> Ami Woods <ami@amiwoods.com> 8/10/2010 10:41AM >>>

Hi Susan,

Ami Woods here in Good Hart, Michigan. If you remember, I contacted you back in the spring regarding the use of the M-119 signage.

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Ami Woods

Good Hart General Store

----- Original Message -----

From: John Di Giacomo <john@traverselegal.com>

To: tracy@ndimagewear.com

Sent: Monday, August 09, 2010 12:08 PM

Subject: M22 Trademark

Dear Ms. Plehl:

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Sincerely,

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Traverse Legal, PLC

Email: john@traverselegal.com

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Traverse City, MI 49684

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000034
MDOT000034

From: "Susan Berquist" <BERQUISTS@michigan.gov>
Subject: Re: M22 Trademark
Date: August 12, 2010 1:44:02 PM EDT
To: "Ami Woods" <ami@amiwoods.com>
Cc: "Carolyn Sutherland" <goodhart@grahamre.com>, "Mark Bolt" <BoltM@michigan.gov>
1 Attachment, 30.0 KB

Hi, Ami -

Mark Bolt (MDOT Traffic and Safety) and I met with an assistant from the attorney general's office this morning. I think I may have mentioned that this office acts as legal counsel to MDOT. Therefore, they are not available to advise the general public, unless the issue directly affects MDOT. For example, if MDOT were to get a letter from Traverse Legal Counsel that said MDOT had to seek their client's permission in order to replace worn or damaged M-22 signs, located along M-22 - that would be a direct impact for "our lawyers" to deal with.

In your situation, we can offer some information. Attached is an excerpt from the Federal Manual on Uniform Traffic Control Devices - I copied this from the .PDF version of the entire manual, because it is a large file. I can provide a link to the entire file, if you like. The pertinent section I have highlighted in yellow in the attached:

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by FHWA.

By law, the Michigan Manual on Uniform Traffic Control Devices must be in compliance with the Federal manual. In effect, route marker signs, such as that for M-22 or M-119 are also in the public domain and cannot be protected by trademark. Thus, it does not appear that the trademark(s) obtained for the M-22 sign or any Michigan M - route sign, are legal.

Again, we're not lawyers, and our lawyer, from the Attorney General's office, can not provide legal advice outside of MDOT. However, if you do seek legal counsel, we can provide documentation of the information provided here.

Hope this helps!
Susan Berquist, MDOT-Planning
berquists@michigan.gov
517-335-2929

>>> Ami Woods <ami@amiwoods.com> 8/10/2010 1:22PM >>>
Thanks Susan. I hope to hear back.
Ami Woods

On Aug 10, 2010, at 11:19 AM, Susan Berquist wrote:

Ami -

The Assistant Attorney General in Charge for MDOT has assigned an attorney from his office (that is, part of the overall office of the Michigan Attorney General) to look into this. I know those attorneys are very busy, so I don't know how long it will take for there to be a response, but I'll also keep YOU in the loop.

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Hi Susan,

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Ami Woods

Good Hart General Store

----- Original Message -----

From: jonah@drave.seaball.com
To: tracy@ndimageyear.com
Sent: Monday, August 09, 2010 12:08 PM

000035

MDOT000035

Subject: M22 Trademark

Dear Ms. Pichl:

Please see the attached letter regarding infringement of M22 Trademark. Please contact me with questions or to discuss.

Sincerely,

John A. Di Giacomo, Esq.

Traverse Legal, PLC

Email: John@TraverseLegal.com

810 Cottageview Dr, Unit G-20

Traverse City, MI 49084

231-932-0411 (office)

231-932-0636 (fax)

<http://www.traverselegal.com/>

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<Mail Attachment.gif>

Ami Woods

231.881.2200 Cell

231.526.7244 Office

800.943.2353 Fax

amiwoods.com

ami@amiwoods.com

FB: facebook.com/amiwoods

Twitter: twitter.com/amiwoods

Blog: amiwoods.blogspot.com

LinkedIn: linkedin.com/in/amiwoods



Federal MUT...doc (30.0 KB)

000036

MDOT000036

From: "Laura Lawson" <l Lawson@blackstarfarms.com>
Subject: RE: M22 Trademark
Date: August 20, 2010 10:47:00 AM EDT
To: "Ami Woods" <ami@amiwoods.com>
2 Attachments, 3.5 KB

At this time our attorney is advising us not to do the label for now, unless you can take off the black area around the 119. Sorry. He is writing a letter back to the m-22 attorneys with some of the info you sent me below, hopefully this will work. I will ask our attorney if I can forward his letter to you as well. I hope we can work something out, I love working with you and you dad, and love the store.

Laura Lawson
Winery at Black Star Farms
Winery Administrator
(231) 944-1282 phone
(231) 944-1279 fax
www.blackstarfarms.com



Please consider the environment before printing this e-mail

From: Ami Woods [mailto:ami@amiwoods.com]
Sent: Thursday, August 12, 2010 8:15 PM
To: Laura Lawson
Cc: Carolyn Sutherland
Subject: Fwd: M22 Trademark

Laura,
See below. Please let me know your status on this meaning are you prepared to continue providing us private label wine or are you unable to move forward at this point when we need a re-order. Thanks and I'll talk to you soon.
Ami

Begin forwarded message:

From: "Susan Berquist" <BERQUISTS@michigan.gov>
Date: August 12, 2010 1:44:02 PM EDT
To: "Ami Woods" <ami@amiwoods.com>
Cc: "Carolyn Sutherland" <goodhart@grahamre.com>, "Mark Bott" <BottM@michigan.gov>
Subject: Re: M22 Trademark

Hi, Ami -

Mark Bott (MDOT Traffic and Safety) and I met with an assistant from the attorney general's office this morning. I think I may have mentioned that this office acts as legal counsel to MDOT. Therefore, they are not available to advise the general public, unless the issue directly affects MDOT. For example, if MDOT were to get a letter from Traverse Legal Counsel that said MDOT had to seek their client's permission in order to replace worn or damaged M-22 signs, located along M-22 - that would be a direct impact for "our lawyers" to deal with.

In your situation, we can offer some information. Attached is an excerpt from the Federal Manual on Uniform Traffic Control Devices - I copied this from the .PDF version of the entire manual, because it is a large file. I can provide a link to the entire file, if you like. The pertinent section I have highlighted in yellow in the attached:

000037

MDOT000037

Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by FHWA.

By law, the Michigan Manual on Uniform Traffic Control Devices must be in compliance with the Federal manual. In effect, route marker signs, such as that for M-22 or M-119 are also in the public domain and cannot be protected by trademark. Thus, it does not appear that the trademark(s) obtained for the M-22 sign or any Michigan M - route sign, are legal.

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Hope this helps!
Susan Berquist, MDOT-Planning
berquist@mdot.michigan.gov
517-335-2929

>>> Ami Woods <ami@amiwoods.com> 8/10/2010 1:22PM >>>
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Ami Woods

On Aug 10, 2010, at 11:19 AM, Susan Berquist wrote:

Ami -

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Susan B., 517-225-2929

>>> Ami Woods <ami@amiwoods.com> 8/10/2010 10:41AM >>>
Hi Susan,
Ami Woods here in Good Hart, Michigan. If you remember, I contacted you back in the spring regarding the use of the M-119 signage. Please see the attachment. This was sent to our screen printer and I thought you would want to be in the loop. I hope to hear back with any insight you might have. I hope all is well in Lansing.
Ami Woods
Good Hart General Store

----- Original Message -----

From: john@traverselegal.com
To: tracy@mdimagewear.com
Sent: Monday, August 09, 2010 12:08 PM
Subject: M22 Trademark

Dear Ms. Piehl:
Please see the attached letter regarding infringement of M22 Trademark. Please contact me with questions or to discuss.
Sincerely,
John A. Di Giacomo, Esq.
Traverse Legal, PLC
Email: John@TraverseLegal.com
810 Cottageview Dr, Unit G-20

000038

MDOT000038

Traverse City, MI 49684

231-932-0411 (office)

231-932-0636 (fax)

<http://www.traverselegal.com/>

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<Mail Attachment.gif>Error! Filename not specified.

Ami Woods

231.881.2200 Cell

231.526.7244 Office

800.943.2353 Fax

amiwoods.com

ami@amiwoods.com

[Facebook: facebook.com/amiwoods](https://www.facebook.com/amiwoods)

[Twitter: twitter.com/amiwoods](https://twitter.com/amiwoods)

[Blog: amiwoods.blogspot.com](http://amiwoods.blogspot.com)

[LinkedIn: linkedin.com/in/amiwoods](https://www.linkedin.com/in/amiwoods)

000039

MDOT000039

From: Andrew Dawley <andrew@motogl.com>
Subject: Fwd: TRADEMARK Issue
Date: March 8, 2011 12:03:31 PM EST
To: amfwoods@mac.com
1 Attachment, 609 KB

----- Forwarded message -----
From: Broneah Kiteboarding <broneah@broneah.com>
Date: Mon, Mar 7, 2011 at 8:53 PM
Subject: Re: TRADEMARK Issue
To: Andrew Dawley <andrew@motogl.com>

Andrew,

How's it going. I have a question for you. Can you please see the attached image? Do you know who made this, is this you?

Let me know if you have any info. Thanks Keegan!

On Mon, Feb 28, 2011 at 6:40 PM, Broneah Kiteboarding <broneah@broneah.com> wrote:
Thanks for the call today, feel free to contact us anytime with questions.

Keegan

On Mon, Feb 28, 2011 at 6:46 AM, Broneah <broneah@broneah.com> wrote:
Call anytime. Thanks!

Best regards,

Broneah Inc.
M22 llc.

231.392.2212
Broneah@broneah.com

On Feb 27, 2011, at 8:33 PM, Andrew Dawley <andrew@motogl.com> wrote:

I'll give you a call tomorrow morning to talk more.
I had purchased 2 URLs... www.m119online.com and www.m119turnofreec.com
I have switched the URL listed on my facebook page to the 2nd address.

Thanks for all the tips. Talk to you tomorrow.
Andrew

On Sun, Feb 27, 2011 at 8:05 PM, Broneah Kiteboarding <broneah@broneah.com> wrote:
Andrew,

Thanks for your email. I researched this a bit and did find your initial email. I forwarded that to Traverse Legal back on Jan 14th, but understand that it was not received by them. I assumed they would follow up with you back at that time with the answer to your initial questions. Sorry that was not the case.

Regardless, hopefully you listened to the interview and got a bit more knowledge about our brand, how we protect it, and what we have into it. For me the most upsetting thing about getting sent to your facebook site was the exact copy of the stickers and mugs, in addition the use of our same domain name, www.m119online.com as we use www.m22online.com

With the huge amount of time and effort we have into the M22 brand it's hard to see things like this pop up. Regardless we would like to talk with you about your ideas in more detail, preferably via phone. My number is 231.392.3555 or email me your and I will call ASAP.

FYI, there is another group in your area that has already tried to do the M119 mark and have since stopped production after communication with our legal team.

I understand the M119 is a great road also. But the issue is that since we were the first company to produce a brand around "a road" we

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always get customer confusion in the marketplace anytime someone tries to copy what we have created. This is exactly why we have a protected and registered trademark.

Please give me a call monday and we can discuss in more detail.

Thanks Keegan

On Sun, Feb 27, 2011 at 1:53 PM, Andrew Dawley <sales@m119online.com> wrote:

Thanks for getting back to me. I has sent you an email several weeks ago asking about the M119 design... I understand and will take the "sign" design down. I haven't sold anything from my site, so it's not a big deal.

Thanks again, I'll get those items down asap.

Andrew Dawley

On Sun, Feb 27, 2011 at 12:36 PM, Broneah Kiteboarding <broneah@broneah.com> wrote:

Hello,

A random customer of ours recently informed us of your facebook website, after viewing the link we realized where the issue came from. We understand your "tunnel of trees" logo that you use for your main image, looks great! The issue is in the sticker and mugs that you are offering online. Unfortunately those items infringe on our trademark. Please listen to the interview on the link below to understand our trademark rights. We would be happy to talk personally if you have any questions, otherwise you can send any questions directly to Traverse Legal (<http://traverselegal.com/>)

View following link:

<http://m22online.com/products-page/trademark/>

Best Regards,

M-22

"Join" on Facebook - <http://www.facebook.com/M22online>

121 East Front Street, Suite 104

Traverse City, MI 49684

www.M22online.com

231-360-9090

BRONEAH

"Join" on Facebook - <http://www.facebook.com/Broneah>

121 East Front Street, Suite 103

Traverse City, MI 49684

www.broneah.com

231-392-2212

Best Regards,

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MDOT000041

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www.broneah.com
231-392-2212

..
Best Regards,

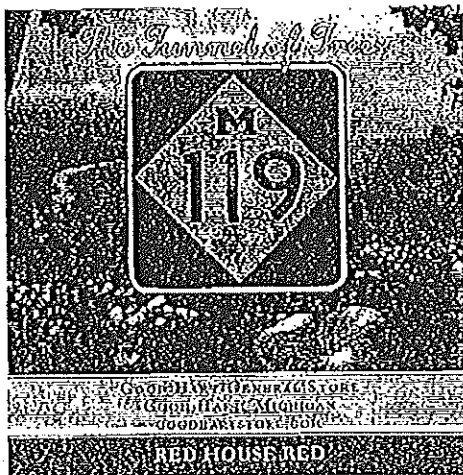
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www.broneah.com
231-392-2212



000042

MDOT000042

From: Broneah Kiteboarding <broneah@broneah.com>
Subject: M22 CONTACT
Date: April 8, 2011 5:44:18 PM EDT
To: amirwoods@mac.com, amir@amirwoods.com
Cc: Matt Myers <matt@broneah.com>

Amir,

We wanted to contact you in efforts to have a face to face meeting with you regarding the M119 logo you have been using. Please let me know if it would be possible. We are available anytime, and if necessary we could come up north or maybe meet in the middle!

Thanks Keegan

..
Best Regards,

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"Join" on Facebook - <http://www.facebook.com/M22online>
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www.M22online.com
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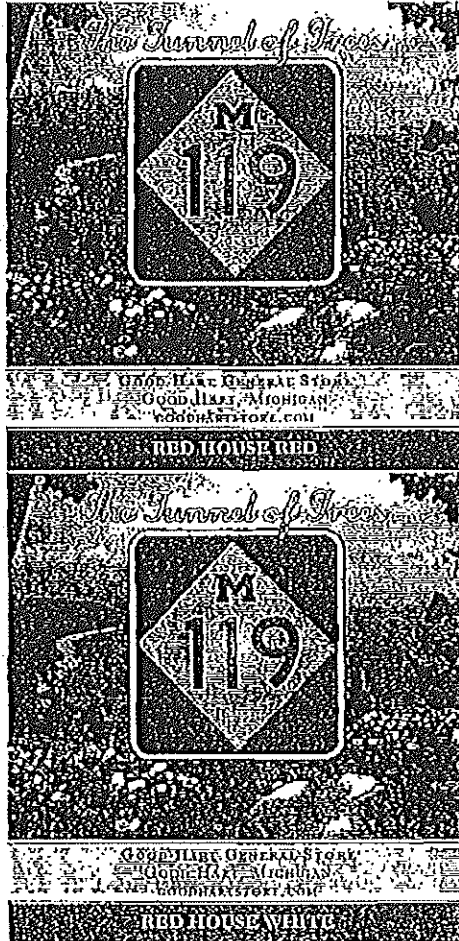
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Traverse City, MI 49684
www.broneah.com
231-392-2212

000043

MDOT000043

From: Ami Woods <amiwoods@mac.com>
Subject: Re: M22 CONTACT
Date: April 9, 2011 9:30:15 AM EDT
To: Broneah Kiteboarding <broneah@broneah.com>
2 Attachments, 1.2 MB

Thanks. Please see attached. I believe you already have this, but am resending to be sure. Yes, our store is quite a fixture and has been so for over 75 years. We know of at least 5 other businesses/organizations producing M-119 merchandise and apparel. That number seems to be rapidly growing.
Ami



On Apr 8, 2011, at 9:23 AM, Broneah Kiteboarding wrote:

Ami,

If you would not mind sending over the logo that you plan to use that would be great. Typically the best "test" for people is for something that small to stand about 10ft away, and if you think it could be confused for the M22 logo then there is probably still an issue. For a t-shirt, its more like 20ft away. Again, the only issue we have is the amount of customer confusion we get from the M119 logo. As you may know there have been multiple companies launching M119 gear in that area.

Again, we appreciate the open communication and we are happy to discuss this in efforts to create something that works for everyone involved. The store location you guys have looks incredible, what an amazing spot!

Keegan

000044

MDOT000044

On Sat, Apr 9, 2011 at 9:18 AM, Ami Woods <amiwoods@mac.com> wrote:

Thank you Keegan,
We actually don't see any confusion between M-22, M-119, or any other M road in the state as the numbers obviously differ - but if you do, then that's not to be disputed.

What we would really like to do is to proceed with our wine labels. To do so, we've modified the logo to a navy blue versus black. Please let me know if we can proceed with these working with Black Star Farms. We'd appreciate your help on this. Thanks again.
Ami Woods

On Apr 9, 2011, at 8:51 AM, Broneah Kiteboarding wrote:

Ami.

Thanks for the email. I would not say it's unfortunate that you are in FL for the month! Although it is supposed to be 70 here tomorrow!

I think the best thing at this point is for you to hear things from our perspective. We have a great interview online that discusses the use of our mark and you can listen to it at the following link:

<http://m22online.com/products-page/trademark/>

We appreciate the advice from the State's Attorney General's office and the Michigan Department of Transportation but this issue is actually a United States Patent and Trademark Office issue. Of course we would never stop anyone from using the M22 road sign for use of directions, map, or any form of transport etc.

We love the "Tunnel of Trees" concept, the only issue we have is the direct use of the black/white road sign. The largest issue we have with M119 product is that we are constantly getting emails, phone calls, and face to face discussions with people who think that anything with the M119 sign is part of our brand. We continually have to explain to people that it is not part of the M22 brand. M22 has grown to the point where anytime someone uses the black/white road emblem in a form of "marketing/branding" the general public thinks it is something that was created by the M22 brand no matter what M number is placed in the emblem. That is the whole issue. If the M119 logo could be created in a way that will avoid this customer confusion then we would not have this issue.

Let me know if that makes sense for you guys. Happy to discuss this further via email or phone if you prefer.

Thanks Keegan

On Sat, Apr 9, 2011 at 8:36 AM, Ami Woods <amiwoods@mac.com> wrote:

Hi Keegan,
Thank you so much for getting in touch with us. We definitely appreciate it and we agree that a face to face would be beneficial. Unfortunately, my entire family is in Florida until mid-May so that might not be a reality unless you want to fly south. :)

It might be best to open up a dialogue via email and work from there for now. But again, we do appreciate the offer to chat in person and maybe could take you up on that come spring.

Our business, the Good Hart General Store, has been in operation since 1934 and we've been selling M-119 and Tunnel of Trees merchandise for about the last 30 years (just about the time M-119 became exactly that... M-119). We specifically began selling items displaying the actual road sign image about 5 years ago.

We hugely respect the business that you have built for yourself, and we encourage your growth just as we do anyone promoting Michigan's scenic roadways and the landscape in general. Our theory is that the more attention to Northern Michigan as a whole, the better business will be for everyone involved.

Currently, we are looking to move forward with our private label wine production for the 2011 season. We very much value our relationship with Black Star Farms and would like to continue that relationship and even grow it in years to come. Documentation we have from the State's Attorney General's office, the Michigan Department of Transportation and research from our attorneys all confirm that the Michigan road signs are public domain. We realize that you possibly have differing information from your sources, however we can only go with what has been provided to us by those offices and organizations.

We'd like to ask at this time, for you to visit our website, familiarize yourself with our business, and then let us know how we can best work together in moving forward. Once again, we thank you for reaching out to us and look forward to hearing back. Thanks Keegan. Have a good weekend.

Ami Woods
Good Hart General Store
<http://www.goodhartstore.com>

On Apr 8, 2011, at 5:44 PM, Broneah Kiteboarding wrote:

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MDOT000045

Ami:

We wanted to contact you in efforts to have a face to face meeting with you regarding the M119 logo you have been using. Please let me know if it would be possible. We are available anytime, and if necessary we could come up north or maybe meet in the middle!

Thanks Keegan

--
Best Regards,

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Traverse City, MI 49684
www.M22online.com
231-360-9090

BRONEAH
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121 East Front Street, Suite 103
Traverse City, MI 49684
www.broneah.com
231-392-2212

Ami Woods
231.881.2200 Cell
231.526.7244 Office
800.943.2353 Fax
amiwoods.com
ami@amiwoods.com

FB: [facebook.com/amiwoods](https://www.facebook.com/amiwoods)
Twitter: twitter.com/amiwoods
Blog: amiwoods.blogspot.com
LinkedIn: [linkedin.com/in/amiwoods](https://www.linkedin.com/in/amiwoods)

--
Best Regards,

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121 East Front Street, Suite 103
Traverse City, MI 49684
www.broneah.com
231-392-2212

Ami Woods
231.881.2200 Cell
231.526.7244 Office
800.943.2353 Fax
amiwoods.com

000046

MDOT000046

From: Broneah Kiteboarding <broneah@broneah.com>
Subject: Re: M22 CONTACT
Date: April 9, 2011 10:33:24 AM EDT
To: Ami Woods <amiwoods@mac.com>
Cc: Matt Myers <matt@broneah.com>
1 Attachment, 82.4 KB

Ami,

Yes we have seen those. Please see the attached knago. It is an example of another person who changed the logo enough to make it so there will not be the continued customer confusion. The logo you sent will certainly continue the customer confusion we are working to avoid. The "navy blue" is so dark it still looks black to me. If that color was changed to a bright blue or something significantly different that would probably help alot. Or if a different design that focuses more on the Tunnel of Trees kinda fke the one attached would also be a great way to get the message across without the confusion.

The M119 sign was already attempted and denied by the United States Patent and Trademark Office due to the similarity to our logo. Instead those same people trademarked the "word" M119.

Let me know if you guys are able to make any adjustments to this design? We would not have a huge issue with you guys selling through the labels that have already been printed as long as we have some type of agreement on future designs.

Any thoughts?

Thanks Keegan!

On Sat, Apr 9, 2011 at 9:30 AM, Ami Woods <amiwoods@mac.com> wrote:

Thanks. Please see attached. I believe you already have this, but am resending to be sure. Yes, our store is quite a fixture and has been so for over 76 years. We know of at least 5 other businesses/organizations producing M-119 merchandise and apparel. That number seems to be rapidly growing.
Ami

On Apr 9, 2011, at 9:23 AM, Broneah Kiteboarding wrote:

Ami,

If you would not mind sending over the logo that you plan to use that would be great. Typically the best "test" for people is for something that small to stand about 10ft away, and if you think it could be confused for the M22 logo then there is probably still an issue. For a t-shirt, its more like 20ft away. Again, the only issue we have is the amount of customer confusion we get from the M119 logo. As you may know there have been multiple companies launching M119 gear in that area.

Again, we appreciate the open communication and we are happy to discuss this in efforts to create something that works for everyone involved. The store location you guys have looks incredible, what an amazing spot!

Keegan

On Sat, Apr 9, 2011 at 9:18 AM, Ami Woods <amiwoods@mac.com> wrote:

Thank you Keegan,
We actually don't see any confusion between M-22, M-119, or any other M road in the state as the numbers obviously differ - but if you do, then that's not to be disputed.

What we would really like to do is to proceed with our wine labels. To do so, we've modified the logo to a navy blue versus black. Please let me know if we can proceed with these working with Black Star Farms. We'd appreciate your help on this. Thanks again.
Ami Woods

On Apr 9, 2011, at 8:51 AM, Broneah Kiteboarding wrote:

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MDOT000047

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Let me know if that makes sense for you guys. Happy to discuss this further via email or phone if you prefer.

Thanks Keegan

On Sat, Apr 9, 2011 at 8:35 AM, Ami Woods <amiwoods@mac.com> wrote:

Hi Keegan,
Thank you so much for getting in touch with us. We definitely appreciate it and we agree that a face to face would be beneficial. Unfortunately, my entire family is in Florida until mid-May so that might not be a reality unless you want to fly south. :)

It might be best to open up a dialogue via email and work from there for now. But again, we do appreciate the offer to chat in person and maybe could take you up on that come spring.

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Have a good weekend.

Ami Woods
Good Hart General Store
<http://www.goodhartstore.com>

On Apr 8, 2011, at 5:44 PM, Broneah Kiteboarding wrote:

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Thanks Keegan

Best Regards,

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www.M22online.com
231-360-9090

BRONEAH
"Join" on Facebook - <http://www.facebook.com/Broneah>

000048

MDOT000048

From: Ami Woods <amiwoods@mac.com>
Subject: Re: M22 CONTACT
Date: April 9, 2011 10:39:38 AM EDT
To: Broneah Kiteboarding <broneah@broneah.com>

Thanks Keegan. I really don't want to alter our design any further. I like it and it's a very attractive label that we plan to move forward with. There are no labels printed and we are sadly out of wine. We definitely want to get moving before May. Let me talk this over with my mother, the store owner, and get back with you. I appreciate the dialogue and the information. Thanks again and we'll be in touch. Enjoy that great weather you mentioned!
Ami Woods

On Apr 9, 2011, at 10:33 AM, Broneah Kiteboarding wrote:

Ami,

Yes we have seen those. Please see the attached image. It is an example of another person who changed the logo enough to make it so there will not be the continued customer confusion. The logo you sent will certainly continue the customer confusion we are working to avoid. The "navy blue" is so dark it still looks black to me. If that color was changed to a bright blue or something significantly different that would probably help alot. Or if a different design that focuses more on the Tunnel of Trees kinda like the one attached would also be a great way to get the message across without the confusion.

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Keegan

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Ami Woods

On Apr 9, 2011, at 8:51 AM, Broneah Kiteboarding wrote:

Ami,

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MDOT000049

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Good Hart General Store

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Thanks Keegan

Best Regards,

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Add hosting, email and more.Want to buy
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Get it with our Domain Buy service.

The data contained in GoDaddy.com, Inc.'s WHOIS database, while believed by the company to be reliable, is provided "as is" with no guarantee or warranties regarding its accuracy. This information is provided for the sole purpose of assisting you in obtaining information about domain name registration records. Any use of this data for any other purpose is expressly forbidden without the prior written permission of GoDaddy.com, Inc. By submitting an inquiry, you agree to these terms of usage and limitations of warranty. In particular, you agree not to use this data to allow, enable, or otherwise make possible, dissemination or collection of this data, in part or in its entirety, for any purpose, such as the transmission of unsolicited advertising and solicitations of any kind, including spam. You further agree not to use this data to enable high volume, automated or robotic electronic processes designed to collect or compile this data for any purpose, including mining this data for your own personal or commercial purposes.

Please note: the registrant of the domain name is specified in the "registrant" field. In most cases, GoDaddy.com, Inc. is not the registrant of domain names listed in this database.

Registrant:
Matthew Diamond
778 Durgis
Bellevue, WA 98006
United States

Registered through: GoDaddy.com, Inc. (<http://www.godaddy.com>)
Domain Name: ROUTESCOUTS.COM
Created on: 31-Mar-08
Expires on: 31-Mar-12
Last Updated on: 13-May-11

Administrative Contact:
Diamond, Matthew cheshire.in.darkness@gmail.com
778 Durgis
Bellevue, WA 98006
United States
408983421

Technical Contact:
Diamond, Matthew cheshire.in.darkness@gmail.com
778 Durgis
Bellevue, WA 98006
United States
408983421

Domain servers in listed order:
NS1255.WEBSITEWELCOME.COM
NS1256.WEBSITEWELCOME.COM

Registry Status: clientDeleteProhibited
Registry Status: clientRenewProhibited
Registry Status: clientTransferProhibited
Registry Status: clientUpdateProhibited

[See Underlying Registry Data](#)
[Report Invalid Whois](#)

NameMatch Recommendations

GoDaddy.com NameMatch has found similar domain names related to your search. Registering multiple domain names may help protect your online brand against Internet squatters who could try to buy up these names in the hopes of selling them to you at an inflated price. It also enables you to capture more Web traffic, which you can then direct to your primary domain.

Domains available for new registration:

Alternate TLDs		
<input type="checkbox"/>	routescouts.co	SAVE! \$14.99/yr
<input type="checkbox"/>	routescouts.info	SAVE! \$1.99/yr
<input type="checkbox"/>	routescouts.net	SAVE! \$9.99/yr
<input type="checkbox"/>	routescouts.org	SAVE! \$9.99/yr
<input type="checkbox"/>	routescouts.us	SAVE! \$3.99/yr
<input type="checkbox"/>	routescouts.ca	SAVE! \$10.99/yr
<input type="checkbox"/>	routescouts.mobi	SAVE! \$6.99/yr
<input type="checkbox"/>	routescouts.biz	SAVE! \$5.99/yr
Similar Premium Domains		
<input type="checkbox"/>	UKRouteFinder.com	\$449.00*
<input type="checkbox"/>	UKRouteFinders.com	\$440.00*
<input type="checkbox"/>	IndianScouts.com	\$1,299.00*
<input type="checkbox"/>	RoutePath.com	\$1,888.00*
<input type="checkbox"/>	ScoutsUSA.com	\$3,488.00*
<input type="checkbox"/>	ScoutsUSA.net	\$1,488.00*
Similar Domains		
<input type="checkbox"/>	theroutescouts.com	\$11.99/yr
<input type="checkbox"/>	routescouts.site.com	\$11.99/yr
<input type="checkbox"/>	myroutescouts.com	\$11.99/yr
<input type="checkbox"/>	routescoutsonline.com	\$11.99/yr
<input type="checkbox"/>	newroutescouts.com	\$11.99/yr
<input type="checkbox"/>	routescouts.store.com	\$11.99/yr
<input type="checkbox"/>	freeroutescouts.com	\$11.99/yr
<input type="checkbox"/>	routescoutsnew.com	\$11.99/yr

Learn more about

[Private Registration](#)[Deluxe Registration](#)[Business Registration](#)[Protected Registration](#)

*Plus (CA) fee of \$0.18 per domain name year.
**CA domain names will be registered through Go Daddy/Domaines Canada, Inc., a CIRA certified registrar.

Enter a domain name to search

http://who.godaddy.com/whois.aspx?k=m1yolxZmaGOMwFOYSlyYoA==&domain=routescouts.com&prog_id=GoDaddy

Page 1 of 2

000051

MDOT000051

From: J Rad <cheshire.in.darkness@gmail.com>
Subject: Re: Route Scouts
Date: August 19, 2011 8:15:42 PM EDT
To: Ami Woods <amiwoods@mac.com>

Hi Ami,

No sorry, no clue what their story was.

M

On Wed, Aug 17, 2011 at 11:31 AM, Ami Woods <amiwoods@mac.com> wrote:

Hi Matthew,

I am actually looking for the Route Scouts website that used to be found at www.routescouts.com. I was wondering if you have any information on what happened to the site. Thanks in advance.

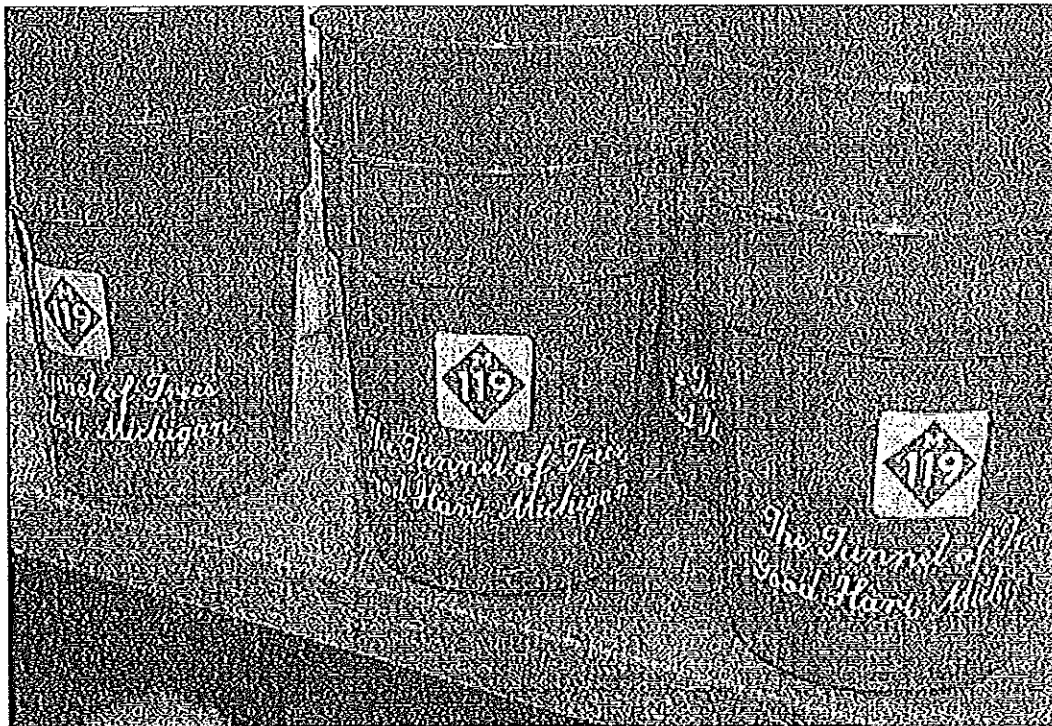
Ami Woods

000052

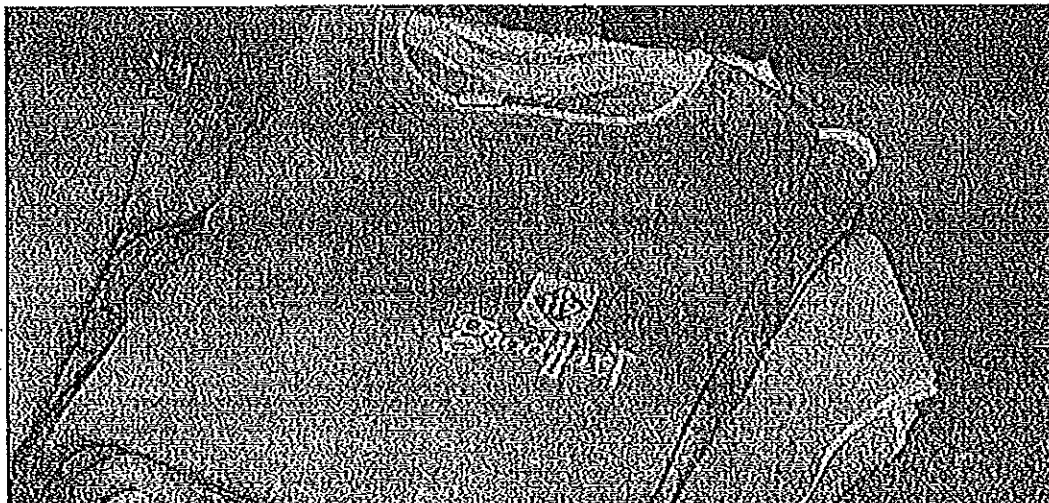
MDOT000052

From: Ami Woods <ami@amiwoods.com>
Subject: Good Hart General Store Images
Date: June 2, 2011 1:40:45 PM EDT
To: tracie1@bishopheinlz.com
12 Attachments, 643 KB

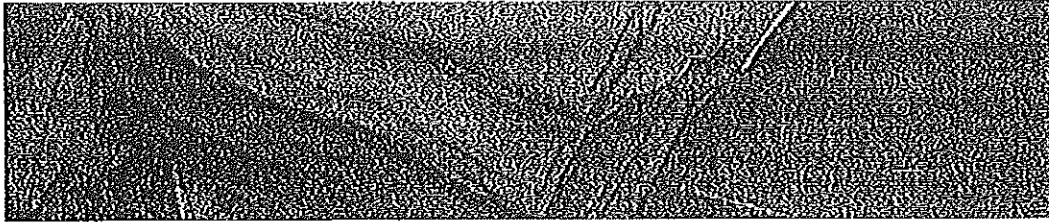
Hello Tracie,
Attached are images from our store taken this morning. I will also send along former images from past years. Thanks. Please let me know if you need anything else.
Ami Woods
Good Hart General Store



DSC_2983.NEF



000053
MDOT000053



DSC_2084.NEF

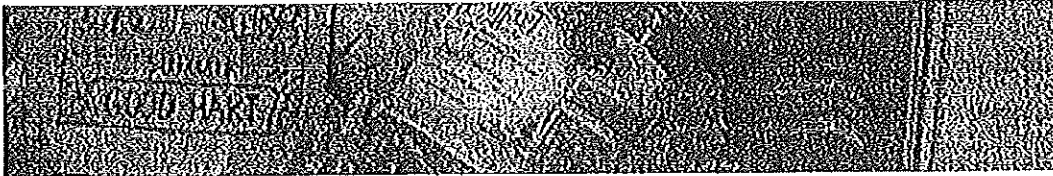


DSC_2985.NEF



000054

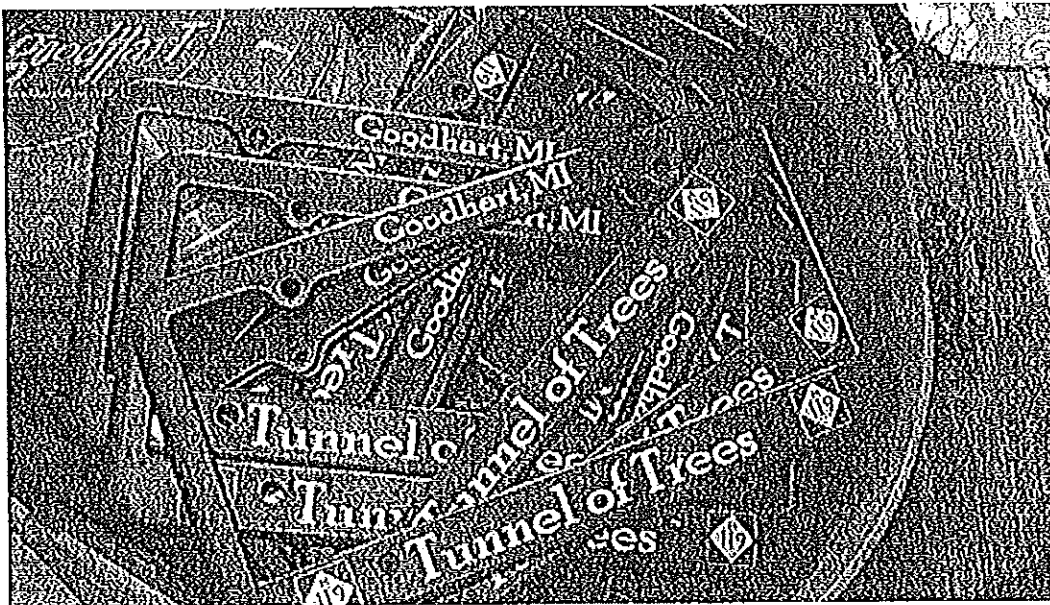
MDOT000054



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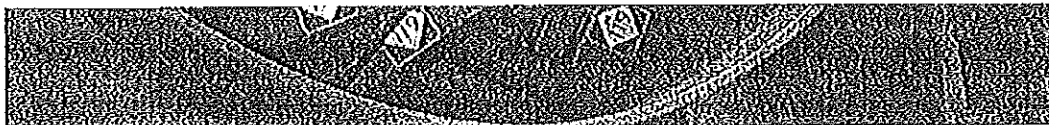


DSC_2987.NEF



000055

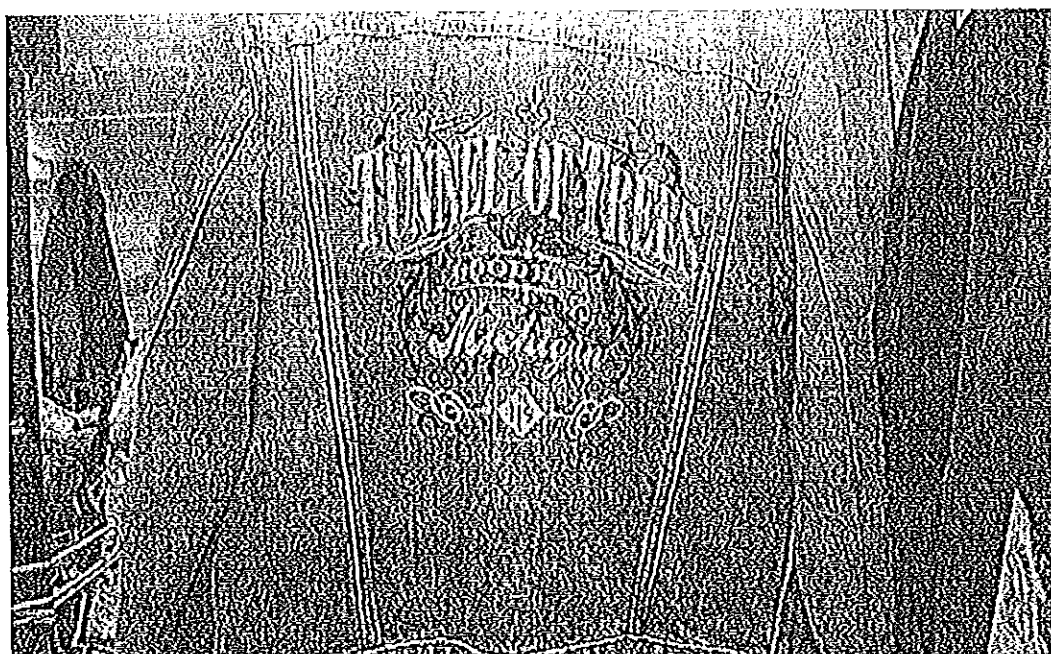
MDOT000055



DSC_2988.NEF



DSC_2989.NEF





DSC_2990.NEF



DSC_2991.NEF



000057

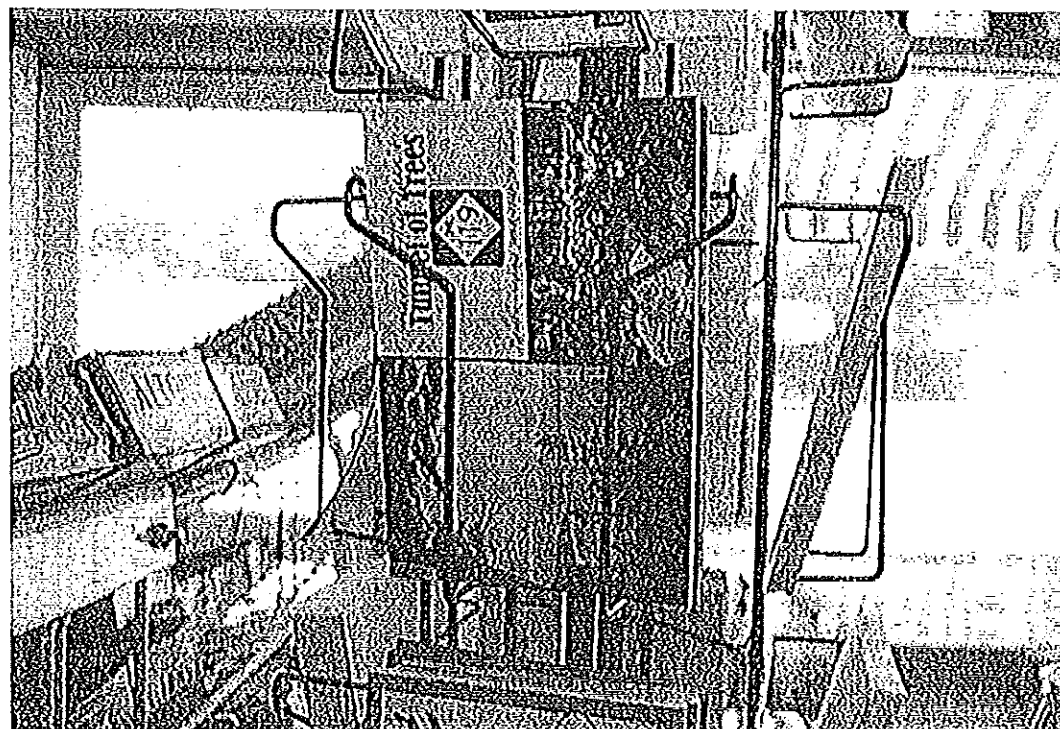
MDOT000057



DSC_2993.NEF



DSC_2994.NEF



000058

EXHIBITS 46 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

Harris, Toni (AG)

From: Lollo, Sharon (AG)
Sent: Tuesday, June 12, 2012 12:16 PM
To: Restuccia, Eric (AG); Rusty Hills (rustyhills@gmail.com); Cropsey, Alan (AG); Wright, John (AG); Isaacs, Carol (AG); Ianni, Robert (AG)
Cc: Dowker, Cristina R (AG); Nurenberg, Beth (AG); Teszlewicz, Barbara (AG); Kirkey, Alicia (AG)
Subject: FW: M22 Meeting in Traverse City at 1030 a.m.
Attachments: Map to Traverse Legal.pdf

FYI –

This meeting is to take place on Tuesday, June 26th. After Alan contacted Enrico on the matter of our opinion release, Enrico said they would like to meet with our team and asked if we would be willing to drive to Traverse City to see M-22's operation.

Alan, Eric and John Wright are scheduled to go.

From: Cathy Dittrich [mailto:cathy.dittrich@traverselegal.com] **On Behalf Of** Enrico@traverselegal.com
Sent: Monday, June 11, 2012 4:55 PM
To: Lollo, Sharon (AG)
Cc: Enrico@traverselegal.com
Subject: M22 Meeting in Traverse City at 1030 a.m.

Sharon:

This will confirm the meeting at the offices of Traverse Legal, PLC. I am attaching a map with directions to our office. We are located in the largest Renaissance zone in the country, known as the Commons in Building 20. This was known as the old Insane Asylum for Michigan.

My thought is that we will spend some time at our office going over some of the issues related to the matter. We would also like the opportunity to show you the stores, run through some numbers, and give you an idea about not only the success of the M22 brand, but its importance to the Northern Michigan economy and its global reach.

At the end of the day, we can take what we have learned and talk about any possibilities for resolution of the outstanding issues.

In the meantime, please do not hesitate to have anyone on your team contact me directly with any questions or concerns. We appreciate this opportunity and look forward to meeting with your team.

Enrico Schaefer

Cathy Dittrich
Legal Assistant to Enrico Schaefer
Traverse Legal, PLC

Email: cathy.dittrich@traverselegal.com

810 Cottageview Dr, Unit G-20
Traverse City, MI 49684
231-715-3277 (direct line)
231-932-0636 (fax)
<http://www.traverselegal.com/>

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EXHIBITS 47 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

Harris, Toni (AG)

From: Broneah Kiteboarding <broneah@broneah.com>
Sent: Friday, June 29, 2012 7:12 AM
To: Cropsey, Alan (AG); Wright, John (AG); Restuccia, Eric (AG)
Cc: Matt Myers; C Enrico Schaefer Schaefer; meganmadion@gmail.com
Subject: M22 MEETING

Alan, John, and Eric.

I wanted to thank you guys for making the trip to Traverse City to meet with us this week. We hope you were able to get a solid perspective of the M22 brand and the incredible amount of work and effort we have into it. I also wanted to send you the link to the video we showed you guys at the shop:

<http://www.youtube.com/watch?v=6K3iRqwQRVs&feature=plcp>

I hope you are enjoying the great weather.

--

Best Regards,

Keegan Myers

M-22

"Join" on Facebook - <http://www.facebook.com/M22online>

125 East Front Street

Traverse City, MI 49684

www.M22online.com

231-360-9090

BRONEAH

"Join" on Facebook - <http://www.facebook.com/Broneah>

125 East Front Street

Traverse City, MI 49684

www.broneah.com

231-392-2212

EXHIBITS 48 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

July 19, 2012

Alan Cropsy
Eric Restuccia
Michigan Department of Attorney General
525 West Ottawa Street
PO Box 30212
Lansing, MI 48909

Re: M22 Trademark – Settlement Purposes Only

Dear Alan and Eric:

Thank you for coming to Traverse City to meet with my clients Matt and Keegan Myers, investor Megan Madion (former CEO of Hagerty Insurance) and Paul Britten (president and CEO of Britten Media). We believe that the meeting was very productive and sincerely appreciate the time and effort your office put in to make it happen.

The primary topic of our meeting was Michigan Attorney General Opinion No. 7265, dated May 29, 2012. As you know, we have some general concerns about the opinion itself and its impact on all Michigan companies seeking to protect their trademark rights, as well as the opinion's specific application to the M22 trademark. It is my goal to generally discuss some of the issues herein.¹

As you know, my client owns the following federally registered trademarks for goods and services around the M22 brand they created: Reg. Nos. 3348635, 3427900, 3992151 and 3992159. I think we can all agree that Matt and Keegan Myers have done a great job promoting their brand, and incidentally the State of Michigan, in a way that is beneficial to all concerned. Our client has already established distinctiveness for all of the marks. With regard to mark 39921251 for its retail stores, my clients established secondary meaning to the examining attorney at the federal United States Patent and Trademark (USPTO) trademark office. Thus, they own distinctive marks for all M22 trademark registrations.

¹ This letter will not address all of the issues in the AG letter. Nor will it address inaccurate facts included therein. This letter is submitted under MRE and FRE 408, for settlement purposes only.

We appreciate that the state of Michigan's concern is that someone might use a road sign in an inappropriate way. Under AG Opinion No. 7265, however, anyone can use the M22 road sign for any purpose, without any limits whatsoever. Federal trademark law actually limits uses of road signs as marks in several important ways, all of which have been complied with by my clients. It seems to me that the real issue that we all ought focus on is whether we can develop an approach that is consistent with established federal trademark law and addresses the concerns of the State of Michigan over potential misuses of state road signs.

One of my goals is to outline what I believe is a better approach to the road sign/trademark issue which addresses a primary concern of the state of Michigan: (a) the use of Michigan road signs by businesses in a way which might cause confusion between the trademark owner and the state of Michigan as an institution and (b) a use which might bring disrepute to the reputation of the great State of Michigan.

1) FEDERAL TRADEMARK LAW CONTROLS

It should be noted that our clients' trademarks in M22 have 'zero' impact on the State of Michigan or the public's right to use the M22 sign as a geographic indicator. The mark registrations simply preclude another person or company from using the sign as a trademark in a way that may deceive the public as to source or origin of goods or services. Put another way, our client's trademark registrations merely gives it exclusive rights to use the M22 mark in connection with the goods/services with which it uses it so as to avoid any likelihood of consumer confusion as to the source of the goods/services in the event another commercial entity makes an infringing use. There is no conflict between the State or public's rights in the road sign and our client's exclusive right to the M22 trademark as brand.

As noted in AG Opinion No. 7265, all alleged issues related to the M22 trademarks are governed by federal trademark law. Because federal law supports the M22 trademarks, we do not believe Opinion No. 7265 affects the validity of my client's marks in any way. It may, however, inspire others to violate federal trademark law, and subject themselves to damages for trademark infringement.

The federal trademark office has already reviewed many of the issues cited in the AG opinion, including secondary meaning, and granted the M22 trademark registrations. Under 15 U.S.C. § 1115, a trademark registration is presumptive proof of validity. Under 15 U.S.C. § 1052, there are only five reasons that a trademark registration can be denied. Once registered, a trademark and can be only be invalidated for the enumerated reasons under Section 1052. Under § 1052 (f), any item may be used as a trademark under federal law and is subject to federal trademark protection. ("Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the

registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."'). Obviously, road signs are not per se precluded.

We remain aware that the Attorney General issued his opinion with limited facts available and no facts from my clients. Under § 1052, the two arguments to invalidate the M22 trademarks are noted below:

(a) Consists of ... [a] matter which may disparage or falsely suggest a connection with ... institutions ... or national symbols, or bring them into contempt, or disrepute; ...

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them ...

I will examine each provision below.

a) *M22 Mark Has Acquired Distinctiveness under the Doctrine of Secondary Meaning*

I would like to first discuss Section 1052(e), which limits the registration of items considered to describe a geographic region. The M22 mark is not 'merely descriptive' of the road known as M22. All of the relevant cases noted in the AG opinion confirm that descriptive or public domain items can achieve trademark status if they achieve secondary meaning. Our clients have invested substantial sums of money in the creation of and advertising of its mark, implemented a successful business plan that has garnered the requisite goodwill associated with its mark, and opened two stores to meet the demand from consumers who have purchased a high volume of its M22 branded items. The result, our client has established 'secondary meaning' around their mark. The federal trademark office has already agreed that the M22 marks have, through extensive marketing and branding, achieved the secondary meaning necessary to make them distinctive in the market. In short, the trademark office agrees that the M22 brand is not geographically or otherwise descriptive. Instead, it has agreed, as it relates to four separate applications for registration, that our client's M22 mark is in fact distinctive. The AG Opinion had almost no facts or basis for the opposite conclusion.

We understand that the AG Opinion did not take any position on secondary meaning, and had no facts available on that issue. While a TTAB Petition to Cancel the M22 marks as descriptive could be filed, we have little doubt that such a petition would be denied. The trademark office has already determined that secondary meaning has been established and

otherwise registered the M22 marks. Thus, the M22 marks are presumed valid. Further, M22 has invested well over \$1 million dollars establishing its M22 mark as a brand. Consumers overwhelmingly see the M22 mark placed on specific goods, such as apparel and storefronts, as a private company brand, rather than as a state road sign.

b) False Connection with the State of Michigan as an Institution

In order to be successful on a Petition to Cancel the M22 marks under Section 1052(a), a third party would need to establish that consumers believe that the State of Michigan or possibly the Michigan Department of Transportation is endorsing, sponsoring or an owner of the M22 stores and goods. Consumer surveys would need to be commissioned to establish that such a false association exists in the minds of a substantial number of consumers.

Because my clients have been building the M22 brand for over seven years, we already know the answer to this question. To our knowledge, none of the likely hundreds of thousands of consumers who have been exposed to or purchased M22 goods, or visited the M22 stores, have expressed any confusion about the goods or stores being associated with the State of Michigan or the Department of Transportation. We are unaware of any emails or anecdotal stories of consumers asking questions indicating confusion (and consumers ask a lot of question each day). Establishing that most consumers identify the M22 mark as anything but a private company would be highly improbable. There is no false association between the M22 brand and the state of Michigan.

Finally, the cases decided under Section 1052(a) make it clear that false association typically occurs when the government does the same thing that the trademark holder is trying to do (i.e. if our clients tried to open a toll road, consumers travelling that road might falsely believe it was operated by the state of Michigan). See *In re Cotter & Co.*, 228 U.S.P.Q. 202 (T.T.A.B. 1985) (WESTPOINT for firearms was rejected as falsely suggesting a connection with the U.S. Military Academy (West Point)). Conversely, where the government has no existing fame or notoriety with regard to the goods being offered by the trademark owner, there can be no false association. See *43 Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc.*, 43 U.S.P.Q.2d 1193(D.D.C. 1997) (a composite mark consisting of the word HEROES on a shield design with a picture of the U.S. capitol building in the shield does not violate § 2(a) because it does not mislead persons into assuming that the U.S. government has sponsored or approved of the charitable services symbolized by the mark); see also *44 U.S. Navy v. United States Manufacturing Co.*, 2 U.S.P.Q.2d 1254, 1987 WL 123804 (T.T.A.B. 1987) (When used on orthopedic devices, the letters "USMC" did not point uniquely to the United States Marine Corps).

Interestingly, Section 1052 identifies numerous items associated with government functions that are specifically precluded from registration. Specifically, § 1052 (b) precludes registration of “the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” Case law makes it clear that an ‘insignia’ of a State, or the United States, is very narrow and that this provision does not include road signs. “Flags and coats of arms “are specific designs formally adopted to serve as emblems of governmental authority.” Trademark Manual of Examining Procedure § 1204. Such “insignia” include the U.S. flag, the Great Seal of the United States, the Presidential Seal. *In re United States Dep't of the Interior*, 142 U.S.P.Q. 506, 507 (TTAB 1964).” *Heroes, Inc. v. Boomer Esiason Hero's Found., Inc.*, CIV. A. 96-1260 (TAF, 1997 WL 335807 (D.D.C. June 6, 1997) amended, CIV.A. 96-1260(TAF), 1997 WL 350097 (D.D.C. June 16, 1997)

There is no ‘catch-all’ provision that exempts other government landmarks, buildings, symbols or designs, thus making them available for trademark use and registration. In fact, the USPTO has a specific classification for design marks that use monuments, buildings, human beings, flags, crowns, geographical maps and other items directly out of the public domain. In fact, the trademark office has a specific design classification, 18.15.03, for road signs used as trademarks.² http://tess2.uspto.gov/tmdb/dscm/dsc_18.htm#1815

One need only look as far as Liberty Mutual Insurance, and its use of the Statue of Liberty, to know that matters in the public domain and related to the government have regularly been used as private company trademarks. <http://tess2.uspto.gov/tmdb/dscm/index.htm#toc>. Other examples are Patagonia apparel (a city/region in South America), New York Life’s use of a New York City building it neither built nor owns, COCA COLA’S use of the US Capital building for its Civil Action Network, the Seattle Sonic’s use of the Space Needle and many others. (*Exhibit A*). There are thousands of other examples of trademark use of otherwise ‘public’ and ‘private’ images, designs and outlines.

2) SPECIFIC RESPONSES TO AG OPINION 7265

a) Dastar Corp v. Twentieth Century Fox Films Corp.

AG Opinon No. 7265 focuses primarily on a Supreme Court case which considered whether a company whose copyright in a film has expired as a matter of law can then re-label the film

² “Transport; equipment for animals; traffic signs - This category includes all types of land, water and air vehicles, whether powered by animals, humans or motors. Equipment for animals such as saddles, leashes and horseshoes are found here. Traffic signs including stop signs, road signs and buoys are found in category 18.”

as a trademark in order to extend their intellectual property rights beyond that provided by the Copyright Act. The AG opinion states:

“Even work that was previously subject to copyright protection cannot be protected under trademark law if the work has passed into the public domain. *Dastar Corp v Twentieth Century Fox Film Corp*, 539 US 23, 34; 123 S Ct 2041; 156 L Ed 2d 18 (2003). See also *Comedy III Productions, Inc v New Line Cinema*, 200 F3d 593, 595; 53 USPQ2d 1443 (CA 9, 2000) (“[T]he Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity”).

Even the AG Opinion recognizes that the limitations of copyright owners to try and repackage their expired copyrights as trademarks is a limit on “former rights-holders.” (“But once a copyright in a creative work expires, the former rights-holder may not enforce his or her exclusive control over the intellectual property). Even assuming the State of Michigan could have claimed copyright ownership over its state road signs, which as noted below it could not, the limitations of *Dastar* would only apply to limit the State of Michigan from extending its expired copyright as a trademark.

The Attorney General's reliance on the Supreme Court decision in *Dastar* is misplaced for a more basic reason. *Dastar* dealt with the very narrow issue of a copyright expiring and a large proportion of film clips from a TV series being thereafter claimed by the former copyright owner as a trademark. The *Dastar* limitation precluding a copyright owner whose copyright has expired to try and extend the life of the copyright by claiming a trademark applied only to “communicative works.” A communicative work is typically a film or book (“a communicative product—one that is valued not primarily for its physical qualities, such as a hammer, but for the intellectual content that it conveys, such as a book or, as here, a video. The purchaser of a novel is interested not merely, if at all, in the identity of the producer (the publisher), but also, and indeed primarily, in the identity of the creator if the story it conveys (the author)”).

“In *Dastar Corp. v. Twentieth Century Fox Film Corp.*, the Supreme Court established that where the good in question is a “communicative product . . . such as . . . a video,” the term “origin” in Section 43(a) refers to “the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.” *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 443, 2011 U.S. Dist. LEXIS 80337, 101 U.S.P.Q.2D (BNA) 1283 (S.D.N.Y. 2011) (citing *Dastar*, 539 U.S. 23, 29, 123 S. Ct. 2041, 156 L. Ed. 2d 18 (2003)).

As stated in Dastar:

Although purchasers do care about ideas or communications contained or embodied in a communicative product such as a video, giving the Lanham Act special application to such products would cause it to conflict with copyright law, which is precisely directed to that subject, and which grants the public the right to copy without attribution once a copyright has expired, e. g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225, 230.

Obviously, a road sign is not a communicative work whose value is within its intellectual expression such as a movie or book. As also noted below, there was never, nor could there ever have been, a copyright in a purely functional state road sign such as M22. Finally, a copyright owner is not trying to extend the life of an expired copyright by repackaging it as a trademark.

b) Public Domain Items as Trademarks

The AG Opinion states: “The MUTCD is consistent with case law establishing that materials or works in the public domain are not subject to trademark protection. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1352; 96 USPQ2d 1681 (Fed Cir, 2010) (“If the mark is not inherently distinctive, it is unfair to others in the industry to allow what is in essence in the public domain to be registered and appropriated, absent a showing of secondary meaning”). The AG Opinion analyzes no fact nor provides any analysis as to whether M22 has achieved secondary meaning.

Works in the public domain are regularly trademarked and available for trademark under law. As noted in *Chippendales*, items which are not inherently distinctive may not be taken out of the public domain by trademark law *without first acquiring sufficient secondary meaning* to consumers. *Chippendales*, at 1352. M22 has already established secondary meaning to the examining attorney at the USPTO. Attacking secondary meaning in a TTAB proceeding, or in court, is an available procedural option, but would likely be considered frivolous given the worldwide notoriety of my clients’ M22 brand.

The AG's assertion is that trademark law cannot extend protection to something formerly in the public domain also tends to undermine hundreds of millions of dollars in established trademark rights of existing Michigan companies. Even in the Fifth Circuit's decision in *Singer Mfg. Co. v. Briley*, 207 F.2d 519 (5th Cir.1953), the court acknowledged that trademark protection can extend to the name “Singer,” which the Supreme Court had held was generic in 1896, where such name for use in connection with sewing machines had been “recaptured” from the public domain through continuous and exclusive use and advertising.

In the Fifth Circuit decision of *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, that court laid out what is required to establish trademark rights in an item formerly in the public domain. 510 F.2d 1004, 1014 (5th Cir. Tex. 1975), cert. denied, 423 U.S. 868 (1975). The Fifth Circuit noted that the key inquiry is whether the mark comes to symbolize a product or business in the public mind:

“An individual selects a word or design that might otherwise be in the public domain to represent his business or product. If that word or design comes to symbolize his product or business in the public mind, the individual acquires a property right in the mark. The acquisition of such a right through use represents the passage of a word or design out of the public domain into the protective ambits of trademark law. Under the provisions of the Lanham Act, the owner of a mark acquires a protectable property interest in his mark through registration and use.”

Boston Professional Hockey, at 1014.

Creating trademark rights in public domain items has long been recognized under US law. The court in *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998) noted:

“[U]nder trademark law, a party acquires rights to a symbol in the public domain through use of the mark and the public's association of the mark with the user.”

Pebble Beach Co. v. Tour 18 I Ltd., 155 F.3d 526, 542 (5th Cir. 1998) (abrogated on other grounds by *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 121 S.Ct. 1255, 149 L.Ed.2d 164 (2001), & *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 234 (5th Cir. 2010)), See *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir.1975)

Over 100 Michigan companies use a form of the outline of the State of Michigan as all or part of their trademark design and seven companies use the single word ‘Michigan’ as their trademark. (Exhibit B). Thousands of Michigan companies use items from the public domain as key design elements of the trademarks. Other companies using road signs as their trademark designs are attached as Exhibit C.

There are numerous other problems with the AG Opinion's rendition of trademark law, and the misapplication of copyright principles to trademark issues. Trademark law does indeed protect items that have entered the public domain. In fact, most design marks come directly out of the public domain. The Fifth Circuit noted that the question of whether a public

domain item achieves trademark status is whether the mark comes to symbolize a product or business in the public mind, also known as secondary meaning:

“An individual selects a word or design that might otherwise be in the public domain to represent his business or product. If that word or design comes to symbolize his product or business in the public mind, the individual acquires a property right in the mark. The acquisition of such a right through use represents the passage of a word or design out of the public domain into the protective ambits of trademark law. Under the provisions of the Lanham Act, the owner of a mark acquires a protectable property interest in his mark through registration and use.” *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir. Tex. 1975), cert. denied, 423 U.S. 868, 96 S.Ct. 132, 46 L.Ed.2d 98 (1975).

Put another way, the moment any mark from the public domain acquires distinctiveness (by establishing secondary meaning) and serves as the exclusive identifier of the source of the goods or services sold in connection with the mark, trademark rights vest in the source owner. I am confident we can all agree now, having shown our client's use and operation, secondary meaning has been established.

The primary problem with an opinion in Michigan that public domain items cannot be subject to trademark protection, beyond the fact that it is directly contrary to established federal law, is that it diminishes the intellectual property value and goodwill of all Michigan companies who have used public domain elements as part of their design marks. The impact of such language goes well beyond M22 or road signs, and potentially gives safe harbor to any third party infringing a Michigan company mark using public domain elements. Such infringers can rely on the Opinion's language to avoid a finding of 'intentional infringement' and thus avoid all of the penalty provisions under the Lanham Act which provide leverage to trademark owners. We recognize that protection of consumers was likely the impetus for the AG Opinion, but it has (albeit quite possibly inadvertently) the opposite effect since it would eliminate the only true way of ensuring there is no likelihood of consumer confusion – trademark law. As a result, our client should maintain the exclusive right to use its M22 mark in connection with the goods and services it offers, which in no way overlap with the State of Michigan, and, as necessary, rely upon trademark law to enforce its rights for the purpose of avoiding consumer confusion.

c) Road Signs as Copyrights

Even if *Dastar* were read to broadly preclude trademarks where a copyright has expired under law, there was never a copyright in the M22 road sign, nor did any copyright expire under law. A fundamental premise of the AG analysis of *Dastar* is that the State of Michigan

intentionally abandoned its existing copyright in the road sign, relegating it to the public domain. As noted above, the fact that an item exists in the public domain does not disqualify it from achieving distinctiveness through secondary meaning. More importantly, Michigan could not claim a copyright in something created by the State to be functional. Functional items are specifically precluded from being copyrighted. In *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140 (9th Cir. 2003), the court noted:

“Lamps Plus's mechanical combination of four preexisting ceiling-lamp elements with a preexisting table-lamp base did not result in the expression of an original work of authorship as required by § 101. Lamps Plus did not create any of the “design ... features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects” of any of the lamp's component parts. 17 U.S.C. § 101. But cf. *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir.1987) (“Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.”). The Victorian Tiffany table lamp “lacks the quantum of originality needed to merit copyright protection.” *Satava*, 323 F.3d at 811.” *Id.* at 1147.

To the extent the AG Opinion is keyed by the false premise of a voluntary relinquishment of any copyright into the public domain, its position is clearly distinguishable and without legal support. The M22 road sign was never subject to copyright protection, was never claimed as a copyright and did not expire as a copyright under the Copyright Act.

d) The Manual on Uniform Traffic Control Devices (MUTCD)

The fact that the MUTCD places traffic control devices in the public domain is of no importance to the primary issue of whether a person or company has created secondary meaning in that design, sufficient to make it distinctive. The language in the MUTCD that “Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright” clearly applies to federal and state agencies implementing road signs. This makes both legal and practical sense, since the federal government would not want states to limit other states in the use of road signs.

Regardless, any interpretation of the MUTCD that is in conflict with federal Lanham Act enacted by Congress would be outside the rule making authority of such agency and preempted. Here, the federal Lanham Act specifically precludes the denial of any trademark not otherwise specifically precluded under the Act. It is hard to imagine any scenario where the Department of Transportation would be authorized to limit trademark rights otherwise allowed under the Lanham Act.

Conclusion.

The State of Michigan should not limit the intellectual property rights of trademark owners or interpret trademark rights in a way more limited than what federal law allows. Such an approach only serves to make Michigan less attractive to businesses and creates uncertainty for Michigan companies trying to build value in their intellectual property rights, not to mention erases the efforts of our client and others like it that have invested in their brand by relying upon federal law. Under the current AG Opinion, any person or company could use a road sign for any purpose, without any limits, since a road sign would never be considered a trademark no matter how used. The opinion allows people to use the road signs in ways that diminish the image of Michigan. Strip bars, liquor stores, cigarettes, condoms and a host of other products might find safe haven under AG Opinion No. 7265.

A better approach was actually raised at our Traverse City meeting. Michigan should support intellectual property and trademark rights to the extent allowed under federal law and use a permit system to ensure that road signs sought to be used on goods and services is consistent with the limitations in Section 1052(a) "which may disparage or falsely suggest a connection with ... institutions ... or national symbols, or bring them into contempt, or disrepute; ..." This strikes the right balance between encouraging innovation and intellectual property creation and protecting the State's interest in making sure road sign uses are appropriate and consistent with existing federal law.

There is little doubt that the M22 brand is the shining example of how the State of Michigan would want private enterprise to use a road sign as a brand. The M22 brand has created over 100 Michigan jobs and has become one of the most significant success stories of any northern Michigan company over the last few years. The M22 brand compliments state tourism goals and can be found across the United States and the world. The M22 brand has the potential to be as large as the Patagonia or Moosejaw brands. Creating a system that encourages other road sign usages, as 'positive message' brands would put Michigan out front on both the pro-business and business innovation fronts. That should be Michigan's goal, which accomplishes the goal of avoiding consumer confusion while maintaining the functional integrity of its road signs.

July 19, 2012

Page 12 of 12

We look forward to continuing the discussion. Please let me know if there is any further information you need or questions you may have.

Very truly yours,

TRAVERSE LEGAL, PLC

A handwritten signature in black ink, appearing to be 'ES' with a large, stylized flourish.

Enrico Schaefer
enrico@traverselegal.com

ES/cad
Enclosures

EXHIBITS 49 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

Harris, Toni (AG)

From: Restuccia, Eric (AG)
Sent: Friday, February 01, 2013 8:33 AM
To: 'Broneah Kiteboarding'; Matt Myers
Cc: Matt Myers; C Enrico Schaefer Schaefer; Cropsey, Alan (AG); Wright, John (AG); Lollo, Sharon (AG)
Subject: RE: M-22 Meeting -- February 4, 2013

Keegan,

Yes, thanks for the reminder! I had intended to email yesterday.

The meeting will be here at the Williams Building, in Lansing, 525 W Ottawa. We will meet in our Kelley Library.

Here is my cell phone number -- (517) 749-6052 -- in case anything comes up.

I have a few things to discuss, but my thought is that since you have asked for the meeting, that I am looking for you all to take the lead in what you would like to see happen.

Let me know if you have any questions.

Otherwise, see you on Monday, February, 2013 at 2 pm.

Eric

B. Eric Restuccia
Michigan Deputy Solicitor General
P.O. Box 30212
Lansing, Michigan 48909
Office: (517) 373-1124
Facsimile: (517) 373-3042
Email: restucciae@michigan.gov

-----Original Message-----

From: Broneah Kiteboarding [mailto:broneah@broneah.com]

Sent: Friday, February 01, 2013 8:13 AM

To: Restuccia, Eric (AG); Matt Myers

Cc: Matt Myers; C Enrico Schaefer Schaefer; Cropsey, Alan (AG); Wright, John (AG); Lollo, Sharon (AG)

Subject: Re: M-22 Meeting -- February 4, 2013

Eric.

We are still waiting from a confirmation from your office for the Monday meeting. We would like to hear back from you regarding the specific meeting location and time before we commit to the trip.

We hope to hear from you at some point today to confirm.

Thanks Keegan

On Mon, Jan 28, 2013 at 8:12 PM, Broneah Kiteboarding <broneah@broneah.com> wrote:

Eric.

Please let us know the specific details for the meeting. Location and any other info we should have. Thanks Keegan

On Tue, Jan 15, 2013 at 1:28 PM, Restuccia, Eric (AG) <RestucciaE@michigan.gov> wrote:

Keegan,

Consistent with our conversation last week, I am hoping to pin down a date and time for a meeting to discuss your November 30, 2012 letter. From our conversation, we had discussed Monday, February 4, 2013 as a possible meeting date.

Given that you and Matt would be traveling in from Traverse City, it would make sense for us to set the meeting for the early afternoon. How does 2 pm on February 4, 2013 sound?

Let me know.

Thanks.

Eric

B. Eric Restuccia
Michigan Deputy Solicitor General
P.O. Box 30212
Lansing, Michigan 48909
Office: (517) 373-1124 <tel:%28517%29%20373-1124>
Facsimile: (517) 373-3042 <tel:%28517%29%20373-3042>
Email: restucciae@michigan.gov

--

Best Regards,

M-22

"Join" on Facebook - <http://www.facebook.com/M22online>

125 East Front Street

Traverse City, MI 49684

www.M22.com

SHOP# 231-360-9090

BRONEAH

"Join" on Facebook - <http://www.facebook.com/Broneah>

www.broneah.com

SHOP# 231-392-2212

--

Best Regards,

M-22

"Join" on Facebook - <http://www.facebook.com/M22online>

125 East Front Street

Traverse City, MI 49684

www.M22.com

SHOP# 231-360-9090

BRONEAH

"Join" on Facebook - <http://www.facebook.com/Broneah> www.broneah.com SHOP# 231-392-2212

EXHIBITS 50 TO
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

2012 Mich. OAG No. 7265 (Mich.A.G.), 2012 WL 1980356

Office of the Attorney General
State of Michigan
Opinion No. 7265
May 29, 2012

TRADEMARKS

***1 Michigan highway route marker design as a trademark**

No entity can lawfully claim exclusive control over use of the State's highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law.

Honorable Frank D. Foster
State Representative
The Capitol
Lansing, MI 48909

You ask whether a private entity can legally claim exclusive control over a state highway route marker design for use on novelty merchandise and other items.

Information supplied with your request indicates that at least two **Michigan** corporations claim to have exclusive control over the use of a **Michigan** highway route marker design. (Attachment 1.) The first corporation claims to have exclusive control over the use of the plain characters "M 22" as well as the M-22 highway route marker design, to promote various goods and services. State Highway M-22 is a picturesque and well-traveled 116-mile drive along Lake **Michigan** through Manistee, Benzie, and Leelanau Counties.¹ The first corporation obtained registrations for a trademark and service mark² with the United States Patent and Trademark Office (USPTO) for the standard character mark "M22" (Attachment 2) with no particular claim to color, style, or design. The corporation also obtained a separate registration for a design identical to the M-22 highway route marker. (Attachment 3.)

The second corporation claims exclusive control over the use of the plain characters "M 119" when used to promote goods and services. State Highway M-119 is known as the "Tunnel of Trees," and is a 20-mile, scenic drive stretching between the Petoskey area and Cross Village in Emmet County.³ The second corporation obtained a USPTO registration for the plain character mark of "M 119" (Attachment 4) with no particular claim to color, style, or design.⁴ The second corporation applied for a trademark on the design of the M-119 highway route marker, but failed to obtain one because the USPTO deemed it too similar to the M-22 registered trademark. Nevertheless, the second corporation claims exclusive control over use of the M-119 highway route marker design to promote goods and services.

Both corporations have demanded that other businesses stop using the **Michigan** highway route marker designs for M-22 and M-119 to promote their own goods and services.

You ask whether these entities or others may claim exclusive control over **Michigan's** highway route marker design through trademark law or by other means.

Trademarks are governed under federal law by the Lanham Act, 15 USC 1051 *et seq.*, and under state law by the **Michigan** Trademark and Service Mark Act (MTSMA), 1969 PA 242, MCL 429.31 *et seq.*, and common law. Definitions under each body of law are distinct, but a trademark may generally be understood to mean "any visible sign or device used by a business enterprise to identify its goods and distinguish them from those made or carried by others."⁵

***2** Federal trademark law represents an exercise of Congress' authority under the Commerce Clause. *Dawn Donut Co v Hart's Food Stores, Inc.*, 267 F2d 358, 365 (CA 2, 1959). The purpose of the Lanham Act is to prevent consumer confusion in the marketplace by providing an assurance to a consumer about the origin of the goods or services the consumer purchases. Foley, Kathryn M., *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 Conn L Rev 921,

939 (February 2009). When a consumer purchases a good or service with a registered trademark, the consumer has some certainty about the origin of the good or service and can make an informed decision on whether to complete the purchase. See *Shakespeare Co v Lippman's Tool Shop Sporting Goods Co*, 334 Mich 109, 113-114; 54 NW2d 268 (1952) (observing that "[t]he function of a trade-mark is simply to designate the goods as the product of a particular manufacturer or trader and to protect his good will against the sale of another's product as his").

Trademarks are similar to but distinct from copyrights. Copyrights protect creative works and are created under authority of the Copyright Clause of the United States Constitution, which states that Congress can create laws "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." US Const art 1, § 8, cl 8; *Trade-Mark Cases*, 100 US 82; 25 L Ed 550 (1879). The purpose of copyright law is to enrich the public domain of creative works by rewarding creativity with the opportunity to have a limited monopoly over a creative work. *Sony Corp of America v Universal City Studios, Inc*, 464 US 417, 477; 104 S Ct 774; 78 L Ed 2d 574 (1984) (citations omitted).

But once a copyright in a creative work expires, the former rights-holder may not enforce his or her exclusive control over the intellectual property. *Kellogg Co v Nat'l Biscuit Co*, 305 US 111, 120-122; 59 S Ct 109; 83 L Ed 73 (1938); *Singer Mfg Co v June Mfg Co*, 163 US 169, 185; 16 S Ct 1002; 41 L Ed 118 (1896). The creative work becomes public property. *Singer Mfg Co*, 163 US at 185. "The prevailing view of the public domain is that of a commons, where material is free for anyone to take and use without restriction." Heymann, Laura A., *The Trademark/Copyright Divide*, 60 SMU L Rev 55, 85 (Winter 2007). Thus, items in the public domain generally are not subject to copyright protection. See *Golan v Gonzales*, 501 F3d 1179, 1189 (CA 10, 2007) ("[T]he principle [is] that no individual may copyright a work in the public domain, [[in] that ordinarily works in the public domain stay there") (citations omitted).

Unlike copyrights, the term of a trademark is indefinite. "[F]ederal trademark law provides the grant of rights to the trademark owner for an indefinite period, the duration of which depends on public recognition that the trademark identifies the user's goods and distinguishes them from the goods of others." *Time Mechanisms, Inc v Qonaar Corp*, 422 F Supp 905, 910 (DNJ 1976) (citation omitted). It is thus possible for a trademark owner to maintain rights in a registered mark in perpetuity, so long as the registration with the USPTO is renewed every ten years. 15 USC 1058-1059.

***3** With these general legal principles in mind, the question is whether Michigan's state highway route marker design is in the public domain and thus not subject to trademark or other similar protections.

Both federal and state law provide for a uniform system of traffic control devices. In 1971, the United States Department of Transportation, Federal Highway Administration issued regulations designed to bring uniformity to the roadways of the United States pursuant to the Highway Safety Act of 1966. These regulations are set forth in the federal Manual on Uniform Traffic Control Devices (MUTCD). The federal MUTCD is promulgated by the Department of Transportation and sets "the national standard for all traffic control devices installed on any street, highway, or bicycle trail open to public travel," 23 CFR 655.603(a); 23 CFR Part 655, Subpart F, "in accordance with" 23 USC 109(d) and 23 USC 402(a).⁶ See 23 CFR 655.603. In order to remain eligible for federal highway and highway safety program funds, a state must adopt the federal MUTCD as a state regulation, adopt a state MUTCD that is approved by the Secretary of Transportation as being in "substantial conformance" with the federal MUTCD, or adopt the federal MUTCD in conjunction with a state supplement. See 23 USC 109(d), 23 USC 402(c); 23 CFR 655.603(b)(3).

Consistent with these federal provisions, the Michigan Vehicle Code, 1949 PA 300, MCL 257.1 *et seq.*, requires the Michigan Department of Transportation (MDOT) and the Michigan State Police to adopt and maintain a uniform system of "traffic control devices," which includes all signs,⁷ that conforms with the federal MUTCD. See MCL 257.608.⁸ In compliance with the Michigan Vehicle Code, MDOT has adopted versions of the Michigan MUTCD that are consistent with the federal manual regarding guidelines on how to create and utilize Michigan traffic control devices.⁹ The federal manual suggests a default design for state highway route markers with a white circle imposed on a black square featuring the respective highway number in black. (Attachment 5, Page 2). But it allows states the option to create a unique design, and Michigan chose to maintain its historic design using a white diamond rather than a circle, and a block "M" over the black number. (Attachment 5, Page 4.)¹⁰

With respect to traffic control device designs — like Michigan's highway route marker design — both the federal and the

Michigan MUTCD provide that such designs are in the public domain:

*Any traffic control device design or application provision contained in this Manual shall be considered to be in the public domain. Traffic control devices contained in this Manual shall not be protected by a patent, trademark, or copyright, except for the Interstate Shield and any items owned by [the Federal Highway Safety Administration]. [Emphasis added; Attachment 5.]*¹¹

*4 The MUTCD is consistent with caselaw establishing that materials or works in the public domain are not subject to trademark protection. See *In re Chippendales USA, Inc.*, 622 F3d 1346, 1352; 96 USPQ2d 1681 (Fed Cir, 2010) (“If the mark is not inherently distinctive, it is unfair to others in the industry to allow what is in essence in the public domain to be registered and appropriated, absent a showing of secondary meaning”). Even work that was previously subject to copyright protection cannot be protected under trademark law if the work has passed into the public domain. *Dastar Corp v Twentieth Century Fox Film Corp*, 539 US 23, 34; 123 S Ct 2041; 156 L Ed 2d 18 (2003). See also *Comedy III Productions, Inc v New Line Cinema*, 200 F3d 593, 595; 53 USPQ2d 1443 (CA 9, 2000) (“[T]he Lanham Act cannot be used to circumvent copyright law. If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity”). Accordingly, Michigan’s highway route marker design cannot — indeed “shall not” — be subject to trademark protection as provided for in the MUTCD.

The State of Michigan created the highway route marker design and could claim ownership of the copyright if it had not expressly abandoned those rights by proclaiming in the MUTCD that the designs are in the public domain. See 17 USC 201(a)-(b). “Rights gained under the Copyright Law may be abandoned. Abandonment of such rights, however, must be manifested by some overt act indicative of a purpose to surrender the rights and allow the public to copy.” *Hampton v Paramount Pictures Corp*, 279 F2d 100, 104; 125 USPQ 623 (CA 9, 1960) (citations omitted). By publishing the designs to the public with the statement that the designs are to remain in the public domain, the State of Michigan took an overt act to surrender its copyright in the design.

Because the State of Michigan, the creator of the design, placed the Michigan highway route marker design in the public domain, no entity can lawfully obtain intellectual property protection of the design under trademark or copyright law. The two corporations at issue could not gain copyright protection over the Michigan highway route marker design because neither created the design. See 17 USC 201(a)-(b). And under the Supreme Court’s decision in *Dastar*, they cannot use trademark law to perpetually protect a design that they did not create and is in the public domain. The fact that they have appropriated the design from the public domain and affixed it to merchandise offered for sale does not create a legitimate basis for trademark protection. To do so would create a “mutant copyright” over works in the public domain that the Supreme Court has specifically sought to avoid. *Dastar*, 539 US at 34.

The corporations may continue to utilize the Michigan highway route marker design alone or incorporate it within another design. But they must “disclaim” any right or interest in intellectual property that does not belong to them. 15 USC 1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered”).¹² Any other individual or company is also free to use the design to promote commercial goods and services.¹³ In other words, the corporations may not exclude other persons and businesses from using the Michigan highway route marker design on the basis of trademark law because a design in the public domain generally cannot be made the subject of a trademark or other protection.

*5 Despite these legal principles and facts, the first corporation registered a trademark for the M-22 highway route marker design. In addition to the route marker design being in the public domain, there are at least two other reasons why this design does not qualify for trademark protection under the Lanham Act. Each is based on section 2 of the Lanham Act, 15 USC 1052, which provides that certain marks are not permitted in the federal register, and provides a process whereby a party may challenge a registration.¹⁴

First, use of the Michigan route marker design as a trademark falsely suggests a connection with the State of Michigan. Registration for marks that “falsely suggest a connection with persons, living or dead, [or] institutions” is precluded. 15 USC 1052(a). The State of Michigan and MDOT qualify as both persons¹⁵ and institutions¹⁶ as defined in the Lanham Act, and the route marker design has been used since the early 1900’s in such a way that the State and MDOT’s reputations are directly associated with the respective roads on which it appears. The corporations’ use of the Michigan route marker design and

enforcement suggests that the State of Michigan approved or somehow licensed that use, which is not the case.

Second, use of the Michigan route marker design on the corporations' goods, is an improper trademark because it is primarily geographically descriptive, contrary to Section 2(e)(2) of the Lanham Act, 15 USC 1052(e)(2). See, e.g., *Baglin v Cusenier Co*, 221 US 580, 591; 31 S Ct 669; 55 L Ed 863 (1911) ("[N]ames which are merely geographical cannot be the subject of exclusive appropriation as trade-marks").¹⁷ The Trademark Trial and Appeal Board has stated, "[T]he purpose of Section 2(e)(2) of the [Lanham] Act is not to punish a particular business for using a geographic name, but rather to leave geographic names free for all businesses operating in the same area to inform customers where their goods or services originate." *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007), slip op. at 19, 23 (finding "'YOSEMITE'" for beer from California brewery to be primarily geographically descriptive).

Michigan trademark law requires the same. The MTMSA is a model statute based on the Lanham Act. Specifically, it mirrors section 2(e)(2) of the Lanham Act provision in order to similarly prevent geographically descriptive marks from entering the Michigan trademark register. See MCL 429.32(e).¹⁸ At common law, the Michigan Supreme Court came to the same conclusion as the Trademark Trial and Appeal Board in *Merced*, stating, "[T]he general rule is that geographic and place names may be used by all for indicating the location of a business, subject to the proviso that any such use which occasions actual or probable confusion, or misleading of the public, constitutes unfair competition and may be enjoined." *Belvidere Land Co v Owen Park Plaza, Inc*, 362 Mich 107, 113; 106 NW2d 380 (1960) (citations omitted).

*6 All of the facts presented in conjunction with your request involve placing the M-22 and M-119 Michigan highway route marker designs on apparel, novelty items, and to advertise events that all originate near the respective Michigan highways in a geographically descriptive manner. People who travel along M-22 and M-119 associate the signs with the Northwestern Lower Michigan region and everything contained within it. That association is not specific to the corporations or any other business. Instead, it encompasses the natural beauties, distinctive shopping and tourism experiences, local foods, and other attractive qualities of the geographic region. One person or company cannot claim to have produced all of the good will associated with the particular highway route marker design that represents the region. The good will does not just belong to these corporations who have used the Michigan route marker design as a trademark for the past few years. The good will belongs to the State of Michigan and its citizens who built or improved the roads and the communities that surround them.

Both federal and Michigan law support the conclusion that no entity may lawfully commandeer the Michigan route marker design as its exclusive trademark because the design is in the public domain. Other businesses in Michigan may use the M-22 route marker to promote the region as a whole, just as businesses near the "Tunnel of Trees" may use the M-119 route marker design. Indeed, the Lanham Act was not meant to deprive commercial speakers of the ordinary utility of descriptive words. "If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a mark that uses a well known descriptive phrase." *Cosmetically Sealed Industries, Inc v Chesebrough-Pond's USA Co*, 125 F3d 28, 30 (CA 2, 1997). See also *Park 'N Fly, Inc v Dollar Park & Fly, Inc*, 469 US 189, 201; 105 S Ct 658; 83 L Ed 2d 582 (1985) (noting safeguards in Lanham Act to prevent commercial monopolization of language).

It is my opinion, therefore, that no entity can lawfully claim exclusive control over use of the State's highway route marker design because the design is in the public domain and is otherwise not subject to protection under trademark law.

Bill Schuette
Attorney General

Footnotes

¹ A 64 mile segment of M-22 in Leelanau County has been designated a Michigan Scenic Heritage Route under 1993 PA 69, MCL 247.951 *et seq*. See < http://www.michigan.gov/som/0,4669,7-192-29938_30240-220123--,00.html > (accessed May 8, 2012). The "heritage route" designation may be applied to "[c]ertain portions of the state trunkline highway system [that] are so uniquely endowed by natural aesthetic, ecological, environmental, and cultural amenities immediately adjacent to the roadside that their use by a larger percentage of the motoring public, particularly during the recreational season, is for the experience of traveling the road rather than as a route to a destination." MCL 247.953.

² Trademarks and service marks are regulated under the same standards. See 15 USC 1053. The term trademark is used to refer to

both for convenience.

- ³ A 13 mile segment of M-119 has also been designated a **Michigan** Scenic Heritage Route. See <http://www.michigan.gov/som/0,4669,7-192-29938_30240-220123--,00.html> (accessed May 8, 2012).
- ⁴ This **opinion** does not address either corporation's use of the character marks "M22" and "M 119." (Attachment 2 and Attachment 4.)
- ⁵ "Trademark." *Encyclopedia Britannica. Encyclopedia Britannica Online*. Encyclopedia Britannica Inc., 2012. Web. 28 Mar. 2012. <<http://www.britannica.com/EBchecked/topic/601724/trademark>> (accessed May 8, 2012).
- ⁶ 23 USC 109(d) gives the Secretary of Transportation the authority to approve the "location, form and character of informational, regulatory and warning signs, curb and pavement or other markings, and traffic signals" on any highway project involving the use of federal funds. 23 USC 402(a) mandates that each state create "a highway safety program ... designed to reduce traffic accidents and deaths, injuries, and property damage resulting therefrom" and requires that each state program be "in accordance with uniform guidelines promulgated by the Secretary."
- ⁷ The term "traffic control devices" "means *all signs*, signals, markings, and devices not inconsistent with this act placed or erected by authority of a public body or official having jurisdiction, for the purpose of regulating, warning or guiding traffic." MCL 257.70 (emphasis added).
- ⁸ The federal MUTCD is available at <http://mutcd.fhwa.dot.gov/kno_2009.htm>(accessed May 8, 2012).
- ⁹ MDOT's version of the MUTCD is available at <<http://mdotwas1.mdot.state.mi.us/public/tands/plans.cfm>> (accessed May 8, 2012).
- ¹⁰ **Michigan** organized its highway system by number in 1919, using the design of a white diamond containing a black letter "M" at the top with the assigned highway number below. For additional in-depth historical analysis, see **Michigan** Highways: The Great Routes of the Great Lakes State <<http://www.michighighways.org>> (accessed May 8, 2012).
- ¹¹ This provision has been part of the **Michigan** MUTCD since 2005, two years before the first corporation's first use in commerce of the M-22 route marker design. (Attachment 3.)
- ¹² For example, the "M-22 Challenge" trademark (Attachment 6) is a completely original design that incorporates the M-22 highway route marker design, as is the stylized mark incorporating the M-119 road sign. (Attachment 7.) Both companies could maintain a registered trademark and disclaim any exclusive rights over the route marker design.
- ¹³ Such use remains subject to any other applicable laws. For example, the State of **Michigan** may have a cause of action under section 43(a) of the Lanham Act to bar the commercial use of an image to avoid confusion, mistake, or prevent a business from deceiving someone to believe that the images were affiliated with the State of **Michigan** or the **Michigan** Department of Transportation. 15 USC 1125(a).
- ¹⁴ A party may challenge an erroneously issued federal registration, as provided by section 15 of the Lanham Act, 15 USC 1065. A challenge must be brought within five years of the period during which the mark holder has made continuous use of the trademark after its registration.
- ¹⁵ "The term 'person' also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity." 15 USCS 1127.
- ¹⁶ The term "institution" is defined broadly. See *In re Shimmecock Smoke Shop*, 571 F3d 1171, 1173; 91 USPQ2d 1218 (Fed Cir, 2009) ("[O]rdinary meaning of 'institution' suggests the term is broad enough to include a self-governing Indian nation").
- ¹⁷ An applicant for a federal trademark that is refused under section 2(e) for being primarily geographically descriptive may apply for registration under section 2(f) by showing that the mark has gained "secondary meaning." 15 USC 1052(f).
- ¹⁸ MCL 429.32(e) states: "A mark by which the goods or services of an applicant for registration may be distinguished from the goods or services of others shall not be registered if the mark ... [c]onsists of a mark which, when applied to the goods or services of the applicant ... is primarily geographically descriptive or deceptively misdescriptive of them."

EXHIBIT 51
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



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[October 19, 2015 9:00 am](#)

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MiQuest, *Managing Partner*, 120 N. Washington Sq., Suite 1000A, Lansing MI, 49833
517.483.8210 phone

EXHIBIT 52
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE



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MEDC Mission

OUR MISSION

We market Michigan and provide the tools and environment to drive job creation and investment.

VISION

We will transform the Michigan economy by growing and attracting business, keeping talented residents here, and revitalizing our urban centers.

A Top 10 State For:

- Low unemployment
- Per capita income
- GDP growth
- Young adult population growth

OUR CUSTOMERS

We engage with customers globally, including:

- Businesses, entrepreneurs and communities
- A talented workforce that adds value to Michigan businesses

Contact Us

To contact a business development specialist, [click here \[/contact-medc/\]](/contact-medc/) or call 1.888.522.0103.

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EXHIBIT 53
PETITIONER STATE OF MICHIGAN'S COMBINED
BRIEF IN REPLY AND RESPONSE

From: Enrico Schaefer <enrico@traverselegal.com>
Sent: Tuesday, October 15, 2013 8:20 AM
To: Restuccia, Eric (AG)
Subject: Re: M22

Hey Eric:

I look forward to working with your designated Warner attorney. Could you provide me his name again? Thanks.

Enrico Schaefer
www.TraverseLegal.com
enrico.schaefer@traverselegal.com
866.936.7447
231-715-3298 (Direct Dial)

On Oct 2, 2013, at 4:30 PM, Enrico Schaefer <enrico@traverselegal.com> wrote:

Eric:

Thanks for the update last week. It sounds like I should interface with the contracted counsel at Warner from this point forward. Could you provide his name and contact info? I'll introduce myself. Thanks

Enrico Schaefer
www.TraverseLegal.com
enrico.schaefer@traverselegal.com
866.936.7447
231-715-3298 (Direct Dial)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

State of Michigan)	
)	
Petitioner,)	Reg. Nos.: 3992159
)	3348635
)	
v.)	
)	
M22, LLC,)	Proceeding: 92058315
)	
)	
Registrant.)	
_____)	

CERTIFICATE OF SERVICE

I, Susan Lubitz, legal secretary to Assistant Attorney General Toni L. Harris, certify that on October 22, 2015, I served a true and correct copy of Petitioner State of Michigan's Combined Brief in Reply and Response to Respondent's Cross-Motion on Registrant's counsel of record by via electronic transmission.

/s/ Susan Lubitz
Susan Lubitz